
ARTICLE

CLAIMING DESIGN

JEANNE C. FROMER[†] & MARK P. MCKENNA^{††}

Design stands out among intellectual property subject matter in terms of the extent of overlapping protection available. Different forms of intellectual property usually protect different aspects of a product. In the design context, however, precisely the same features are often subject to design patent, trademark, and copyright protection—and parties commonly claim more than one of those forms. Yet, as we show, the claiming regimes of these three forms of design protection differ in significant ways: the timing of claims; claim format (particularly whether the claims are visual or verbal); the multiplicity of claims (whether and how one can make multiple claims to the same design); and the level of abstraction at which parties claim rights. These methodological differences have significant effects on the operation of each individual regime. All of the claiming regimes have significant shortcomings, particularly in terms of the quality of notice the claims provide to third parties about their scope. That notice problem is worsened, as we argue, by the frequent cumulation of rights

[†] Professor of Law, New York University School of Law; Co-Director, Engelberg Center on Innovation Law & Policy.

^{††} John P. Murphy Foundation Professor of Law, Notre Dame Law School.

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in the same design. Claim ambiguity and parties' ability to switch back and forth between different design claims—both within and across legal regimes—make it difficult for courts and third parties to evaluate the validity and scope of rights. There is significant irony here because intellectual property claims exist almost entirely to provide notice. Cumulation also enables design rightsholders to assert rights in one or more regimes using the claiming rules that benefit them most at a particular moment, without any risk that those claiming choices will bind them in later rights assertions.

We suggest a number of improvements to each claiming regime that would help restore internal order. We also analyze various approaches to ameliorating the amplified costs of overlapping regimes for claiming design. In particular, we focus on doctrines of election and channeling rules as alternative methods of directing designs to one regime or another. We also introduce the possibility of transsubstantive intellectual property claiming rules as a way to reduce important inconsistencies across these regimes while also allowing protection under multiple regimes. Each of these solutions would alleviate at least some of the concerns we identify, though one's preference among them will likely depend on one's level of concern about overlapping rights.

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INTRODUCTION

Beautiful and thoughtful design is striking. Design is also ascendant. From the iPhone to Christian Louboutin shoes to Eames furniture, design occupies an increasingly influential role in our culture and economy.¹ The intellectual property laws that protect design are also striking, but for a different reason: the extent of overlapping protection they permit.

To be sure, design is not the only subject matter that implicates multiple forms of intellectual property protection, which are each thought to promote creation, innovation, or fair competition in their respective realms. In other cases of overlapping protection for a product or service, however, each form covers a different aspect of the subject matter. Software, for example, is potentially subject to both utility patent and copyright protection.² But utility patent protects only the functional aspects of software, whereas copyright law protects only its nonfunctional, expressive aspects.³

¹ See, e.g., *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 447-48 (S.D.N.Y. 2011) (describing the financial success and cultural significance of Louboutin's acclaimed red-soled shoes), *aff'd in part, rev'd in part*, 696 F.3d 206, 212 (2d Cir. 2012); Tim Bradshaw, *Designers on the Ascendant in Silicon Valley*, FIN. TIMES (July 7, 2013), <https://www.ft.com/content/b587e678-e42c-11e2-91a3-00144feabdco> [<https://perma.cc/PV45-69EG>] (explaining that designers now play crucial roles in startup companies as a result of Apple's influence); Sophie Gilbert, *The Vision of Charles and Ray Eames*, ATLANTIC (Nov. 13, 2015), <https://www.theatlantic.com/entertainment/archive/2015/11/charles-and-ray-eames-beyond-the-chair/415764/> [<https://perma.cc/CV2U-5DYF>] (describing the immense success of Eames furniture and its lasting influence on modern designers at companies including Apple and Ikea); see also, e.g., ALICE RAWSTHORN, *HELLO WORLD: WHERE DESIGN MEETS LIFE* iv (2014) (noting that design is a tool that brings about "scientific, technological, cultural, political, economic, social, environmental or behavioral" changes).

² For a thorough exploration of the roles of utility patent and copyright in the software context, see Pamela Samuelson, *Staking the Boundaries of Software Copyrights in the Shadow of Patents*, 71 FLA. L. REV. (forthcoming 2019), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3250496. See also Christopher Buccafusco & Mark A. Lemley, *Functionality Screens*, 103 VA. L. REV. 1293, 1320-24 (2017) [hereinafter Buccafusco & Lemley, *Functionality*] (discussing copyright's filtering analysis for computer software); Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U. L. REV. 1441, 1505 (2010) ("Given that writing computer source code is more about problem solving than problem finding, it is an uneasy fit in copyright law, in which the protectability standard is tailor-made for expression valued for its problem finding."); Dennis S. Karjala, *Distinguishing Patent and Copyright Subject Matter*, 35 CONN. L. REV. 439, 439-40 (2003) (underscoring that "the already much eroded distinction between patent and copyright subject matter would almost completely disappear for digital technologies" if patent were to be "limited to physical artifacts").

³ See, e.g., Buccafusco & Lemley, *Functionality*, *supra* note 2, at 1320 ("The code's functional components, however, are not protectable [by copyright], so courts must screen them out and focus only on the remaining expression."). In this context, like others involving subject matter overlap, courts have developed substantial doctrine for the purpose of channeling protection of distinct aspects of the subject matter to a particular regime. See *id.* at 1320-21 (citing cases in

Design is different. Unlike the complementary use of different forms of intellectual property for different aspects of other sorts of subject matter, parties commonly claim multiple forms of protection for *precisely the same features* of a design. For example, Puma recently sued fast-fashion retailer Forever 21, asserting design patent, trademark, and copyright infringement; Puma alleged that Forever 21 copied the same features of three footwear designs that it had developed in collaboration with singer Rihanna, one of which is shown in Figure 1.⁴

Figure 1: Bow Slides from Puma and Forever 21⁵

Puma’s “Bow Slide”	Defendant’s “Bow Slide”
	
	

Each relevant legal regime—design patent, trademark, and copyright—makes some effort to channel protection of design’s functional features to utility patent law. But intellectual property law is largely comfortable with overlapping protection for design’s *nonfunctional* aspects. The various forms of design protection can have complementary or cumulative economic effect, as each legal regime might imbue the claimant with somewhat different substantive rights and

which the “abstraction-filtration-comparison” test was applied). Considerable debate has arisen around the effectiveness of those doctrines.

⁴ Amended Complaint at 3-12, *Puma SE v. Forever 21, Inc.*, No. 17-2523 (C.D. Cal. Apr. 4, 2017) [hereinafter *Puma Amended Complaint*]; *see also* Complaint at 11-17, *Skinny Brand Jeans LLC v. QVC, Inc.*, No. 18-2011 (E.D. Pa. May 14, 2018) (asserting trade dress, unfair competition, and copyright infringement claims against QVC, which allegedly copied Skinny Brand Jeans’s “unique, innovative, distinctive and recognizable slimming wash pattern” and “stomach restraining panel” for women’s jeans).

⁵ *Puma Amended Complaint*, *supra* note 4, at 9.

make different remedies available. As a result, strategic parties are often able to use design patent, trademark, and copyright laws cumulatively or as substitutes.

One of us has elaborated elsewhere on the problem of cumulation of intellectual property rights.⁶ But even those not disposed to regard cumulation as problematic in principle⁷ ought to be concerned about the considerable differences in claiming methodologies across design patent, trademark, and copyright. At the very least, those differences undermine notice and create worrisome opportunities for strategic behavior.

Take, for example, the plaintiff's claim in *Two Pesos, Inc. v. Taco Cabana, Inc.*⁸ In that landmark trademark case, Taco Cabana, a fast-food Mexican restaurant chain, claimed as its trade dress the exterior and interior design of its restaurants,⁹ which it characterized as consisting of

a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.¹⁰

⁶ See Mark P. McKenna, *(Dys)Functionality*, 48 HOUS. L. REV. 823, 824 (2011) [hereinafter McKenna, *(Dys)Functionality*] (discussing the cumulation of rights in trademark law resulting from “courts differ[ing] over the extent to which the [functionality] doctrine focuses on competitors’ right to copy unpatented features as opposed to their need to copy”); Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 STAN. TECH. L. REV. 1, 44-46 (2013) [hereinafter McKenna & Strandburg, *Progress*] (worrying about a design patent regime that overlaps with utility patent, trade dress, and copyright laws).

⁷ Compare 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2A.07 (2016) (arguing that there is no reason that the same design cannot be protected by both copyright and patent laws) with Andrew Beckerman-Rodau, *The Problem with Intellectual Property Rights: Subject Matter Expansion*, 13 YALE J.L. & TECH. 36, 73-89 (2011) [hereinafter Beckerman-Rodau, *Problem*] (concluding that overlapping protection “undermines the careful balance individually developed under each body of intellectual property law”); Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1476 (2004) [hereinafter Moffat, *Mutant Copyrights*] (“[T]he availability of overlapping intellectual property protection in all of its forms presents a serious threat to the goals and purposes of federal intellectual property policy”); Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493, 1512-16 (2017) [hereinafter Samuelson, *Strategies*] (criticizing the overlap of copyright and utility patent protections for undermining intellectual property law’s careful balance of encouraging creation while avoiding monopolies that stifle progress and creativity). For an article acknowledging troublesome aspects of overlapping intellectual property protections but arguing that “eliminating such overlaps as a structural matter would be inadvisable,” see Laura A. Heymann, *Overlapping Intellectual Property Doctrines: Election of Rights Versus Selection of Remedies*, 17 STAN. TECH. L. REV. 239, 275 (2013) [hereinafter Heymann, *Overlapping*].

⁸ 505 U.S. 763 (1992).

⁹ *Id.* at 766.

¹⁰ *Id.* at 765 (citations omitted) (internal quotation marks omitted).

The generality of that description is remarkable, particularly in light of the photographs Taco Cabana entered into the record. As shown on the left in Figure 2, the most visually striking aspect of Taco Cabana's restaurant design is its primarily pink color. Had Taco Cabana been forced to articulate the elements of its trade dress prior to and independently of its dispute with Two Pesos, it seems likely that the color pink would have featured prominently in that description. But because Taco Cabana could enforce its rights without having to register the trade dress,¹¹ it was never forced to delineate its claim before the dispute. Once it confronted Two Pesos' blue design, Taco Cabana surely was not going to emphasize the pink color scheme. Instead, it strategically claimed its trade dress to capture Two Pesos' specific design choices, highlighting a more general "festive eating atmosphere" and "festive and vivid color scheme."¹²

Figure 2: Photographs of Taco Cabana (Left) and Two Pesos (Right) Restaurants¹³



There are good reasons to allow parties to assert rights in unregistered trademarks.¹⁴ Registration favors large, sophisticated companies, which generally are familiar with the registration system and have the resources to seek registration for each new potential trademark.¹⁵ The availability of

¹¹ See, e.g., *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 209-10 (2000); *Two Pesos*, 505 U.S. at 768.

¹² *Two Pesos*, 505 U.S. at 765-66.

¹³ *Two Pesos v. Cabana*, CORNELL U. L. SCH., https://courses2.cit.cornell.edu/sociallaw/student_projects/Tradedresspage2.html#_edn20 (last visited Sept. 30, 2018).

¹⁴ That said, courts' extension of federal law to allow claims based on unregistered rights altered the traditional relationship between trademark and unfair competition laws in ways that were not fully considered. See Mark P. McKenna, *Trademark Law's Faux Federalism*, in *INTELLECTUAL PROPERTY AND THE COMMON LAW* 288, 289 (Shyamkrishna Balganesh ed., 2013) ("[T]he persistent sense that federal and state law regulate concurrently has masked a significant federalization of trademark and unfair competition law over the last forty to fifty years.").

¹⁵ See Gideon Parchomovsky & Alex Stein, *The Relational Contingency of Rights*, 98 VA. L. REV. 1313, 1350 (2012) ("The relative advantage in litigation costs enjoyed by large corporations

unregistered rights makes it easier for smaller, less sophisticated companies to claim rights without significant expense. Unregistered rights are also substantially more flexible. A party that goes to the expense of registering a mark has some incentive to stick with that mark over longer periods of time, whereas unregistered rights are better suited to marks that might be adapted or used in connection with different goods or services over time. Recognition of unregistered rights is also consistent with foundational American trademark principles because trademark rights have always arisen out of use rather than registration.¹⁶

Still, the flexibility of unregistered rights can have real costs. One obvious cost is a lack of notice regarding the scope of rights claimed by a party. Before litigation, Two Pesos could only have observed Taco Cabana's use in the marketplace and made an educated guess as to the features of any trade dress owned by Taco Cabana. Based on its observation, Two Pesos might reasonably have believed that, if Taco Cabana had any rights to the design of its restaurants, the color pink was an essential—and central—part of the trade dress. Indeed, Two Pesos might have chosen to use blue in its restaurant design precisely to avoid infringement.

Relatedly, the flexibility of unregistered rights enables strategic behavior on the part of claimants. Because it was able to defer claiming until it asserted its rights against Two Pesos, Taco Cabana was able to define its trade dress to encompass Two Pesos' design. It might not have been able to do so if it had been forced to claim earlier and independently of the particular dispute. In addition, trademark law has no rules fixing the level of generality at which trade dress must be described.¹⁷ Taco Cabana was thus able to claim without referencing specific features that might have contrasted with corresponding features of the Two Pesos design or invited comparisons to the designs of the many other Mexican restaurants whose restaurants predated Taco Cabana's. As a result, Taco Cabana was able to leave the scope of its rights open in other cases.

To compare design patent claiming, consider luxury Italian footwear company Aquazzura's recently settled case against Ivanka Trump.¹⁸ Aquazzura

enables them continuously to expand the scope of trademark protection at the expense of small businesses that can ill-afford to protect their rights in lengthy court battles.”); cf. Jessica M. Kiser, *To Bully or Not to Bully: Understanding the Role of Uncertainty in Trademark Enforcement Decisions*, 37 COLUM. J.L. & ARTS 211, 221-23 (2014) (commenting on the “numerous direct and indirect costs” of trademark enforcement and protection).

¹⁶ See, e.g., *Am. Washboard Co. v. Saginaw Mfg. Co.*, 103 F. 281, 287 (6th Cir. 1900) (“It is the party who uses it first as a brand for his goods, and builds up a business under it, who is entitled to protection, and not the one who first thought of using it on similar goods, but did not use it.” (quoting *George v. Smith*, 52 F. 830, 832 (S.D.N.Y. 1892))).

¹⁷ *Infra* Section I.B.

¹⁸ *Aquazzura v. Ivanka Trump Settle Suit*, FASHION LAW (Nov. 18, 2017), <http://www.thefashionlaw.com/home/a-trumped-up-trial-aquazzura-v-ivanka-trump> [<https://perma.cc/8RXJ-ER9W>];

holds a design patent for the design of one of its popular shoes,¹⁹ known as the Christy, which comes in both flat and pump versions.²⁰ As we detail below, design patent claims consist of drawings, which are typically made early and independently of any dispute. Aquazzura's design patent claims to the Christy are shown below in the left two pictures in Figure 3. One version of the Christy marketed by Aquazzura is shown on the right in Figure 3.

Figure 3: Aquazzura Christy Design Patent²¹ and As Sold²²



After Aquazzura's Christy shoes achieved success in the market, Ivanka Trump began selling her Tropica shoe, shown in Figure 4. The Tropica shares some design elements with the shoe depicted in Aquazzura's design patent, particularly similar lacing, straps, and overall shape. Yet there are also differences in the lacing and strap pattern. Most obviously, Trump's Tropica laces pass through three sets of eyelets, whereas Aquazzura's Christy laces pass through only two sets.²³ Thus, the Tropica is not identical to Aquazzura's

see also Second Amended Complaint at 2, *Aquazzura Italia SRL v. Trump*, No. 16-4782 (S.D.N.Y. Mar. 30, 2017), 2017 WL 1506103 (bringing trademark and design patent infringement claims); *Aquazzura Adds Design Patent Infringement Claim to Trump Lawsuit*, FASHION LAW (Nov. 4, 2016 [hereinafter *Trump Lawsuit*]), <http://www.thefashionlaw.com/home/aquazzura-adds-design-patent-infringement-claim-to-trump-lawsuit> [https://perma.cc/J2ZX-UCZ3] ("Even more recently, Aquazzura has expanded the breadth of its trade dress infringement suit against Trump, opting to add a design patent infringement claim to the mix, as well."). At the time of settlement, Aquazzura had limited its claims to those for infringement of the design of another shoe, the Wild Thing, despite media reports that it was also asserting infringement claims of the Christy design.

¹⁹ U.S. Patent No. D750,359.

²⁰ *Aquazzura Awarded Design Patent for Hot-Selling Shoe Design*, FASHION LAW (Mar. 17, 2016), <http://www.thefashionlaw.com/home/aquazzura-awarded-design-patent-protection> [https://perma.cc/A5RJ-XL63].

²¹ U.S. Patent No. D750,359.

²² *Trump Lawsuit*, supra note 18.

²³ See *Real vs. Steal—Aquazzura Christy Lace-Up Flats*, IN THEIR CLOSET (Oct. 17, 2016), <http://intheircloset.com/aquazzura-christy-lace-up-pointed-toe-flats> [https://perma.cc/N6FV-PSS3] (listing many other knockoff versions of the Aquazzura Christy shoe, and observing that Trump's Tropica version is not identical, though it is similar).

claimed design. While design patent infringement does not require identity,²⁴ the design against which a court will have to compare the Tropica is not open to new depiction within the context of litigation.

Figure 4: Ivanka Trump's Tropica Shoe²⁵



These examples highlight significant differences between the trademark and design patent claiming regimes. One difference has to do with the timing of claims. Depending on the regime, claiming can happen shortly after design creation or well after commercialization. And it can happen in the context of a design patent application filed independently of any dispute or in the context of a particular assertion of rights. Another difference relates to claim format. Design patent claiming is entirely visual, whereas trade dress claiming is verbal. Both types of claims can vary in terms of the claim's level of generality. These differences in timing and format interact with and complicate the several other dimensions along which claiming in intellectual property can differ.²⁶

A party's claiming choices can be consequential for the scope of its rights in a design, and they can shape legal and business incentives. Design patent law forces claimants to think through the scope of their claimed rights at the time of application, which may be early in the design's lifecycle. At that point, it may be relatively difficult for the designer to anticipate the range of alternative designs competitors might develop. Early claiming might also force a designer to think more carefully, and at an earlier stage, about the ways it is likely to market the design and about the extent and nature of competition the design will face. Conversely, later claiming allows for greater experimentation with different designs and more opportunity to assert rights

²⁴ *Infra* Section I.A.

²⁵ MACY'S, *Ivanka Trump Tropica Lace-Up Flats*, <https://www.macys.com/shop/product/ivanka-trump-tropica-lace-up-flats?ID=4654617> [<https://perma.cc/UKA9-7455>] (last visited Aug. 29, 2018).

²⁶ See generally Jeanne C. Fromer, *Claiming Intellectual Property*, 76 U. CHI. L. REV. 719, 719 (2009) [hereinafter Fromer, *Claiming*] (discussing the various dimensions of claiming in patent and copyright, including central, peripheral, characteristic, and exemplar claiming).

strategically as the competitive environment develops. In terms of claim format, visual claiming tends to focus viewers on a design's gestalt—though perhaps in skewed ways—rather than individual features. Verbal claiming likely does the opposite.

As we discuss below, both design patent and trademark's claiming regimes have significant shortcomings, just as copyright's does, particularly in terms of the quality of notice the claims provide to third parties about their scope. Those notice problems are worsened by the frequent cumulation of rights in the same design. Claim ambiguity and parties' ability to switch back and forth between different design claims—both within and across legal regimes—makes it difficult for courts or third parties to evaluate the validity and scope of rights. There is significant irony here because intellectual property claims exist almost entirely to provide notice, whether to government officials or third parties ascertaining protectability or determining the scope of rights.²⁷ Cumulation also enables design rightsholders to assert rights in one or more regimes using the claiming rules that benefit them most at a particular moment, without any real risk that its claiming choices will bind it in future rights assertions.

Importantly, the problems with the claiming regimes in these areas and the costs of variation in claiming methodology across systems are not the result of considered policy judgments by which the costs were accepted as regrettable byproducts of important policy gains. Design protection is relatively new in trademark law, and courts' inability to develop a clear and consistent claiming methodology in this area is a consequence of their expansion of trademark subject matter and infringement doctrine.²⁸ Copyright's protection for design has long been uneven, particularly in light of the difficulties courts have had with the concept of separability in the context of useful articles.²⁹ And copyright's extremely low originality bar, along with its loosening infringement standard, has put more pressure on courts to identify the protectable features of the works at issue.³⁰ While the design patent statute is old, use of that system has become far more popular

27 See generally Fromer, *Claiming*, *supra* note 26, at 731 ("In essence, claiming helps the public assess what remains in the public domain and what has been made private."). The format of claiming can affect the quality of notice, as well as ascertainment of scope and the ability to cover works grounded in after-developed technologies. *Id.* at 757-71.

28 For a description of trademark law's growth and its connection to increasingly challenging issues regarding the scope of rights, see Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WM. & MARY L. REV. 2197, 2215-16 (2016) [hereinafter Lemley & McKenna, *Scope*].

29 See *infra* Section I.C.

30 Lemley & McKenna, *Scope*, *supra* note 28, at 2214-15.

in recent years,³¹ and claimants have used it much more commonly for partial designs.³² These developments have made claiming in each area both more important and more difficult, and they have dramatically increased instances of overlapping protection. Thus, in our view, the problems with claiming in these areas, and especially their relationship to the problem of overlap, were largely accidental and, until now, mostly unconsidered.

In this Article, after setting out the features of the different claiming regimes of design patent, trademark, and copyright laws, we evaluate several dimensions of the differences between those claiming regimes, focusing primarily on timing, mode of depiction, and level of abstraction. In addition to identifying several improvements to each claiming regime, we analyze various approaches to ameliorating the amplified costs of overlapping protection. In particular, we focus on doctrines of election and channeling rules as alternative methods of directing designs to one regime or another. We also introduce the possibility of transsubstantive intellectual property claiming rules as a way to reduce important inconsistencies across these regimes while also allowing protection under multiple regimes. Each of these solutions would alleviate at least some of the concerns we identify, though one's preference among them will likely depend on one's level of concern about overlapping rights.

I. CLAIMING DESIGNS IN THE LAW

Given the range of activities and artifacts we colloquially refer to as “design”—furniture design, game design, web design, floral design, and even the design of processes—the category of “design” can sometimes feel like it refers to everything and therefore nothing.³³ Designers and scholars of design tend to use the term expansively: for example, Karl Ulrich defines design as “conceiving and giving form to artifacts that solve problems.”³⁴ Intellectual property law is not much more precise. Design patent, trademark, and copyright laws use varying labels to identify types of design

³¹ See, e.g., Christopher Buccafusco & Jeanne C. Fromer, *Fashion's Function in Intellectual Property Law*, 93 NOTRE DAME L. REV. 51, 104 (2017) (“[S]eeking and asserting design patent protection for fashion designs has become increasingly popular.”).

³² See Sarah Burstein, *The “Article of Manufacture” in 1887*, 32 BERKELEY TECH. L.J. 1, 1 (2017) [hereinafter Burstein, *“Article of Manufacture” in 1887*] (describing the once-narrower subject matter of design patent law); Sarah Burstein, *The “Article of Manufacture” Today*, 31 HARV. J.L. & TECH. 781, 781-88 (2018) [hereinafter Burstein, *“Article of Manufacture” Today*] (describing modern design patent law’s more expansive definition of the article of manufacture, and explaining that partial claiming is popular because it allows patent owners to protect their inventions even when the defendant’s product is not identical).

³³ KARL T. ULRICH, *DESIGN: CREATION OF ARTIFACTS IN SOCIETY* 1-2 (2011).

³⁴ *Id.* at 2 (emphasis omitted).

subject to protection, though they do so without conceptual clarity regarding the boundaries between categories.

Design patents are available for any “new, original and ornamental design for an article of manufacture.”³⁵ As Sarah Burstein demonstrates, courts once had a reasonably constrained idea of what “article[s] of manufacture” were, and configurations and surface ornamentations of those things were patentable.³⁶ But modern design patent law is more capacious: The Supreme Court recently defined an article of manufacture as “simply a thing made by hand or machine.”³⁷ Thus, the design of anything made by hand or machine is design patent subject matter.

Trademark law also protects designs, primarily as trade dress.³⁸ The law protects both product packaging and product design but subjects them to different legal treatment. Packaging is capable of being considered inherently distinctive and thus immediately protectable, but design is protectable only when it has “acquired distinctiveness” or “secondary meaning.”³⁹ The Supreme Court developed this significant distinction, however, without defining either product design or packaging.⁴⁰

And copyright law protects the broad class of “original works of authorship fixed in any tangible medium of expression,” which includes “pictorial, graphic, and sculptural works.”⁴¹ Thus, copyright seems to embrace much of what we might ordinarily consider “design.” But, among other limitations, the design of a useful article is copyrightable only to the extent that its features are “separable” from the utilitarian aspects of the article.⁴²

³⁵ 35 U.S.C. § 171(a) (2012).

³⁶ Burstein, *Article of Manufacture* in 1887, *supra* note 32, at 83 (arguing that courts understood “article of manufacture” to mean a “tangible item made by humans—other than a machine or composition of matter—that had a unitary structure and was complete in itself for use or for sale”).

³⁷ *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 435 (2016).

³⁸ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765-67 (1992) (holding that inherently distinctive, nonfunctional trade dress is protectable under § 43(a) of the Lanham Act without proof of secondary meaning). We say *primarily* because there is a design element to many logos and stylized trademarks, which are not trade dress.

³⁹ See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210-16 (2000) (“[I]n an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product’s design is distinctive, and therefore protectable, only upon a showing of secondary meaning.”). A mark acquires the requisite secondary meaning when “in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.” *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings*, 696 F.3d 206, 216 (2d Cir. 2012) (quoting *Inwood Labs, Inc. v. Ives Labs, Inc.*, 456 U.S. 844, 851 n.11 (1982)).

⁴⁰ The Supreme Court acknowledged this problem, but instead of defining the categories, it simply created a default rule, instructing courts to treat ambiguous subject matter as product design and require secondary meaning. *Wal-Mart*, 529 U.S. at 215.

⁴¹ 17 U.S.C. § 102(a) (2012).

⁴² *Id.* § 101 (“[T]he design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates . . . features that

Congress intended the separability requirement to distinguish applied art from industrial design, making copyright protection potentially available for the former but channeling the latter to design or utility patent protection.⁴³ The Supreme Court recently defined applied art as “art employed in the decoration, design, or execution of useful objects.”⁴⁴ It defined design as “the combination of details or features that go to make up” a useful article.⁴⁵ Notably, the Court did not attempt to define industrial design.

We mean here to focus on the various types of designs that design patent, trademark, and copyright laws address, despite those regimes’ lack of clear definitions.⁴⁶ Of course, each of those regimes has a somewhat distinct justification. Design patent law is generally thought—or at least originally was thought—to encourage the creation of industrial design.⁴⁷ By contrast, trademark law enables mark owners to reap the reputational benefits of their goods or services by preventing consumer confusion about the source of those goods.⁴⁸ And copyright law aims to encourage the production and dissemination of artistic and cultural works.⁴⁹ Despite these different purposes, design patent, trademark, and copyright laws not only all protect design, they commonly protect the *same* aspects of a design. Before turning to that overlap in protection, we first consider claiming in design patent, trademark, and copyright laws respectively.

A. Design Patent Claiming

The inventor of “any new, original and ornamental design for an article of manufacture” may obtain a design patent, subject to requirements of novelty and nonobviousness.⁵⁰ The Federal Circuit has interpreted “ornamental” to

can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”).

⁴³ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

⁴⁴ *Id.* at 1014 (citation and internal quotation marks omitted).

⁴⁵ *Id.* at 1009 (citation and internal quotation marks omitted).

⁴⁶ We do not address here *sui generis* protection for semiconductor chips or boat hulls, which are defined more precisely. See 17 U.S.C. §§ 901(a)(1)–(3) (2012) (protecting semiconductor chip products); *id.* §§ 1301(a)(2), (b)(4) (protecting original designs of boat hulls).

⁴⁷ See *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 525 (1871) (noting that patent law seeks to secure for a limited time the economic benefits flowing from a new and original product to its creator); McKenna & Strandburg, *Progress*, *supra* note 6, at 31–32 (discussing Congress’s motive in filling a “perceived vacuum of protection” for design patents not otherwise protected by copyright, patent, or trademark laws when passing the 1842 design patent statute).

⁴⁸ See, e.g., Mark McKenna, *Testing Modern Trademark Law’s Theory of Harm*, 95 IOWA L. REV. 63, 66–72 (2009) (describing this conceptual framing of trademark law before criticizing parts of it).

⁴⁹ See, e.g., Jeanne C. Fromer, *An Information Theory of Copyright Law*, 64 EMORY L.J. 71, 74–76 (2014) (“[C]opyright law provides the incentive of exclusive rights for a limited duration to authors to motivate them to create culturally valuable works.”).

⁵⁰ 35 U.S.C. § 171(a) (2012).

mean nonfunctional.⁵¹ Because features are functional under prevailing case law only when they are “dictated by function,” ornamentality is not a significant limitation on patentability;⁵² nor are design patent’s novelty and nonobviousness requirements, particularly relative to the parallel requirements in utility patent law.⁵³

Design patents last for fifteen years from the date of grant.⁵⁴ The owner of a design patent has a right to prevent others from using a similar design “if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, [the] two designs are substantially the same, [and] the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other.”⁵⁵

To get a design patent, the inventor must apply to the Patent and Trademark Office (PTO), which examines the claimed design for patentability.⁵⁶ Because design patent law incorporates most of the legal rules applicable to utility patents—including a rule that generally grants priority to the first to file for a patent on a design⁵⁷—inventors have an incentive to seek design patent protection expeditiously.⁵⁸ As a result, the information in a design patent application is likely to be developed early in the commercialization timeline, frequently before competitors enter the

⁵¹ *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1378 (Fed. Cir. 2002) (“[I]f other designs could produce the same or similar functional capabilities, the design of the article in question is likely ornamental, not functional.”).

⁵² Buccafusco & Fromer, *Fashion’s Function*, *supra* note 31, at 100 n.269; *see also* Mark P. McKenna & Christopher Jon Sprigman, *What’s In, and What’s Out: How IP’s Boundary Rules Shape Innovation*, 30 HARV. J.L. & TECH. 491, 520 (2017) (“[T]he Federal Circuit has, since its inception, considered the question of whether claimed features lack ornamentality more than thirty times. It has found the claimed design invalid on functionality grounds only five times, most recently in 2001.”).

⁵³ *See, e.g.*, McKenna & Strandburg, *Progress*, *supra* note 6, at 42 (“[T]he Federal Circuit’s standards for nonobviousness in design patent law are relatively low, as compared to utility patent standards . . . [T]he Federal Circuit’s approach comes dangerously close to collapsing obviousness and novelty altogether.”).

⁵⁴ 35 U.S.C. § 173.

⁵⁵ *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871); *accord* *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc) (citing, affirming, and applying the ordinary observer test).

⁵⁶ 35 U.S.C. §§ 112, 171; *see also* U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1504 (9th ed., rev. 8, Jan. 2018) [hereinafter MPEP] (describing the examination of design patent applications); MATTHEW A. SMITH, DESIGN PATENTS 7 (0.9 ed. 2012), http://patentlyo.com/media/docs/2012/12/2012-12-17_design_patents.pdf [<https://perma.cc/SG45-FPMC>] (noting the regulations that govern the form of patent applications).

⁵⁷ 35 U.S.C. § 102(a).

⁵⁸ *See* Jeanne C. Fromer, *Dynamic Patent Disclosure*, 69 VAND. L. REV. 1715, 1720 (2016) [hereinafter Fromer, *Dynamic Disclosure*] (remarking that inventors prefer to file patent applications promptly “to avoid being blocked from getting a patent by a competing inventor”). In the context of utility patents, “there are marketplace pressures to rush to patent, in that patent applications and granted patents readily serve as signals to venture capitalists and other funders that the inventions at issue are a worthy business investment.” *Id.* Whether design patents also help attract outside funding is currently unknown as an empirical matter.

space. That means that a design patent claim will likely be made independently of any disputes with competitors that might arise down the line.⁵⁹ Design patent applications are not published, so the PTO makes the claimed design public only once the patent issues,⁶⁰ which occurs about twenty months from filing, on average.⁶¹

Design patent applications, like applications for utility patents, must contain a sufficient “written description of the [design], and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same.”⁶² The application must also “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor . . . regards as the [design].”⁶³

Yet because “[t]he design for an article consists of the visual characteristics embodied in or applied to an article [of manufacture],”⁶⁴ a design patent application may include only a single claim for the design, and that claim must consist of a drawing.⁶⁵ In essence, then, a design patent’s single claim is visual.⁶⁶ The application must have a preamble, which includes the design’s title (which must “designate the particular article” of manufacture at issue) and “a brief description of the nature and intended use of the article in which the design is embodied.”⁶⁷ But as the PTO makes clear, “[n]o description of the design in the specification beyond a brief description of the drawing is generally necessary, since as a rule the illustration in the drawing views is its

⁵⁹ That said, there might be opportunities to amend claims during patent prosecution to cover competitors’ products that have since emerged. See Sarah Burstein, *Costly Designs*, 77 OHIO ST. L.J. 107, 115-16 (2016) [hereinafter Burstein, *Costly Designs*] (“The PTO also allows design patent applicants to broaden their claims . . . [T]his strategy allows a design patent applicant to . . . capture competing products that were introduced after the first design patent application was filed—even if those competing products did not infringe the original patent claim.”).

⁶⁰ 35 U.S.C. § 122(b)(2)(iv).

⁶¹ Robert C. MacKichan III, *Despite Increased Hiring, Design Patent Application Backlog Builds*, FINNEGAN: PROSECUTION FIRST BLOG (Mar. 7, 2016), <https://www.finnegan.com/en/insights/blogs/prosecution-first/despite-increased-hiring-design-patent-application-backlog-builds.html> [https://perma.cc/378C-NHGS].

⁶² 35 U.S.C. § 112(a).

⁶³ *Id.* § 112(b).

⁶⁴ MPEP, *supra* note 56, § 1502.

⁶⁵ 37 C.F.R. §§ 1.152–53(a) (2012). This is in contrast to utility patents, which can—and very often do—conclude with multiple verbal claims. MPEP, *supra* note 56, § 1502.01(C).

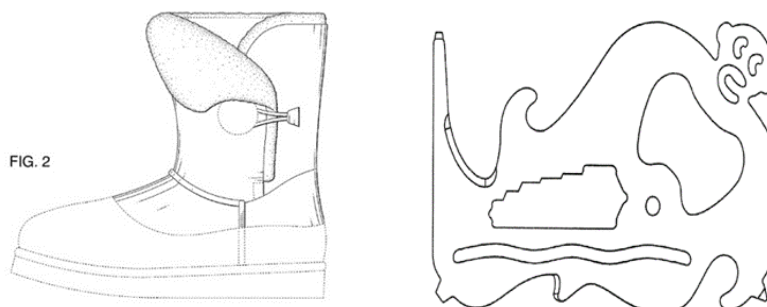
⁶⁶ MPEP, *supra* note 56, §§ 1503.01.II, 1504.04.

⁶⁷ 37 C.F.R. §§ 1.153(a), 1.154(b)(1). The preamble is generally thought not to have any legal effect, and it is therefore unclear whether the depicted design is limited to the context suggested by the preamble language. Sarah Burstein, *The Patented Design*, 83 TENN. L. REV. 161, 179-207 (2015).

own best description.”⁶⁸ Thus, the drawing takes precedence over everything else in a design patent application.⁶⁹

A design patent claim can be directed to configuration or to surface ornamentation.⁷⁰ Moreover, an applicant can claim the design of an entire object or specific features thereof.⁷¹ The scope of the claim is defined by what is drawn in solid lines.⁷² By contrast, broken lines are used to represent “[s]tructure that is not part of the claimed design, but is considered necessary to show the environment in which the design is associated.”⁷³ Visual aspects depicted with broken lines are therefore unclaimed.⁷⁴ Thus, in the drawing on the left in Figure 5, the claim is limited to certain design features of the upper portion of the boot; the shape of the button and the design of the lower part of the boot are not claimed. By contrast, the drawing on the right in Figure 5 is entirely in solid lines. It therefore reflects a claim to every aspect of the design of the multi-dimensional pocket tool.

Figure 5: Drawings from Deckers’ Upper Boot Patent⁷⁵ (Left) and a Utility Tool⁷⁶ (Right)



⁶⁸ MPEP, *supra* note 56, § 1503.01.II.

⁶⁹ See *id.* §§ 1503-02 (“[T]he drawing or photograph constitutes the entire visual disclosure of the claim . . .”).

⁷⁰ *Id.* § 1502 (identifying both configuration and surface ornamentation as design patent subject matter).

⁷¹ See Burstein, *Costly Designs*, *supra* note 59, at 114 (noting that a design patent applicant does not need to claim an “entire article of manufacture”).

⁷² MPEP, *supra* note 56, § 1503.02.III ¶ 15.50 (requiring solid lines for the “ornamental design which is being claimed” and prohibiting broken lines even for “unimportant or immaterial features” so long as they are “portions of a claimed design”).

⁷³ *Id.* § 1503-02.III.

⁷⁴ *Id.* For further detail on the meaning of solid and broken lines in design patents, see Burstein, *Costly Designs*, *supra* note 59, at 114-16, which discusses priority determinations with regard to continuation applications when a solid line in an earlier application is later changed to a broken line.

⁷⁵ U.S. Patent D599,999 fig.2.

⁷⁶ U.S. Patent D707,091 fig.7.

Perhaps counterintuitively, depicting some aspects of the article in broken lines makes the claim broader rather than narrower. The drawing of the boot design above claims an upper portion of a boot with some sort of fastening device, but it covers use of those design features no matter the size or shape of the button and no matter the design of the lower part of the boot.⁷⁷ Had the drawing depicted the boot entirely in solid lines, the shape and size of the button and the design of the lower portion of the boot would have been relevant constraints on the scope of the claim.

Despite the overwhelming visual orientation of design patent claiming rules, images rarely speak for themselves, so verbal descriptions of claimed designs feature prominently in design patent litigation.⁷⁸ Yet the formal role of verbal description is quite unclear.

In virtually every doctrinal context, courts insist that excessive reliance on verbal description should be avoided because of “the risk of placing undue emphasis on particular features of the design and the risk that a finder of fact will focus on each individual described feature in the verbal description rather than on the design as a whole.”⁷⁹ The Federal Circuit has thus repeatedly underscored that “a design is better represented by an illustration than it could be by any description and a description would probably not be intelligible without the illustration.”⁸⁰

Nevertheless, despite courts’ general disfavor of verbal description, it turns out to be impossible to avoid. Courts cannot evaluate the validity of a claimed design without identifying and describing aspects of the design and comparing them to features of prior art designs. Nor can they assess infringement without describing similarities and dissimilarities between

⁷⁷ MPEP, *supra* note 56, § 1503.02.III ¶ 15.50.01 (“Environmental structure may be illustrated by broken lines in the drawing . . .”).

⁷⁸ See Rebecca Tushnet, *The Eye Alone Is the Judge: Images in Design Patents*, 19 J. INTELL. PROP. L. 409, 418 (2012) [hereinafter Tushnet, *The Eye Alone*] (explaining that although the Federal Circuit “endorsed the idea that the images should be allowed to speak for themselves,” courts use verbal description where juries “would not know how to interpret without [verbal] instruction”).

⁷⁹ *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 680 (Fed. Cir. 2008) (en banc).

⁸⁰ *Id.* at 679 (quoting *Dobson v. Dornan*, 118 U.S. 10, 14 (1886) (internal quotations and citations omitted)). Nonobviousness is an outlier on this issue because in that context a court’s failure to reduce the design to verbal description is error. See *High Point Design LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1314 (Fed. Cir. 2013) (finding that the district court described the design at “too high a level of abstraction,” and remanding for the district court to “add sufficient detail to its verbal description of the claimed design to evoke a visual image consonant with that design”); *Apple, Inc. v. Samsung Elecs. Co.*, 678 F.3d 1314, 1329–33 (Fed. Cir. 2012) (concluding that the district court viewed the references in the obviousness context “from too high a level of abstraction”); cf. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1332 (Fed. Cir. 2014) (holding that even though “the district court did not expressly undertake to translate the claimed design into a verbal description,” that did not constitute error because “[i]t [was] entirely clear from the district court’s opinion what it considered to be the relevant design characteristics of the . . . patented design”).

features of the accused product and those of the claimed design. Thus, while courts often cling to the Federal Circuit's suggestion that descriptions are not intelligible without the accompanying illustrations, the cases demonstrate that the opposite is about as true: design patent drawings may not be intelligible without some description.

Take, for example, the Federal Circuit's discussion of novelty in a case involving foam clogs sold under the Crocs brand name.⁸¹ In that case, the court emphasized that the claimed design should be compared to a prior art reference holistically, without focusing on individual design elements described in words.⁸² But the court then proceeded to identify and highlight particular design features (shown in Figure 6) and compare them to features of a prior art reference, concluding that the differences may be significant:

The Crocs '789 patent, as shown . . . in the figure on the left, contains a long, U-shaped dimpling pattern on the insole. In contrast, the patents-in-suit [including the '263 patent] . . . have a dimpling pattern that includes multiple short rows of dimples. Because we cannot say that these differences are insignificant as a matter of law, a genuine issue of material fact exists as to whether the designs would be viewed as substantially similar in the eyes of the ordinary observer armed with the knowledge of the prior art.⁸³

Figure 6: Croc Design Patent Claim⁸⁴

Figure 6 in the '789 Patent

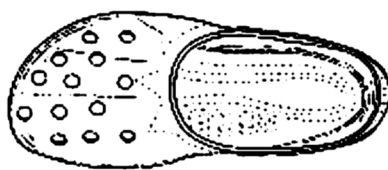


Figure 1 in the '789 Patent

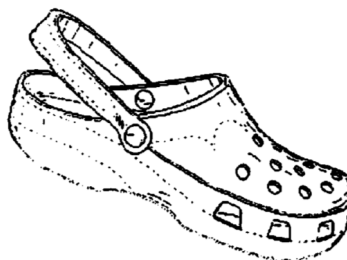
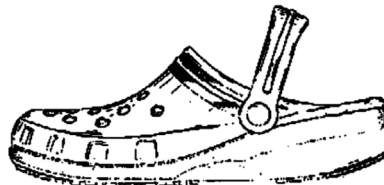


Figure 6 in the '263 Patent



Figure 2 in the '263 Patent



⁸¹ Int'l Seaway Trading Corp. v. Walgreens Corp., 589 F.3d 1233, 1237-41 (Fed. Cir. 2009).

⁸² *Id.* at 1240 ("[A]pplying the point of novelty test in the context of anticipation . . . creates the need to canvass the entire prior art to identify the points of novelty.").

⁸³ *Id.* at 1242-43.

⁸⁴ *Id.* at 1236-1237, 1342.

At the same time, the Federal Circuit agreed with the district court that “[s]light variations on the number and position of the circular holes on top of the shoe, the rectangular holes on the toe of the shoe as well as the design of different shaped rectangles on the sole of the shoe” were insufficient to preclude a finding of lack of novelty because they did not change the overall visual impression of the shoe.⁸⁵

Given the tight relationship between novelty and infringement standards,⁸⁶ it should be no surprise that courts are similarly conflicted about verbal description of the visual claim in the infringement context. Under *Gorham Co. v. White*’s canonical infringement test, an accused design is infringing when it is “substantially the same” as the claimed design such that the ordinary observer would be deceived into buying the accused design believing it to be the claimed design.⁸⁷ Courts are supposed to make this assessment of similarity holistically. Indeed, the Court emphasized the ordinary-observer perspective because it believed that experts would fixate on differences and therefore be reluctant to find infringement.⁸⁸ Nevertheless, the Court proceeded to identify and describe similarities and differences between the plaintiff’s and defendant’s silverware designs in 284 words of intricate detail before concluding that the differences were insignificant.⁸⁹

In its more recent en banc decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*, the Federal Circuit emphasized that the ordinary observer should assess

⁸⁵ *Id.* at 1243. For another example of courts’ split personality with regard to verbal descriptions of design patents, this time in the context of assessing ornamentality, see *PHG Techs., LLC v. St. John Cos.*, 469 F.3d 1361, 1363-68 (Fed. Cir. 2006).

⁸⁶ *Int’l Seaway Trading*, 589 F.3d at 1240 (“[T]he same tests must be applied to infringement and anticipation . . .”).

⁸⁷ 81 U.S. (14 Wall.) 511, 528 (1871). Until 2008, courts often supplemented the *Gorham* infringement standard for design patents with a “point of novelty” inquiry. Under this inquiry, the court was required to identify the features in the claimed design that made the design patentable over the prior art so as to focus the comparison between the accused product and the patented design on the presence or absence of those features. See generally Mark A. Lemley, *Point of Novelty*, 105 NW. U. L. REV. 1253 (2011) [hereinafter Lemley, *Point of Novelty*] (describing this test, and analyzing when assessment of the point of novelty is and is not appropriate in patent law). That approach did not require courts to offer a complete verbal description of the claimed design, but it did require identification and verbal description of the features that constituted the point of novelty. Indeed, the whole idea of the point of novelty test was to draw attention to those features in order to determine if they were present in the accused product. The Federal Circuit rejected the point of novelty test in *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc).

⁸⁸ *Gorham*, 81 U.S. (14 Wall.) at 528 (“Experts, therefore, are not the persons to be deceived . . . [Ordinary observers] are the principal purchasers of the articles to which designs have given novel appearances, and if they are misled, and induced to purchase what is not the article they supposed it to be, . . . the patentees are injured.”).

⁸⁹ *Id.* at 529-31.

similarity in light of the prior art, and it gave lower courts latitude to describe the designs verbally.⁹⁰ According to the Federal Circuit, “a court may find it helpful to point out, either for a jury or in the case of a bench trial by way of describing the court’s own analysis, various features of the claimed design as they relate to the accused design and the prior art,” and as a result, a district court’s “relatively detailed claim construction will not be reversible error.”⁹¹ Indeed, in another case the Federal Circuit approved a district court’s claim construction that filtered out a hammer design’s unprotectable functional aspects before comparing the accused product to the patented design, rather than merely comparing the hammer designs holistically.⁹²

There are at least two related reasons for courts’ frequent verbal descriptions of designs notwithstanding doctrinal rules that purport to elevate the design patent drawings above all else. First, many design patent validity and infringement doctrines require analysis of particular design features, and application of those doctrines encourages—if it doesn’t implicitly demand—verbal elaboration. In particular, despite their legitimate concerns about disaggregation leading decisionmakers to undervalue a design’s overall creativity, courts must also appropriately define the scope of a party’s rights in the design, and they cannot do that without accounting in some way for unprotectable features.⁹³ Second, courts have to offer reasons for their rulings, and they feel at home in words and much less so in pictures.⁹⁴

⁹⁰ 543 F.3d at 665.

⁹¹ *Id.* at 679–80.

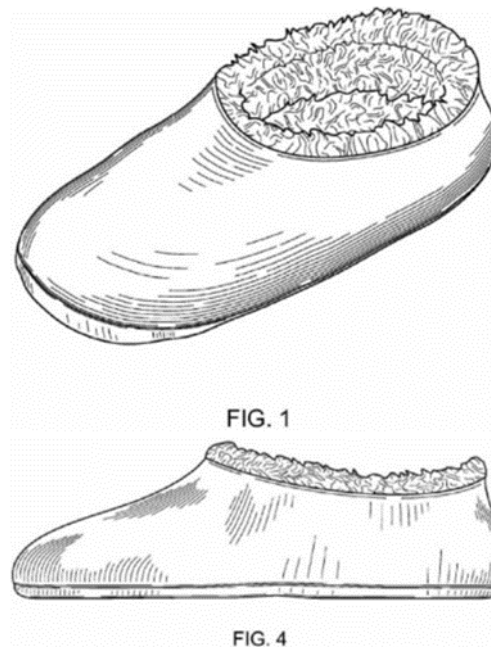
⁹² *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293–94 (Fed. Cir. 2010). Later decisions, however, have faulted lower courts for eliminating such features, suggesting that lower courts can highlight functional features but cannot fully filter them out. *See, e.g.*, *Sports Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1321–22 (Fed. Cir. 2016) (rejecting the district court’s claim construction for filtering out functional aspects of a design for a personal flotation device despite those aspects being functional and despite emphasizing that the functional aspects cannot form any part of the claim scope); *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1334 (Fed. Cir. 2015) (agreeing that the “trigger, torque knob, and activation button elements of the [claimed surgical instrument] have functional aspects,” but holding that “the district court’s construction of the Design Patents . . . hav[ing] no scope whatsoever fails to account for the particular ornamentation of the claimed design”).

⁹³ *Cf.* Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 717–19 (2012) [hereinafter Tushnet, *Worth a Thousand Words*] (making a similar observation about courts’ treatment of visual works under copyright law).

⁹⁴ *See, e.g.*, *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1332 (Fed. Cir. 2014) (emphasizing that “the purpose of requiring district courts to describe the claimed design in words is so that the parties and appellate courts can discern the trial court’s reasoning in identifying a primary reference” for assessing nonobviousness); *infra* subsection II.B.3; *cf.* Tushnet, *The Eye Alone*, *supra* note 78, at 417 (“The written description does at least attempt to create a reviewable record and to ask questions that can sometimes be answered on summary judgment. As with copyright infringement, the ordinary observer test makes design patent infringement findings harder to review and analyze; as gestalts, they are difficult to dissect.”).

A pervasive level-of-generality issue further complicates the role of verbal description. Consider, for example, a recent case involving a patented slipper design in which the Federal Circuit criticized the district court for characterizing the design as one for “slippers with an opening for a foot that can contain a fuzzy (fleece) lining and have a smooth outer surface.”⁹⁵ According to the Federal Circuit, that description, which was to be used in assessing nonobviousness, “represent[ed] too high a level of abstraction by failing to focus on the distinctive visual appearances of . . . the claimed design.”⁹⁶ Specifically, the district court failed to “add sufficient detail to its verbal description of the claimed design to evoke a visual image consonant with th[e claimed] design,”⁹⁷ pictured in Figure 7.

Figure 7: Slipper Design Patent Claim⁹⁸



⁹⁵ High Point Design LLC v. Buyers Direct, Inc., 730 F.3d 1301, 1314 (Fed. Cir. 2013) (internal quotation marks omitted).

⁹⁶ *Id.* (quoting Apple v. Samsung, 678 F.3d 1314, 1332 (Fed. Cir. 2012) (ruling similarly with respect to a district court’s description of an iPad design patent as “a rectangular tablet with four evenly rounded corners and a flat back”)).

⁹⁷ *Id.*

⁹⁸ *Id.* at 1305.

In another case, however, the Federal Circuit accepted the level of generality at which the district court described the similarities and differences between the claimed design of a football jersey for dogs and the purported primary prior art reference, depicted in Figure 8.⁹⁹ The district court had identified three differences: “(1) the patented design has a V-neck collar where the Eagles jersey has a round neck; (2) the patented design contains an interlock fabric panel on the side portion of the design rather than mesh; and (3) the patented design contains additional ornamental surge stitching on the rear portion of the jersey.”¹⁰⁰ In terms of similarity, the district court emphasized that both designs have “an opening at the collar portion for the head, two openings and sleeves stitched to the body of the jersey for limbs, and a body portion on which a football logo is applied.”¹⁰¹ Likewise, “the Eagles jersey is made ‘primarily of a mesh and interlock fabric,’ and ‘it contains at least some ornamental surge stitching,’ both elements found in the prior art reference.”¹⁰²

Figure 8: Design Patent Claim for Football Jersey for Dogs and Eagles Jersey Primary Reference¹⁰³



⁹⁹ *MRC Innovations*, 747 F.3d at 1332.

¹⁰⁰ *Id.*

¹⁰¹ *Id.* at 1333.

¹⁰² *Id.* Notably, the Federal Circuit thought that, in light of the district court’s description of similarities and differences, its failure to translate the claimed design into a verbal description was excusable. *Id.* at 1332.

¹⁰³ *Id.* at 1328–30.

Why was the district court's description of the differences between the designs in the latter case appropriate, while the court's description in the former case was "at too high a level of generality"? No principles are evident.

Three key features of design patent claiming emerge from this review. First, with regard to timing, designs are claimed in the design patent application, typically prior to and independently of any disputes with potential infringers. In fact, design patent claims can become public, upon patent issuance, even before the patentee's associated product arrives on the market.¹⁰⁴

Second, the scope of design patent rights is, at least formally, determined by the design patent drawings. Those drawings set out both claimed and unclaimed matter by use of solid and broken lines, respectively. Despite design patent law's emphasis on visual claims over verbal descriptions, case law makes clear that verbal description plays an inescapable role in design patent jurisprudence. The role of verbal description, however, is seriously complicated by the unpredictability of the level of generality at which a visual claim should be described.

Third, design patent claims are best categorized as central claims by exemplar. In previous work, one of us proposed that claims to intellectual property can be classified along two dimensions: peripheral versus central, and by characteristic versus by exemplar.¹⁰⁵ Peripheral claiming entails delineating the metes and bounds of the set of protected creations, while central claiming involves setting out some—but not necessarily all—members of that set.¹⁰⁶ Claiming by characteristic "requires a description of the essential properties of the set's members," whereas claiming by exemplar "entails enumerating particular members of the set of protected embodiments."¹⁰⁷

Because design patent claims are principally visual and singular rather than comprised of verbal lists of design characteristics, those claims are by

¹⁰⁴ In fact, there are websites dedicated to reporting on industries' or companies' issued design patents, sometimes for products that have not yet appeared on the market. See, e.g., *Apple Was Granted 4 Design Patents Today Covering HomePod, an Apple Store Room and More*, PATENTLY APPLE (Mar. 13, 2018), <http://www.patentlyapple.com/patently-apple/2018/03/apple-was-granted-4-design-patents-today-covering-homepod-an-apple-store-room-and-more.html> [<https://perma.cc/PKS7-G9HZ>] (revealing Apple designs for a retail space, home speaker, laptop device, and charger); *Apple Wins Design Patents for Chicago's Newest Apple Store and a MacBook with Back Edge USB-C Port*, PATENTLY APPLE (Sept. 12, 2017), <http://www.patentlyapple.com/patently-apple/2017/09/apple-wins-design-patents-for-chicagos-newest-apple-store-and-a-macbook-with-back-edge-usb-c-port.html> [<https://perma.cc/TMC7-8N7Z>] (reporting on the design patent granted to Apple for its storefront in Chicago, among others).

¹⁰⁵ Fromer, *Claiming*, *supra* note 26, at 724-30; cf. Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction*, 157 U. PA. L. REV. 1743, 1783-87 (2009) [hereinafter Burk & Lemley, *Fence Posts*] (exploring peripheral versus central claiming with regard to utility patents).

¹⁰⁶ Fromer, *Claiming*, *supra* note 26, at 726-27.

¹⁰⁷ *Id.* at 727.

exemplar. That is, one must determine the design's important features or characteristics from the design's visual depiction.

It might seem that design patent claims are peripheral because the designer drafts her claim to demarcate the bounds of her creation and patent infringement is determined by reference to that claim.¹⁰⁸ But in light of the infringement standard, the precise contours of a design patent claim do not strictly limit the scope of a party's rights. Under *Gorham*, an accused design infringes a patented design if "an ordinary observer, giving such attention as a purchaser usually gives, [would find the] two designs . . . substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other."¹⁰⁹ That test permits factfinders to find infringement when features depicted in the design patent claim are absent from the defendant's design, or when features absent from the design patent claim are present in the defendant's design, so long as the defendant's product is similar enough to the claimed design that an ordinary observer would deem them substantially the same.¹¹⁰ Therefore, we think design patent claims are better categorized as central rather than peripheral claims.

These features of design patent claiming are distinctive. We return to how these features affect the design patent regime after describing how parties claim design in trademark law and copyright law.

B. Trade Dress Claiming

Product design and product packaging are protectable as trade dress, which, under modern law, is a species of trademarks.¹¹¹ Unlike design patent rights, trademark rights arise through use rather than registration.¹¹² Thus, while the Lanham Act creates procedures for federal registration of marks,¹¹³

¹⁰⁸ Cf. Burk & Lemley, *Fence Posts*, *supra* note 105, at 1744-46 (analyzing utility patent law as having peripheral claiming); Fromer, *Claiming*, *supra* note 26, at 721-23 (same).

¹⁰⁹ See *supra* text accompanying note 87.

¹¹⁰ Design patent jurisprudence further confirms that claims are central. In one case involving two design patents, one for a windshield design with four holes and one for one with no holes, the Federal Circuit ruled that "[c]laiming different designs does not necessarily suggest that the territory between those designs [here, windshield designs with one to three holes,] is also claimed." *Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 704 (Fed. Cir. 2014). Yet, the court continued, the design patents might cover three-holed windshield designs if they are sufficiently similar. See *id.* at 705.

¹¹¹ See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209-16 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773-74 (1992).

¹¹² 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 16:18 (5th ed. 2018) (quoting *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017)).

¹¹³ 15 U.S.C. § 1052 (2012).

unregistered marks are enforceable under federal law on substantially the same terms as registered marks.¹¹⁴

Like all trademarks, to be protectable, trade dress must be used in commerce in a way that “identif[ies] and distinguish[es] [a party’s goods] from those manufactured or sold by others and . . . indicate[s] the source of the goods, even if that source is unknown.”¹¹⁵ As we noted above, product packaging is capable of being considered inherently distinctive, but product design is only protectable if it has acquired secondary meaning.¹¹⁶ Moreover, trade dress features are not protectable to the extent they are functional, meaning they are “essential to the use or purpose of the article or . . . affect[] the cost or quality of the article.”¹¹⁷

There are several distinguishing features of trademark claiming. One is a function of the fact that trademark rights are not rights in gross; that is, those rights exist only in relation to the goods or services with which they are used.¹¹⁸ While trademark rights may be enforced against a somewhat broader range of uses, the rights remain anchored by the claimant’s use.¹¹⁹ As a result, unlike patent rights, trademark claims are two dimensional: a party claims a particular trademark in relation to particular goods or services.

Both of those dimensions matter because the scope of a party’s trademark rights is determined by assessment of likelihood of confusion through a multifactor test that measures both the similarity of the *marks* at issue and the similarity of the *goods*.¹²⁰ Even in cases involving identical goods, use of a mark does not infringe if it is sufficiently dissimilar from the plaintiff’s

¹¹⁴ See *id.* §§ 1114, 1125(a). Indeed, many (perhaps most) trademarks are not registered. Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945, 961-62 (2018).

¹¹⁵ 15 U.S.C. § 1127. Likewise, under a more recent addition to the law, they are protectable if a person has a “bona fide intention to use [them] in commerce and applies to register [them] on the principal register established by [federal law].” *Id.*

¹¹⁶ *Supra* text accompanying notes 38–40.

¹¹⁷ *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001).

¹¹⁸ See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 & n.6 (2d Cir. 1976) (emphasizing that classification is product specific, and that “a term that is in one category for a particular product may be in quite a different one for another,” using the example of Ivory, which “would be generic when used to describe a product made from the tusks of elephants but arbitrary as applied to soap”).

¹¹⁹ See Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 909 (2017) [hereinafter Tushnet, *Registering Disagreement*] (noting that although registration requires careful identification of the specimen on which the registrant is using the trademark, trademark rights are not necessarily limited to the goods or services for which the mark is registered).

¹²⁰ Each circuit has its own multifactor test. The tests overlap substantially, however, and all of them consider the similarity of the parties’ marks and the similarity of goods, among other factors. See, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

mark.¹²¹ Nor is use of an identical mark necessarily infringing if it is for distinct goods or services.¹²² For example, PANDORA for internet radio can coexist with PANDORA for jewelry.¹²³ That kind of coexistence is not the exception but the rule, and the list of coexisting marks could be expanded dramatically if we included marks with the same dominant portion and different generic or descriptive additions: DELTA DENTAL, DELTA FAUCET, and DELTA AIRLINES; and APPLE COMPUTERS, APPLE RECORDS, and APPLE VACATIONS.¹²⁴

Two other distinguishing features of trademark claiming—relating to the timing and format of claims—are consequences of the fact that federal law protects both registered and unregistered marks.¹²⁵ In terms of timing, for marks that are registered, the particular form of the mark must be claimed in the application, likely independent of any particular dispute with an alleged infringer.¹²⁶ Unregistered marks, on the other hand, are never formally claimed in any fixed format and ultimately are defined for purposes of an assertion of rights, and then perhaps not even fully.

That timing difference affects the format of claims, as the PTO has developed detailed and extensive rules governing the depiction of a mark in a trademark application.¹²⁷ Specifically, the PTO requires applicants to include a verbal description of the mark when the claimed mark (1) contains a design element; (2) is three dimensional or a configuration of goods or packaging; (3) includes broken lines to show position or placement or to indicate that a portion of the product or packaging is not part of the mark; or (4) includes color.¹²⁸ These verbal descriptions must be quite detailed. Indeed, the Trademark Manual of Examining Procedure suggests the

¹²¹ See Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More Than the Weak?*, 92 N.Y.U. L. REV. 1339, 1356-60 (2017) (classifying doctrine in this regard).

¹²² See *id.* at 1357 (“The hard cases . . . arise . . . where the facts present similar marks or competing (or related) goods.”).

¹²³ PANDORA, Registration No. 3,173,558; PANDORA, Registration No. 3,613,181.

¹²⁴ *E.g.*, DELTA DENTAL, Registration No. 1,760,270; DELTA AIR LINES, Registration No. 970,418; DELTA, Registration No. 2,583,761; APPLE, Registration No. 1,078,312 (registering Apple for computers and computer programs); APPLE VACATIONS, Registration No. 1,462,268 (listing goods and services as travel agency services).

¹²⁵ See *supra* note 112 and accompanying text.

¹²⁶ See 15 U.S.C. § 1051(a)(2) (2012) (requiring, as part of the application to register, “a drawing of the mark” and a specification of “the goods in connection with which the mark is used”); *id.* § 1052(b)(2) (requiring a drawing and a description of the goods in connection with which a party has a bona fide intention to use a mark).

¹²⁷ U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE §§ 807-08 (8th ed. Oct. 2017) [hereinafter TMEP].

¹²⁸ *Id.* § 808.01.

following very long and excruciatingly detailed description of the stylized mark depicted in Figure 9:

Figure 9: Trademark Manual of Examining Procedure Exemplary Trademark¹²⁹



The mark consists of a red background; the stylized word “HOSPITAL” in white letters outlined in black with the letter “S” in the form of a dollar sign and letter “L” in the form of a cast; a man with red hair in a green gown with an orange and silver stethoscope and silver headband mirror; man wearing a blue cap, gown and mask with silver scissors; silver medical tree with white, pink, and gold intravenous pouch, fluid and tube; gray and gold crutch; nurse with yellow hair wearing pink clothing and brown clip board; orange and black scale with an orange man wearing purple pants and orange robe; nurse with yellow hair and white clothing pushing a wheelchair with a man in green clothing with white cast and gold cane; white and blue bed pan; yellow and black buildings and white signs with stylized words “EMERGENCY HOSPITAL” in black, and green vegetation; white and pink emergency vehicle with purple tires; a green air tank, orange stretcher, green golf club bag with white balls and pink clubs; nurse with yellow hair and blue clothing holding a white syringe with pink fluid; and an orange man dressed in blue with a white and red thermometer.¹³⁰

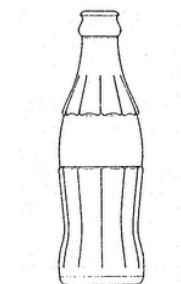
Despite this formal requirement, many registrations of trade dress lack any meaningful verbal description. As an example, consider the registration of the iconic Coca-Cola bottle design, shown below in Figure 10. The registration depicts the bottle, but it includes only the meager description that “the mark consists of the three-dimensional configuration of the distinctive bottle as shown.”¹³¹

¹²⁹ *Id.* § 808.02.

¹³⁰ *Id.*

¹³¹ Registration No. 1,057,884.

Figure 10: Registered Coca-Cola Bottle Design¹³²



In addition to rules regarding the form of the mark depicted in the application and verbal descriptions, use-based applications must be accompanied by a specimen of use, and that specimen must demonstrate use of the mark for which registration is sought.¹³³ That requirement is supposed to assure a reasonably tight relationship between registration and use because the applicant must show that it is actually making use of the mark for which it seeks registration and is not merely trying to reserve the mark.¹³⁴

An application to register a mark typically claims the mark independently of any particular dispute. While the form of the mark for which registration is sought is strategic in the sense that, to the extent possible, the applicant depicts and describes the mark so as to capture anticipated variations that the applicant would regard as infringing, it is nearly impossible for an applicant to claim with the full range of potential uses in mind.

Registered marks stand in sharp contrast to unregistered ones, which are never formally claimed before a dispute. Obviously, unregistered marks are used in some particular format, so the use itself provides a kernel of notice as to the scope of a party's rights. But that notice can be highly imperfect, particularly in the context of composite marks (ones with many components),

¹³² *Id.*

¹³³ TMEP, *supra* note 127, § 904. The same is ultimately true of applications based on intent to use because those applications will have to be supported by a statement of use and a specimen reflecting use of the mark in the format for which registration was sought. *Id.* §§ 1104, 1109.

¹³⁴ Yet a party need not always submit a specimen showing use of the mark in the identical form for which registration is sought. Standard-character marks are understood to encompass all stylizations of the mark. *Id.* § 1207.01(c)(iii). Thus, if a party applies to register the mark in standard-character form, use of that word mark in any format will support the application. Applications to register marks in stylized form, however, must be supported by specimens showing use of the mark in that form. *Id.* § 807.04(b). That constraint operates even more powerfully on product packaging and design, for which there is no real analogy to the standard-character mark. There is less flexibility along the goods and services dimension because the specimen must show use in relation to the claimed goods and services.

a category that would include most trade dress. *Two Pesos*¹³⁵ is illustrative here: because Taco Cabana was not required to claim its trade dress independently of its dispute with Two Pesos, it would have been difficult to tell before the dispute whether color was an important part of the “not formally claimed” restaurant design. This problem is especially serious in the context of design because protectable designs may include many features that are unprotectable on their own but are protectable as part of the composite.¹³⁶ It is therefore often difficult to determine which features are important in defining the scope of a party’s rights.¹³⁷

This notice problem persists even for registered marks because it turns out that, despite the intricate rules governing a mark’s description in a trademark application, the specific form of the registration is mostly unimportant at the infringement stage. While the existence of a registration confers a presumption of validity, courts evaluating likelihood of confusion rarely pay attention to the form of registration, or even to the identified goods or services.¹³⁸ Instead, courts focus on consumer understanding of a mark as used in the marketplace because consumer understanding is more relevant to potential consumer confusion.¹³⁹

*Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*¹⁴⁰ is the exception that proves the rule. In that well-known case, Christian Louboutin objected to Yves Saint Laurent’s use of a red-lacquered sole on its monochromatic red shoes.¹⁴¹ Louboutin owned a registration for “a red lacquered outsole on footwear,” as depicted in Figure 11.¹⁴² Louboutin’s description made clear that “the dotted lines [were] not part of the mark but [were] intended only to show placement of the mark.”¹⁴³

¹³⁵ See *supra* text accompanying notes 8–14.

¹³⁶ See *Groeneveld Transp. Efficiency, Inc. v. Lubecore Int’l, Inc.*, 730 F.3d 494, 527 (6th Cir. 2013) (noting the problem of “overall appearance” in the context of protectable trade dress); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1535–37 (11th Cir. 1986) (demonstrating that colors like royal blue and materials like silver foil, although not individually protectable, may be protectable as a composite); *Best Cellars Inc. v. Grape Finds at Dupont, Inc.*, 90 F. Supp. 2d 431, 451 (S.D.N.Y. 2000) (reiterating that while each element of trade dress individually may lack distinctiveness, the combination of elements may be sufficiently distinctive to merit protection); Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ. ST. L.J. 1033, 1048–49 (2009) (arguing that “even for the highly stylized mark, the composite mark doctrine affords protection only for the design, not for the underlying descriptive word(s)”).

¹³⁷ For a general discussion of the problem of determining the scope of a mark owner’s rights when the mark at issue includes unprotectable matter, see Lemley & McKenna, *Scope*, *supra* note 28.

¹³⁸ See Tushnet, *Registering Disagreement*, *supra* note 119, at 909 (citing relevant cases).

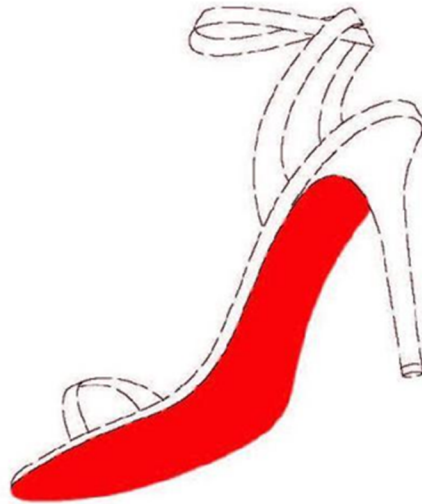
¹³⁹ *Id.*

¹⁴⁰ 696 F.3d 206 (2d Cir. 2012).

¹⁴¹ *Id.* at 213.

¹⁴² Registration No. 3,361,597.

¹⁴³ *Id.*

Figure 11: Illustration from Christian Louboutin Trademark Registration¹⁴⁴

Rather than emphasizing the form of the registration (which notably did not explicitly limit the mark to a *contrasting* red sole), the Second Circuit focused on Louboutin's actual advertising and use, which it believed demonstrated that secondary meaning existed only with respect to red-lacquered soles on shoes in a contrasting color.¹⁴⁵ Indeed, rather than defining Louboutin's rights by reference to the form of its registration, the court ordered the PTO to amend the registration to make it conform to consumer understanding.¹⁴⁶ As a consequence, the corrected registration now describes the mark as "consist[ing] of a red lacquered outsole on footwear that contrasts with the color of the adjoining ('upper') portion of the shoe" (though the broader original illustration remains).¹⁴⁷

Even after the Second Circuit's decision, the precise scope of Louboutin's rights with regard to red-lacquered soles remains underspecified. It's not only

¹⁴⁴ *Id.*

¹⁴⁵ *Christian Louboutin*, 696 F.3d at 227-28.

¹⁴⁶ *Id.* at 228.

¹⁴⁷ Registration No. 3,361,597. Christian Louboutin's ability to obtain rights in its red-lacquered soles has been contested, sometimes successfully, in other jurisdictions. Compare *Christian Louboutin's Red Sole Is Not a Valid Trademark in India*, FASHION LAW, (July 18, 2018), <http://www.thefashionlaw.com/home/christian-louboutins-red-sole-is-not-a-valid-trademark-in-india> [https://perma.cc/7KMK-NDDT] (reporting on the High Court of Delhi's judgment against Louboutin), with Eleonora Rosati, *BREAKING: CJEU Rules that Louboutin Red Sole Mark Does NOT Fall Within Absolute Ground for Refusal*, IPKAT, June 12, 2018, <http://ipkitten.blogspot.com/2018/06/breaking-cjeu-rules-that-louboutin-red.html> [https://perma.cc/QLW5-AVV4] (noting that the European Union's Court of Justice held that "a mark consisting of a colour applied to the sole of a shoe is not covered by the prohibition of the registration of shapes").

that consumer perceptions can change over time such that rights dependent on secondary meaning can evolve, but also that legal actors decide scope iteratively in the context of particular disputes. For purposes of resolving Louboutin's claim against Yves Saint Laurent, the court needed to determine Louboutin's rights only as against monochromatic women's pumps with a red-lacquered sole. It could do that by emphasizing one particular aspect of Louboutin's mark: that the sole contrasts with the upper part of the shoe.¹⁴⁸ But, of course, that leaves unanswered questions regarding Louboutin's rights with respect to use of red-lacquered soles on women's flat shoes or men's shoes with a contrasting upper, even though Louboutin also sells both types of shoes.¹⁴⁹ Louboutin's registration is itself ambiguous; it claims the mark for "women's high fashion designer footwear," which would seem to cover flat shoes, but the drawing depicts a pump (albeit with broken lines).¹⁵⁰

Figure 12: Christian Louboutin Greggo Flat Shoe¹⁵¹



¹⁴⁸ Notably, it is not even clear why the court was so confident that emphasizing the contrasting upper was sufficient to resolve the case without a likelihood-of-confusion analysis. *Christian Louboutin*, 696 F.3d at 228. Infringement does not require use of an identical mark. *See, e.g., Streamline Prod. Sys., Inc. v. Streamline Mfg., Inc.*, 851 F.3d 440, 454 (5th Cir. 2017) (noting that "the more similar the marks, the greater likelihood of confusion," though the marks may be distinguishable). Therefore, even if the Louboutin mark was properly limited to contrasting red soles, use of a red sole in other contexts could still be infringing. The Second Circuit did not even contemplate this possibility.

¹⁴⁹ An example of the latter is shown in Figure 12.

¹⁵⁰ Registration No. 3,361,597.

¹⁵¹ *Greggo Flat*, CHRISTIAN LOUBOUTIN, http://us.christianlouboutin.com/us_en/shop/men/greggo-flat.html [<https://perma.cc/J5X5-6GZ9>] (last visited Sept. 30, 2018).

These questions are far from academic, as other designers have used red on various shoe components that are arguably infringing, as shown in Figure 13.

Figure 13: Stuart Weitzman Women's Shoe (Left) and Burberry "Splash Sole" (Right)¹⁵²



Courts have often demonstrated sensitivity to notice concerns in cases involving unregistered trade dress and have therefore required trade dress claimants to describe their trade dress verbally, usually in the complaint.¹⁵³ Images alone are routinely deemed insufficient,¹⁵⁴ and even combinations of

¹⁵² *Shoes*, FASHION CAPE, http://thefashioncape.com/gallery_categories/shoes/ [<https://perma.cc/L4RD-6B6U>] (last visited Sept. 30, 2018); *Burberry Splash Sole Shoes in Bordeaux*, LYST, <https://www.lyst.com/shoes/burberry-splash-sole-shoes-bordeaux/> [<https://perma.cc/GA3N-XS4C>] (last visited Sept. 30, 2018).

¹⁵³ See, e.g., *Gen. Motors Corp. v. Lanard Toys, Inc.*, 468 F.3d 405, 415 (6th Cir. 2006) (noting that the elements of the trade dress should be identified); *Tumblebus Inc. v. Cranmer*, 399 F.3d 754, 768 (6th Cir. 2005) ("To recover for trade-dress infringement under § 43(a) of the Lanham Act, a party must first identify what particular elements or attributes comprise the protectable trade dress."); *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 634 (6th Cir. 2002) (requiring that the elements of the trade dress be identified separately). But see *Invisaflo, LLC v. Euramax Int'l, Inc.*, No. 14-3026, 2015 WL 11562084, at *3 (N.D. Ga. Aug. 4, 2015) (finding that the Eleventh Circuit does not impose a verbal-articulation requirement, but that the plaintiff's description would have sufficed under the Second Circuit's more difficult standard); *Kee Action Sports LLC v. Valken, Inc.*, No. 12-6069, 2013 WL 6633439, at *5-7 (D.N.J. Dec. 17, 2013) (stating that the Third Circuit does not require verbal description and finding that the plaintiff "sufficiently pled the nature of the claimed trade dress to satisfy the notice requirements of Federal Rule of Civil Procedure 8").

¹⁵⁴ See, e.g., *Tracey Tooker & TT Ltd., Inc. v. Whitworth*, 212 F. Supp. 3d 429, 434 (S.D.N.Y. 2016) ("Although Tooker has submitted numerous photos of her hats, the Court cannot distill the distinctive elements of [Tooker]'s trade dress from a collection of photos."); *Oban US, LLC v. Nautilus, Inc.*, No. 13-1076, 2014 WL 2854539, at *9 (D. Conn. June 23, 2014) ("[T]he mere attachment of brochures [and] photographs . . . to the Amended Complaint is not sufficient, as courts cannot be expected to distill from a set of images those elements that are common to a line

images and verbal descriptions are often not enough if they do not collectively identify the protectable elements of the trade dress.¹⁵⁵

There is, however, no consistency regarding the level of generality at which courts enforce this requirement. In *Landscape Forms, Inc. v. Columbia Cascade Co.*,¹⁵⁶ the Second Circuit rejected as too abstract a description of site furniture that “incorporates large three-inch tubing, with a powdered cosmetic finish, bent in gentle turns that roll around the perimeter of the furniture which in combination with the various seating surfaces gives the viewer a floating or suspended feeling.”¹⁵⁷ This description and various statements by Landscape’s witnesses “fail[ed] to indicate what unique combination of features ma[de] the trade dress of the ten items in the Petoskey line inherently distinctive.”¹⁵⁸ According to the court, “[a] claim for site furniture which is at once massive, yet appears to float, is too abstract to qualify as trade dress If the law protected style at such a level of abstraction, Braque might have prevented Picasso from selling cubist paintings in the United States.”¹⁵⁹

In *Premium Balloon Accessories, Inc. v. Creative Balloons Mfg., Inc.*,¹⁶⁰ however, the Sixth Circuit accepted Premium’s description of its balloon weight trade dress because “Premium provided pictorial representations of its trade dress and emphasized the weight (80-100 grams), shape (five-pointed star), colors (primary), and size of its weight, among other factors.”¹⁶¹ Though

of products and both distinctive and nonfunctional.” (internal quotations omitted)); *Weber-Stephen Prods. LLC v. Sears Holding Corp.*, No. 13-1686, 2013 WL 5782433, at *4 (N.D. Ill. Oct. 25, 2013) (“Weber’s cited cases . . . do not support its position that including pictures of its grills in its complaint, without detailed description, is enough.”); *Heller Inc. v. Design Within Reach, Inc.*, No. 09 Civ.1909 (JGK), 2009 WL 2486054, at *6 (S.D.N.Y. Aug. 14, 2009) (“[I]mages alone do not satisfy the plaintiff’s obligation to articulate the distinctive features of the trade dress.”). In some cases, parties do not even attempt to identify the particular features of their trade dress but simply refer to images in a design patent and gesture vaguely at the existence of a trade dress. *See, e.g.*, *Original Complaint at 1, 3, Snap-On Inc. v. Harbor Freight Tools USA, Inc.*, No. 16-1265 (E.D. Wis. Sept. 21, 2016) (demonstrating that the plaintiff attached images of their product but failed to explicitly describe the trade dress).

¹⁵⁵ *See, e.g.*, *Homeland Housewares, LLC v. Euro-Pro Operating LLC*, No. 14-03954, 2014 WL 6892141, at *3 (C.D. Cal. Nov. 5, 2014) (“Plaintiffs argue that they have sufficiently described their trade dress because they have provided a photograph . . . and have provided a written description This description and the photograph alone do not sufficiently identify the particular elements of the packaging they seek to protect.”); *Mike Vaughn Custom Sports, Inc. v. Piku*, 15 F. Supp. 3d 735, 747 (E.D. Mich. 2014) (“[T]he description of the graphics describe the design as functional The Court cannot evaluate what the plaintiff considers non-functional if the only factual allegations describe the product design’s myriad functional purposes The images do not rescue plaintiff’s trade dress claim . . .”).

¹⁵⁶ 113 F.3d 373 (2d Cir. 1997).

¹⁵⁷ *Id.* at 381.

¹⁵⁸ *Id.* at 381-82.

¹⁵⁹ *Id.* at 382.

¹⁶⁰ 573 F. App’x 547 (6th Cir. 2014).

¹⁶¹ *Id.* at 553.

the court acknowledged that “Premium’s articulation of its trade dress could have been more precise—for example, Premium should have stated the size of its weight,” it found the description adequate.¹⁶²

In other cases, courts have accepted the plaintiffs’ descriptions without discussion¹⁶³ or have crafted their own descriptions based on the evidence presented.¹⁶⁴ One consequence of this inconsistency is that, despite courts’ motivation to improve notice, the descriptions parties offer frequently do not meaningfully identify the protectable features of the trade dress.¹⁶⁵ That can be true even when the description is long because length doesn’t always correspond to specificity; indeed, parties often use length to disguise generality. Here, for example, is Yeti’s very long, but extremely general, description of its trade dress in its complaint against Blackbird Products Group:

YETI’s trade dress rights in the designs and appearances of the Roadie® and Tundra® coolers include, but are not limited to, the visual flow of the Tundra® and Roadie® coolers, the curves and lines in the Tundra® and Roadie® coolers, the design, style, and appearance of these curves and lines in the Tundra® and Roadie® coolers, the visual connection and relationship between one or more of the curves and lines in the Tundra® and Roadie® coolers, and the style, design, and appearance of one or more design aspects of the Tundra® and Roadie® coolers, including but not limited to the design and appearance of the style line on the front of the cooler; the design and appearance of the style line on the back of the cooler; the design and appearance of the style line on each side of the cooler; the design and appearance of the “duck-bill” tapered front corners of the cooler; the design and appearance of the inverted style line above the name plate and below the lid; the design and appearance of the ledge around the perimeter of the cooler; the design and appearance of the rope handles, the design and appearance of the front, side and rear design of the feet of the cooler; the placement, design and appearance of the slots on the side, front and rear of the cooler; the design and appearance of the latches; the design and appearance of the name plate and name plate lettering; the placement,

¹⁶² *Id.*

¹⁶³ *See, e.g.,* Groeneveld Transp. Efficiency, Inc. v. Lubecore Int’l, Inc., 730 F.3d 494, 503 (6th Cir. 2013) (noting the trade dress at issue without further elaboration); Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH, 289 F.3d 351, 354-56 (5th Cir. 2002) (same).

¹⁶⁴ *See, e.g.,* AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1536 (11th Cir. 1986) (noting the district court’s characterization of the trade dress of a Klondike Bar wrapper based on the evidence).

¹⁶⁵ *Cf. Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 117 (2d Cir. 2001) (noting that “a plaintiff’s inability to explain to a court exactly which aspects of its product design(s) merit protection may indicate that its claim is pitched at an improper level of generality, *i.e.*, the claimant seeks protection for an unprotectible style, theme or idea” (quoting *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997))).

design, and appearance of the name plate on the front between the two front style lines; and the color contrast, color combinations, and shapes of features of the cooler, whether these elements are alone or in any combination with each other, including the overall look and appearance of the Roadie® and Tundra® coolers.¹⁶⁶

The verbal-description requirement might constrain parties' claiming in some cases because a party that claims too broadly risks describing a trade dress for which it will have trouble satisfying trademark law's distinctiveness¹⁶⁷ and nonfunctionality requirements.¹⁶⁸ Indeed, at the extreme, courts sometimes do not even recognize vague or underspecified claims as identifying trade dress at all.¹⁶⁹ But that is atypical. More commonly, courts will construe the plaintiff's claims narrowly, so there is little downside to claiming broadly and strategically.¹⁷⁰

¹⁶⁶ Complaint at 5-6, *Yeti Coolers v. Blackbird Prods. Grp., LLC*, No. 15-1105 (W.D. Tex. Dec. 7, 2015).

¹⁶⁷ See, e.g., *Forney Indus., Inc. v. Daco of Mo.*, 835 F.3d 1238, 1253 (10th Cir. 2016) (noting that the plaintiff's description was too vague to satisfy the distinctiveness requirement); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 41-42 (1st Cir. 2001) (granting summary judgment because the plaintiff did not highlight elements to meet the distinctiveness requirement); *supra* text accompanying note 115.

¹⁶⁸ *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 79-82 (2d Cir. 1990) (noting that a defendant may avoid liability through the functionality doctrine, which includes an inquiry as to whether trade dress protection "will hinder competition or impinge upon the rights of others to compete effectively in the sale of goods"); see also *supra* text accompanying note 117. For a comparison in which a party's narrow claiming in the registration context saved it from a finding of functionality, see *In re Bottega Veneta Int'l, S.a.r.l.*, 2013 WL 5655822, at *1, *8-9 (T.T.A.B. Sept. 30, 2013) (finding a basket-weave pattern used on leather products nonfunctional because the plaintiff had narrowly described the mark as "a configuration of slim, uniformly-sized strips of leather, ranging from 8 to 12 millimeters in width, interlaced to form a repeating plain or basket weave pattern placed at a 45-degree angle over all or substantially all of the goods").

¹⁶⁹ See *Test Masters Educ. Servs., Inc. v. State Farm Lloyds*, 791 F.3d 561, 566-67 (5th Cir. 2015) (finding that plaintiff failed to assert a trade dress infringement claim despite allegations that defendant created a "confusingly similar" web site because the "alleged confusion . . . stems from the use of a similar service mark ('Testmasters'), and the false representation that TES offers a similar service (live LSAT courses offered nationwide)"); *Fair Wind Sailing, Inc. v. Dempster*, 764 F.3d 303, 309-11 (3d Cir. 2014) (dismissing the plaintiff's claim for trade dress infringement when it had claimed only (1) "a hodgepodge of unconnected pieces of its businesses, which together d[id] not comprise any sort of composite visual effect" and (2) "web design," without further specificity).

¹⁷⁰ See, e.g., *Toyo Tire & Rubber Co., Ltd. v. CIA Wheel Grp.*, No. 15-0246, 2016 WL 4992111, at *1-2, *3 n.3 (C.D. Cal. Sept. 15, 2016) (finding the plaintiff's trade dress nonfunctional after defining the claim to include only "the two-dimensional pattern created by the blocks—not the three dimensional structure created by the grooves between the blocks or the placement of thin shallow channels cut into the blocks known as sipes," despite the plaintiff's description of the trade dress as "the overall appearance of its . . . tires"); *Maker's Mark Distillery, Inc. v. Diageo N.A., Inc.*, 703 F. Supp. 2d 671, 680, 682-83 (W.D. Ky. 2010), *aff'd*, 679 F.3d 410 (6th Cir. 2012) (allowing the plaintiff to narrow the description of its trade dress to emphasize a red dripping wax seal after five years of litigation in which the plaintiff never claimed red as an element of the mark and despite a registration that made no reference to color).

Take the example of a recently filed case in which Lisa Frank, a company that makes stickers, school supplies, and other products for kids, sued Orb Factory, which sells similar products.¹⁷¹ A representative sampling of Lisa Frank's products is shown in Figure 14.

Figure 14: Lisa Frank Products¹⁷²



Compare these samples to the extraordinarily broad way Lisa Frank described its trade dress in its complaint:

the combination of some or all of the following elements, depending upon the product and its packaging, that create a unique overall image and distinct visual impression . . . (1) brightly colored bold graphics of distinctive animal characters depicted individually or grouped with one or more other such characters, with rainbow colored features, large eyes, and happy, friendly expressions; (2) use of brilliant, often rainbow sequenced, colors, graduated color sequences, and rainbow colors that fade into one another . . . ; (3) package, cover and product surface designs featuring, in addition to the distinctive animal characters, combinations of rainbows, flowers, ice cream cones, butterflies, birds, rabbits, fish, cupcakes, bubbles, peace symbols, random words, hearts, happy faces, and stars, often in groups including colorful backgrounds employing rainbow colors, color fades and Lisa [F]rank pink, props and landscape features such as trees, pools, and snow; and (4) product packaging incorporating the look and feel of the products.¹⁷³

¹⁷¹ First Amended Complaint at 6-7, *Lisa Frank, Inc. v. Orb Factory Ltd.*, No. 15-00433, 2017 WL 2655406 (D. Az. Sept. 16, 2015) (alleging that the defendant sells products that are “confusingly similar” to the plaintiff’s trade dress).

¹⁷² *Id.* at 7-8.

¹⁷³ *Id.* at 5.

Probably not incidentally, Orb Factory's products, particularly the ones Lisa Frank references in the complaint, generally appear as shown in Figure 15.

Figure 15: Orb Factory Products¹⁷⁴



In sum, it is difficult to characterize trade dress claiming given the differentiated claiming regimes for registered and unregistered marks. But three features stand out. First, regardless of the registration status of the trade dress at issue, courts focus primarily on consumer understanding and commercial context rather than the form of a registration. Specifically, independently of whether trade dress is registered, the scope of a party's rights will nearly always be determined by reference to a claim a mark holder makes in the course of litigation. Trade dress claiming is therefore generally done late and in the context of particular disputes, which enables strategic behavior. Moreover, any notice provided by use of the trade dress or by claims made in a registration is at best imperfect because later claims made in the context of litigation matter significantly more.¹⁷⁵

Second, trademark law generally emphasizes verbal claims over visual ones, as demonstrated by courts' threshold requirement of verbal description as a means for framing distinctiveness and functionality inquiries.¹⁷⁶ But the

¹⁷⁴ *Id.* at 7.

¹⁷⁵ As Rebecca Tushnet suggests, this need not be so. Courts could put greater emphasis on the form of a registration by requiring that they be more substantive, and in many cases such emphasis could actually constrain the scope of a party's rights. Tushnet, *Registering Disagreement*, *supra* note 119, at 929-40.

¹⁷⁶ Cf. Rebecca Tushnet, *Looking at the Lanham Act: Images in Trademark and Advertising Law*, 48 HOUS. L. REV. 861, 890-91 (2011) (commenting on the distrust of images in trademark law and the simultaneous under- and over-inclusiveness of the verbal-description requirement in trade dress litigation).

level-of-generality problem looms large here, just as it does in the design patent context. In particular, courts have no methodology for determining the level of generality at which parties must verbally describe their trade dress. As a result, the descriptions courts accept can vary wildly.

Finally, trade dress claims are best characterized in their varied forms as central claims, sometimes by characteristic and sometimes by exemplar. Claims in registration, via use in the marketplace, and in litigation—be they verbal or visual, early or late—tend to exemplify the trade dress rather than describe its periphery (whether with regard to the classes of goods or services to which protection extends or to the scope of the design itself).¹⁷⁷ When the claims come in the form of illustrations or use in the marketplace, they are by exemplar because others must discern the design's pertinent characteristics. By contrast, as the examples above demonstrate, the verbal descriptions provided to the PTO or to courts tend to be by characteristic, yet they are still central.

C. Copyright Claiming

Designs can also benefit from copyright protection, to the extent they constitute “original works of authorship fixed in a[] tangible medium of expression.”¹⁷⁸ For most works created after 1977, the copyright lasts for the author's lifetime plus seventy years.¹⁷⁹ Copyright owners hold several exclusive rights in relation to their works, including the right to reproduce the works, prepare derivative works based on them, and distribute copies.¹⁸⁰ These exclusive rights are violated not only by identical copying, but also by the making of substantially similar works.¹⁸¹ According to the Second Circuit, two works are considered substantially similar if “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.”¹⁸²

¹⁷⁷ See Fromer, *Claiming*, *supra* note 26, at 795-96 (“[A] trademark protects a set of marks. For example, holding the trademark for ‘Pledge’ furniture wax allows the holder to prevent others from using ‘Promise’ as a mark for furniture wax. Trademark claims—contained in registrations with the PTO—thus seem to be central. And they have a mix of exemplar claiming—the mark itself—and characteristic claiming—the sorts of goods and services to which the mark can be applied.” (footnote omitted)).

¹⁷⁸ 17 U.S.C. § 102(a) (2012).

¹⁷⁹ *Id.* § 302(a). Anonymous works, pseudonymous works, and works made for hire have a fixed term of either 95 years from the date of publication or 120 years from the date of creation, whichever expires first. *Id.* § 302(c).

¹⁸⁰ *Id.* § 106.

¹⁸¹ See, e.g., *Corwin v. Walt Disney Co.*, 475 F.3d 1239, 1253 (11th Cir. 2007); *Whitehead v. Paramount Pictures Corp.*, 53 F. Supp. 2d 38, 46 (D.D.C. 1999) (“[Plaintiff] has provided no direct evidence of copying, so he has the burden of establishing both substantial similarity and access.”)

¹⁸² *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001) (internal quotation marks omitted). When a plaintiff's work consists in part of public-domain elements, the Second Circuit further refines

Claiming in copyright law shares some features of design patent claiming and some of trademark claiming. It is like design patent claiming in that one claims one's work as is, not with regard to its later use or reception in the marketplace (as with trademark law).¹⁸³ But unlike design patent claiming and like trademark claiming, copyright typically does not require any "formal" claim beyond the work itself until a dispute occurs. Copyright does not require formal claims because works are protectable immediately upon fixation; formalities are not a prerequisite.¹⁸⁴ In that sense, as one of us has previously observed, "the copyrighted work stands in as a central claim by exemplar for the set of works that are substantially similar or derivative."¹⁸⁵ That is, the copyrighted work itself is used as the prototype against which all allegedly infringing works are compared to see if they share sufficient salient characteristics to fall within the scope of the copyright holder's rights.¹⁸⁶

Despite copyright law's ostensible rejection of formalities, registration is still encouraged and is a requirement for instituting an infringement action.¹⁸⁷ Unlike design patent and trademark applications, however, copyright applications are not meaningfully examined.¹⁸⁸ And unlike issued design patents and trademark registrations, copyright registrations do not contain any essential information about the claimed aspects of the copyrighted work; the registrations instead consist primarily of administrative data like information about the registrant, the work's title, its completion date, and publication date (if any).¹⁸⁹

Moreover, because the copyright infringement standard allows for findings of infringement based on partial or fragmented similarity,¹⁹⁰ the copyrighted work itself often gives very little insight about the particular

its test to require "substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed" work. *Id.* (internal quotation marks omitted).

¹⁸³ *Supra* Sections I.A–B. As we discuss below, infringement in both copyright and design patent laws is determined by reference to audience reaction, which complicates this understanding.

¹⁸⁴ See Fromer, *Claiming*, *supra* note 26, at 743–52 (analyzing copyright law as a system of claiming by exemplar, with some claiming by characteristic in licensing); Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 STAN. L. REV. 485, 539–45 (2004) [hereinafter Sprigman, *Reform(aliz)ing*] (discussing the U.S. move away from copyright formalities).

¹⁸⁵ Fromer, *Claiming*, *supra* note 26, at 748.

¹⁸⁶ *Id.* at 748–49.

¹⁸⁷ 17 U.S.C. § 408 (2012) (describing the procedures for registering copyright); *id.* § 411 (requiring registration as a prerequisite to a civil infringement action, with some exceptions).

¹⁸⁸ See Steven J. Horowitz, *Copyright's Asymmetric Uncertainty*, 79 U. CHI. L. REV. 331, 337–38 (2012) (explaining why copyright applications are not subject to extensive review).

¹⁸⁹ Fromer, *Claiming*, *supra* note 26, at 745 n.136.

¹⁹⁰ *Palmer v. Braun*, 287 F.3d 1325, 1330 (11th Cir. 2002) (noting that a larger work that copies "only a small part of the copyrighted work but do[es] so word-for-word" may still be found to infringe); see Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1268–72 (2014) [hereinafter Fromer & Lemley, *Audience*] (discussing courts' varying tests for substantial similarity); Lemley & McKenna, *Scope*, *supra* note 28, at 2231–39 (same).

claimed aspects of a work.¹⁹¹ As a result, copyright owners typically identify the protected characteristics of their works only in the context of litigation.¹⁹² As with trademark claiming for the first time in litigation, this claiming can be strategically targeted to cover the defendant's allegedly infringing works.

The lack of claiming methodology and resulting opportunity for strategic behavior can lead to a free-for-all in copyright claiming. As just one example, consider the Supreme Court's recent *Star Athletica, L.L.C. v. Varsity Brands, Inc.*¹⁹³ decision, which focused on copyright law's useful articles doctrine. Varsity Brands sued Star Athletica for infringing five cheerleading uniform designs.¹⁹⁴ The Varsity Brands design team originally sketched those designs on paper, later producing at least two completed uniforms based on the designs. Varsity Brands then registered a copyright in each of the five designs.¹⁹⁵ It registered three of the designs as "2-dimensional artwork," for which it submitted sketches as deposit copies; the other two it registered as "2-dimensional artwork" in the nature of "fabric design (artwork)," submitting for each a photograph of a completed uniform incorporating the design.¹⁹⁶ One of the registration submissions is depicted in Figure 16.

¹⁹¹ Fromer, *Claiming*, *supra* note 26, at 782-83.

¹⁹² *Id.*

¹⁹³ 137 S. Ct. 1002 (2017).

¹⁹⁴ *Id.* at 1007.

¹⁹⁵ *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 WL 819422, at *2 (W.D. Tenn. Mar. 1, 2014), *rev'd*, 137 S. Ct. 1002 (2017).

¹⁹⁶ *Id.*

Figure 16: One of Varsity Brands' Claimed Cheerleading Uniform Designs¹⁹⁷



In its complaint, Varsity Brands included photographs of the allegedly infringing designs from Star Athletica's catalog. For example, it asserted that Star Athletica's design shown in Figure 17 infringed Design 078 in Figure 16.

Figure 17: Star Athletica's Allegedly Infringing Design¹⁹⁸



¹⁹⁷ Joint Appendix at 32, *Varsity Brands, Inc. v. Star Athletica, L.L.C.*, 799 F.3d 468 (6th Cir. 2015) (No. 15-866) [hereinafter *Star Athletica* Joint Appendix], 2016 WL 3924018.

¹⁹⁸ *Id.* at 33.

Note that Star Athletica's allegedly infringing design is not identical to Varsity Brands'. Varsity Brands' side panels are white, whereas Star Athletica's are light blue. Both stripe patterns have the same colors, but the patterns themselves are different. The skirt designs are also different. Perhaps for this reason, Varsity Brands claimed its design holistically in the complaint, referring only to Design 078 depicted in Figure 16. At various points during the litigation, Varsity Brands referred verbally to the aspects of this design it thought were copyrightable: "the lines, stripes, coloring, angles, V's [or chevrons] and shapes and the arrangement and placement of those elements."¹⁹⁹ Varsity Brands almost certainly described its design at this high level of generality so that it would encompass non-identical designs like Star Athletica's. And that proved to be successful, as every court that ruled on Varsity Brands' claims accepted its description, characterizing Varsity Brands' works in terms of the "graphic features of Varsity [Brands'] designs—the arrangement of stripes, chevrons, zigzags, and color-blocking."²⁰⁰

Interestingly, when it needed to describe its designs verbally in order to overcome the Copyright Office's initial refusal to register them, Varsity Brands did so with much greater specificity. Take, for example, its description of another design, Design 538:

DESIGN 538 . . . has a central field of black bordered at the bottom by a gray/white/black multistripe forming a shallow "vee" of which the left-hand leg is horizontal, while the right-hand leg stretches "northeast" at approximately a forty-five degree angle. Below the upward-angled leg of the shallow "vee" is a similarly angled wider white stripe, succeeded by an area of black. The central field of black is bordered on top by an "X" figure formed of the same gray/white/black multistripe that appears at the bottom, with the colors reversed. Above the "X" is a field of white; the wedges at either side of the "X" are subdivided horizontally into approximately equal-sized wedges of black over white.²⁰¹

Varsity Brands claimed Design 538 with this level of specificity because the Copyright Office might otherwise have believed that the

¹⁹⁹ *Id.* at 242; *accord id.* at 284 (emphasizing "the lines, stripes, coloring, angles, V's and shapes and the arrangement and placement of those elements"); *cf. id.* at 237 (referring to all five designs as "compris[ing] original combinations, positionings, and arrangements of elements which include V's (chevrons), lines, curves, stripes, angles, diagonals, inverted V's, coloring, and shapes, etc.").

²⁰⁰ *Varsity Brands*, 799 F.3d at 491; *accord Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1012 (2017) (characterizing Varsity's copyright claim as centering on "the arrangement of colors, shapes, stripes, and chevrons on the . . . cheerleading uniforms"); *Varsity Brands*, 2014 WL 819422, at *9 (referring to Varsity Brands' copyright claim as directed to "the lines, patterns, and chevrons").

²⁰¹ *Star Athletica* Joint Appendix, *supra* note 197, at 140.

design lacked originality²⁰² or was an unprotectable useful article, as we discuss below.²⁰³ By claiming narrowly, Varsity Brands apparently thought—probably correctly—that the Copyright Office would be more likely to acknowledge an original and copyrightable contribution.

Yet the contrast between Varsity Brands' different claims is striking. When it sought to establish copyrightability at the Copyright Office—making its claim independently of any purported infringement—Varsity Brands claimed narrowly. But when it sued Star Athletica, Varsity Brands claimed far more generally to make it easier to establish infringement. And it could manipulate its claim strategically in this way without fear that its narrower early claim would be held against it.

The difference in generality of claims matters because the Supreme Court's approach in *Star Athletica* puts significant pressure on claiming in cases involving useful articles. A useful article is a pictorial, graphic, or sculptural work "having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information."²⁰⁴ Copyright law denies protection to features of a useful article unless the article "incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."²⁰⁵

According to the Supreme Court, features are separable when they

(1) can be perceived as a two- or three-dimensional work of art separate from the useful article, and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on [their] own or fixed in some other tangible medium of expression—if [they] were imagined separately from the useful article.²⁰⁶

In the process of evaluating Varsity Brands' designs under this rule, the Court implicitly differentiated between designs *on* useful articles, which can be imagined separately even if they correspond to the shape of the article, and the design *of* an article, which cannot be so imagined.

Yet the question of whether Varsity Brands' designs were surface ornamentation (design *on*) or instead depicted the configuration *of* cheerleading uniforms divided courts at every level of the litigation.²⁰⁷ Indeed, each of the three opinions in the Supreme Court reflected a different understanding of Varsity Brands' claimed design. According to the majority,

²⁰² See *supra* text accompanying note 178.

²⁰³ See *infra* text accompanying notes 204–05.

²⁰⁴ 17 U.S.C. § 101 (2012).

²⁰⁵ *Id.*

²⁰⁶ *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017).

²⁰⁷ For more on this issue, see Mark P. McKenna, *Knowing Separability When We See It*, 166 U. PA. L. REV. ONLINE 127, 131–32 (2017).

Varsity Brands claimed “surface designs” consisting primarily of “combinations, positionings, and arrangements of elements’ that include ‘chevrons . . . , lines, curves, stripes, angles, diagonals, inverted [chevrons], coloring, and shapes.’”²⁰⁸ Those surface designs simply “correspond[ed] to the shape of the useful article[s]” (the cheerleading uniforms).²⁰⁹ Justice Ginsburg took the “surface design” theme even further in her concurrence, in which she described the designs as “standalone pictorial and graphic works that [Varsity Brands] reproduce[d] on cheerleading uniforms.”²¹⁰ In her view, those standalone works were not designs of useful articles, and separability analysis was therefore not even necessary. Justice Breyer saw things quite differently. In his view, the designs inescapably depicted cheerleading uniforms because Varsity Brands did not merely claim a series of chevrons and stripes; instead, it claimed chevrons and stripes “as they [were] arranged on the neckline, waistline, sleeves, and skirt of each uniform.”²¹¹

That variation in understanding of the relevant designs matters enormously. Despite the majority’s insistence that “two-dimensional artistic features on the surface of useful articles” are not “inherently separable,”²¹² it is hard not to see as dispositive the majority’s characterization of Varsity Brands’ works as surface designs applied to cheerleading uniforms. It is, however, entirely unclear why that characterization is the most natural one. Among other things, the correct understanding of Varsity Brands’ claims turns in significant part on whether we focus on the images in the deposit copies Varsity Brands submitted with its applications to register the designs or instead on Varsity Brands’ later characterization of those designs.

The majority’s description of Varsity Brands’ works as drawings of various features in some arrangement ignores the reality of the images submitted to the Copyright Office. Those images do not simply depict chevrons and lines; they depict cheerleading uniforms with particular design features. That, of course, does not necessarily mean that Varsity Brands *claimed* every aspect of what is shown in the deposit copy images, but uncertainty about what the images reflect is precisely the problem. Copyright registration does not require visual demarcation of the claimed features, nor does it require a clear verbal identification of those features. As a result, one cannot simply look at a copyright registration and determine the scope of the registrant’s claim.²¹³

²⁰⁸ *Star Athletica*, 137 S. Ct. at 1007.

²⁰⁹ *Id.* at 1012.

²¹⁰ *Id.* at 1018 (Ginsburg, J., concurring).

²¹¹ *Id.* at 1035 (Breyer, J., dissenting) (emphasis omitted).

²¹² *Id.* at 1009.

²¹³ See Fromer, *Claiming*, *supra* note 26, at 745 n.136 (“To register, an applicant must complete a form with information about the applicant and the work’s title, completion date, and

This is a potentially significant issue in the context of useful articles—which many designs are—because the same visual image in a deposit copy could reflect at least two different types of claims. One might, for example, make a model of a car and submit an image of that model to claim rights in the model.²¹⁴ As the *Star Athletica* majority noted, the car model would be copyrightable even if the owner could not enforce its rights against a party that made an actual car with the same design.²¹⁵ But one could also submit an image of the model car and claim features depicted in the image in the same way Varsity Brands claimed the features depicted in images of its cheerleading uniforms—as features that might be “applied to” the car itself.²¹⁶ That is to say that the very same deposit copy could form the basis of a claim to a particular depiction of a car—but not the design of an actual car—or to features of an actual car. Because the registration process does not require delineation of the claim, third parties cannot really know how a putative copyright owner will define its claim until litigation.

That timing is a problem because *Star Athletica* makes separability turn on whether features of a useful article can be imagined separately as a work of authorship that is not itself a useful article.²¹⁷ What features are we to “imagine” separately, and how do we know whether those features can be recognized as a work of authorship or instead simply depict the useful article?

The majority had very little to offer on either of those questions; it simply accepted that Varsity Brands’ design consisted of a combination of chevrons and other lines arranged in some format. But if we are to assume that separability implies evaluation of something less than the entirety of the design, then the first step in the separability analysis must be identification of the purportedly separable features.²¹⁸ And surely identification must at least start with the features the plaintiff *claims* should be imagined separately. Here, the lack of claiming methodology in copyright is likely to pose significant issues.

In particular, the descriptions of the designs at issue are likely to matter in separability cases because at different levels of abstraction the purportedly

publication date (if any) but nothing about the work’s content or the set of works protected by the copyright.” (citations omitted)).

²¹⁴ One could, of course, also claim copyright in the image of the model itself, distinct from the model. But that image would not be a useful article, so it would not be subject to separability analysis.

²¹⁵ See *Star Athletica*, 137 S. Ct. at 1010 (“Although the replica could itself be copyrightable, it would not give rise to any rights in the useful article that inspired it.”).

²¹⁶ See *id.* at 1005 (“§ 113(a) . . . protects art first fixed in a medium other than a useful article and subsequently *applied to* a useful article.” (emphasis added)).

²¹⁷ *Id.* at 1010.

²¹⁸ Buccafusco & Fromer, *Fashion’s Function*, *supra* note 31, at 65–69, 85–93. In fact, the Court made it clear the decisionmaker must “determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article.” *Star Athletica*, 137 S. Ct. at 1010.

separable features are going to look more like works of authorship that can be imagined separately—or, conversely, more like the platonic form of the useful article.²¹⁹ In other words, the level of abstraction of the description is going to influence whether a court regards the design simply as that of “a shovel as a shovel,” or instead as an article that consists, at least in part, of “artistic features that could be perceived as art apart from the shovel, and which would qualify as protectable pictorial, graphic, or sculptural works on their own or in another medium.”²²⁰

As this discussion indicates, copyright claiming is hard to characterize precisely because there is so little methodology to it.²²¹ From the moment a work is fixed until and unless the owner asserts rights in the work, the copyrighted work itself serves as the copyright claim. The work serves as an exemplar against which other works are compared to determine infringement. Because copyright’s infringement standard does not require identity but only substantial similarity,²²² the author’s rights actually extend beyond the four corners of the work. The work thus serves as a “central claim by exemplar.”²²³

²¹⁹ Cf. Mala Chatterjee, Note, *Conceptual Separability as Conceivability: A Philosophical Analysis of the Useful Articles Doctrine*, 93 N.Y.U. L. REV. 558, 558–61 (2018) (using the philosophical framework of conceivability to analyze which features of useful article are separable).

²²⁰ *Star Athletica*, 137 S. Ct. at 1013 n.2. As difficult as it may be to develop a consistent claiming methodology, the alternative is for courts simply to engage in artistic evaluation, as the majority did for Duchamp’s shovel. Indeed, the only way the Court could confidently have concluded that there were no separable features of the shovel was to determine (implicitly, and without the benefit of any claim to particular features) that none of the features of that shovel were sufficiently artistic to “be perceived as art apart from the shovel.” *Id.* This is risky business because we have long been told that it is “a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [artistic expression], outside of the narrowest and most obvious limits.” *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). The majority’s test at least flirts with that undertaking; divorcing separability from any particular claim leaves courts with essentially no other option. Cf. Barton Beebe, *Star Athletica and the Problem of Panaestheticism*, 9 U.C. IRVINE L. REV. (forthcoming 2019) (manuscript at 11), available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3123967 (“[When] the law begins to pursue a separation between the utilitarian and the aesthetic . . . the law finds itself on . . . the wrong . . . side of that divide, where it is no longer engaging in legal reasoning [I]t is engaging in aesthetic thinking about the meaningful and the beautiful.”).

²²¹ Margot Kaminski and Guy Rub recognize a related issue when they discuss how “[c]opyright faces a framing problem When courts adjudicate copyright disputes, they often begin their analysis by deciding either to frame the copyrighted work as a whole or to focus on its components or parts.” Margot E. Kaminski & Guy A. Rub, *Copyright’s Framing Problem*, 64 UCLA L. REV. 1102, 1104 (2017). They refer to the former as “zooming out” and the latter as “zooming in.” *Id.* We think copyright law indeed has a framing problem, but it is multidimensional and not only about zooming out or zooming in. As discussed in this section, copyright law’s framing problem is about which particular aspects of a copyrighted work one decides to focus on and at which level of generality one views a work. And this problem derives from copyright law’s lack of a claiming methodology. For Kaminski and Rub’s quite different take on how copyright law’s framing problem affects useful articles, see *id.* at 1128–41.

²²² See *supra* text accompanying notes 178–82.

²²³ Fromer, *Claiming*, *supra* note 26, at 748.

The work's characteristics and its periphery are generally not further specified until and unless there is a copyright dispute. The timing of copyright claiming therefore tends to be late, and claims can be strategically crafted to fit the contours of particular disputes. That is true even if the copyright holder chooses to register the work prior to and independently of the dispute; unlike design patent and trademark, registration does not require any meaningful identification of the claimed aspects of the work. Because there is little to no reflection on claiming in copyright law, the level of generality and the medium of specification can vary, typically at the claimant's choosing and without much pushback or legal reflection.

* * *

If nothing else, this Part's tour of the claiming rules in design patent, trademark, and copyright—the three primary intellectual property systems that protect design—shows how varied the claiming regimes are. Although they all employ central, rather than peripheral, claiming, the claiming regimes vary along other important dimensions, especially:

- whether claiming is by exemplar or by characteristic;
- the timing of the claims and their independence from particular disputes;
- the form of the claims (visual or verbal); and
- the level of generality at which claims can be made.

In the next Part, we begin analyzing the consequences of choices along these dimensions for a system for claiming design.

II. INTERNAL CONSEQUENCES OF CLAIMING DESIGN

The choice of claiming system for each design protection regime has important internal consequences. That is, a design protection regime's adoption of central or peripheral claiming; exemplar or characteristic claiming; early or late claiming; visual or verbal claiming; and more or less abstract claiming have significant effects on the operation of that regime. The most important effects relate to the background information the claimant can use to structure its claim at the time that claim is made (and the related ability to frame litigation); the extent to which a regime's claim format is elastic or manifold (which can lead to inconsistent or patchwork claiming); the adequacy of notice; the difficulty of fixing claim scope; and the degree to which claimants must internalize claiming choices with regard to both validity and scope. Because the various dimensions we discussed above influence each regime in these respects, we organize the following sections in terms of the effects of claiming choices, highlighting relevant claiming dimensions along the way. In light of this analysis, we suggest ways in which each claiming regime might be optimized.

A. Claim Timing and Information Available to Shape the Claim

At the outset, it is important to note that there are two critical timing issues with regard to claiming design. First is the timing of claiming vis-à-vis commercialization of the claimant's design. Second is the timing with regard to a particular assertion of rights. Claiming can happen early with regard to both commercialization and rights assertion, late with regard to both, or late with regard to commercialization but early with regard to assertion.

With this framing of timing variables in claiming design, consider how the background information available at that moment in time can shape the claim itself. Given the incentives design patent law creates, designers are likely to file their applications early in their own commercialization timeline, and possibly early with respect to potential competitors, depending on how crowded the competitive landscape is at the time of the application.²²⁴ Even if the market in which the applicant's design will compete is crowded, neither a potential competitor nor the applicant is likely to know at the time of application how any competitor's design will compete with the applicant's new design. Still, a smart, forward-looking applicant would devote time and resources to understanding the competitive landscape and the ways others might respond to the applicant's design in order to make informed claiming choices. This thoughtful applicant would also think about how it expects to market the new design. Of course, no applicant can foresee every competitive development during the design patent term. But any thoughtful applicant realizes it is helpful to think about the future before making a design patent claim in order to maximize design patent scope vis-à-vis competitors' designs.

The incentive early claiming gives to an applicant—to consider how it will market its design and how competitors might respond—is a feature, not a bug. Consider the comparative case of utility patent law's disclosure and utility doctrines, which force inventors who file their patent applications early in the development process to consider whether they can enable the scope of their claims and whether their inventions have specific and substantial utility.²²⁵

²²⁴ That said, savvy design patent applicants can use patent continuations to secure protection on certain variations of an earlier protected design, perhaps finding a way to secure protection for competitors' later-issued designs. See Burstein, *Patented Design*, *supra* note 67, at 221 (noting that "design patent practitioners can use the PTO's continuation procedures to 'evergreen' design patent protection for a particular product for thirty or even forty years"); Perry J. Saidman, *The Crisis in the Law of Designs*, 89 J. PAT. & TRADEMARK OFF. SOC'Y 301, 319-22 (2007) [hereinafter Saidman, *Crisis*] (discussing an example of such practice for a lever-operated corkscrew).

²²⁵ The enablement requirement puts the onus on the applicant to disclose the invention in a way that "teach[es] those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *Auto. Techs. Int'l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1280 (Fed. Cir. 2007). The disclosure must also describe the invention in sufficient terms such that one skilled in the art would conclude that the inventor actually possessed the claimed invention at the time of filing. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306,

Inventors that can satisfy those criteria will have to disclose the information demonstrating so; if they cannot satisfy the criteria, they will go back to the drawing board and refine their inventions, thereby advancing their inventions to society's benefit.²²⁶ Analogously, requiring early claiming of designs should force businesses to think through their designs and how they intend to commercialize and market those designs. Early claiming gives designers an incentive to articulate claims that correspond to their market intentions, which they might not otherwise have thought through as thoroughly at that stage.

Two important features of current design patent law might, however, prevent that desirable outcome by giving designers the incentive to claim their designs broadly and in as piecemeal a manner as possible. First, designers can claim their designs broadly without fear they will be denied a design patent on novelty or nonobviousness grounds because those protectability thresholds are enforced laxly, if at all.²²⁷ And second, because design patent allows such extreme partial claiming, designers can fragment their designs into multiple design patent applications and thereby achieve far broader protection than they could receive if they were required to claim the design of an article as a whole.²²⁸ To the extent modern design patent doctrine provides these incentives to claim broadly, we think it dilutes the important potential benefits of early claiming.

Designers who do claim in ways that anticipate their marketing are likely to do a better job of providing notice to the public of both the design right and the way the rightsholder might envision using the design in the marketplace, something we discuss below.²²⁹ In terms of notice, then, it is important that the law hold a claimant to the limits of claims that express

1320-21 (Fed. Cir. 2003). The utility requirement demands that the invention offer a "specific benefit" in its "currently available form." *Brenner v. Manson*, 383 U.S. 519, 534-35 (1966).

²²⁶ The Supreme Court has explained that the disclosure requirement "stimulate[s] ideas and the eventual development of further significant advances in the art." *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974). As one of us has described, "patent disclosure indirectly stimulates future innovation by revealing the invention's design so that others can use it fruitfully when the patent term expires and design around, improve upon, or be inspired by the invention, even during the patent term." Jeanne C. Fromer, *Patent Disclosure*, 94 IOWA L. REV. 539, 541 (2009) [hereinafter Fromer, *Patent Disclosure*]; accord Fromer, *Dynamic Disclosure*, *supra* note 58, at 1716-19 (describing the "multiple ways" in which effective patent disclosure should "stimulate further innovation").

²²⁷ See McKenna & Strandburg, *Progress*, *supra* note 6, at 38-42.

²²⁸ See Burstein, *"Article of Manufacture" Today*, *supra* note 32, at 787-88 ("Partial claiming allows a design patent owner to succeed on an infringement claim where the defendant's product, considered as a whole, doesn't look the same as the patent owner's product.").

²²⁹ *Infra* Section II.C.

those intentions, whether or not the designer's eventual use of the design in the marketplace matches its initial intentions.²³⁰

That said, it cannot be emphasized enough that the legal incentives to claim early might be sufficiently strong that even sophisticated claimants will sometimes (perhaps even often) be unable to claim in a way that encompasses the full range of potential competitive designs. At the time at which designers must make their claims, they may lack sufficient information about potential competitor responses. And of course competitor behavior is a moving target because competitors will often attempt to circumvent existing claims to intellectual property once those claims are known to them. Take, for example, Two Pesos using the color blue for the exterior of its restaurant, possibly to avoid the pink color it likely perceived to be a critical limit on Taco Cabana's rights in the design of its restaurants.²³¹ In the design patent realm, consider how the makers of the Insta-Pull lever-operated corkscrew, depicted on the right in Figure 18, may have designed their product to distinguish it from the Rabbit lever-operated corkscrew claimed in the design patent drawing shown on the left.

230 Of course, because design patent claims are central, rather than peripheral, early claims will not strictly limit a claimant to its early predictions about the competitive landscape. But the initial claim does clearly form the core, anchoring claim scope. *Supra* Section I.A.

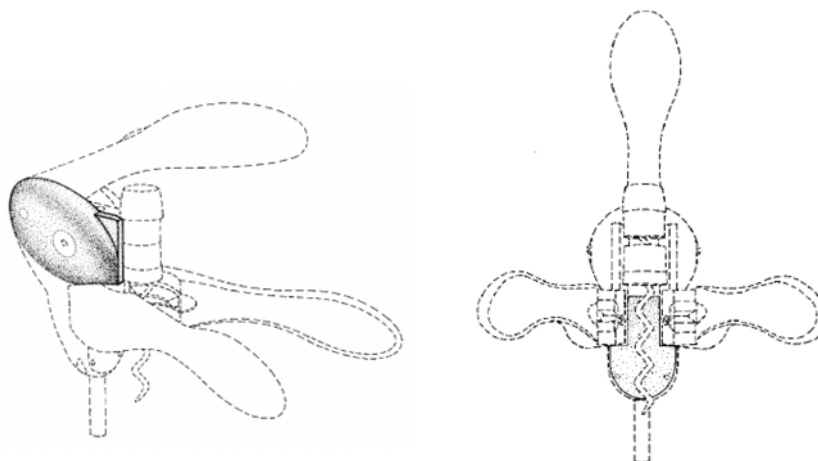
231 *Supra* notes 8–16 and accompanying text. Design patent applicants can frustrate that timing by filing design patent applications as divisional applications from parent patent applications, which might have been pending for a longer time. Burstein, *Costly Designs*, *supra* note 59, at 115–16 (explaining the “keep [one] in the oven” strategy, by which design patent applicants can “go back to the PTO and capture competing products that were introduced after the first design patent application was filed—even if those competing products did not infringe the original patent claim” (internal quotations omitted)); Saidman, *Crisis*, *supra* note 224, at 319–21 (describing an example of such a continuation application strategy involving lever-operated corkscrews). When they do that, they might be delaying claiming until the design is more complete and potentially commercialized. That sort of delay might also give the design patent owner more opportunity to consider what competitors are doing and to claim strategically in relation to those competitors.

Figure 18: Rabbit²³² (Left) and Insta-Pull²³³ (Right) Lever-Operated Corkscrews



When the Rabbit corkscrew's maker discovered this competitor, it filed for—and secured—broader design patents, depicted in Figure 19, as continuations of its issued design patent, with the apparent aim of rendering the Insta-Pull's otherwise different design infringing.

Figure 19: Design Patent Continuations²³⁴



²³² U.S. Patent No. D446,098 fig.1.

²³³ *Happy Easter*, THE WEEKLY SCREW: THE VIRTUAL CORKSCREW MUSEUM'S WEEKLY NEWSPAPER (Apr. 16, 2006), <http://www.bullworks.net/daily/weekly003.htm> [<https://perma.cc/E7XD-MBYW>].

²³⁴ U.S. Patent No. D442,045 fig.1; U.S. Patent No. D441,265 fig.1.

Indeed, after being granted these two new design patents, the Rabbit's maker filed suit against the Insta-Pull maker, though the court refused to find infringement.²³⁵

The encouragement that an early claiming regime provides for parties to commit to a particular commercialization or marketing strategy can have other downsides. Early claiming makes it more difficult for businesses to defer commercialization or marketing commitments until they better understand how consumers will react to their design. And one could imagine that claims would, in some circumstances, be clearer if they were drawn with better information about the sorts of competitive designs one intended to encompass. Early claiming may lead to more partial or fragmented claiming as a way to hedge against narrow rights that could otherwise result from a failure to anticipate consumers' and competitors' responses to a protected design. Take the example of Aquazzura's Christy shoe design. Not only has that design been a commercial success, but it seems to have awakened in consumers an interest in certain alternative laced designs, like Ivanka Trump's. Perhaps Aquazzura's design patent rights would have been construed to encompass Trump's design; perhaps they would not. But the scope of Aquazzura's claim likely would have been clearer if it had known how this design might later be understood in the marketplace.

Trademark claiming differs from design patent claiming in terms of timing and the availability of information about consumer understanding and competitor behavior. Recall that trademark owners can choose whether to register their designs.²³⁶ Other than the general advantages of earlier registration, there is comparatively less pressure to register trademarks early

²³⁵ *Metrokane, Inc. v. Wine Enthusiast*, 185 F. Supp. 2d 321, 326-30 (S.D.N.Y. 2002). Interestingly, the court took disapproving notice of the plaintiff's strategic continuation filings:

It is quite revealing that plaintiff filed the applications for the two patents in suit only after plaintiff had seen defendant's accused device on the market and had acquired a specimen of it and, indeed, only a few days before the original Complaint in this action was filed. Plaintiff obviously scrutinized defendant's device for any points of visual similarity to its own commercial device, and focused the patent drawings on these narrow features, however inconsequential and little noticed they had been before. The design patent laws were established to encourage the decorative arts by providing temporally limited protection for meritorious ornamental designs. They were not intended to empower patent owners to harass competitors who are marketing devices which happen to incorporate parts whose shapes resemble insignificant physical details of the patent owner's products. This is apparently the game of "gotcha" which plaintiff is attempting to play in this case.

Id. at 327-28 (citation omitted).

²³⁶ *Supra* Section I.B.

than there is to apply for a design patent because trademark rights arise out of the use of a protectable mark rather than out of registration.²³⁷

We suspect that, even when parties seek to register their trade dress before litigation, they still apply well after they have commercialized the trade dress, and that the delay in seeking registration relative to commercialization is more pronounced for trade dress than it is for other types of marks. Use-based applications must be based on preexisting use, which means registered designs necessarily have been commercialized to some extent before application. Product designs in particular should have been in relatively widespread use, typically for some time, before the date of application because product design cannot be registered unless and until the design has acquired secondary meaning.²³⁸ Those registration timing rules probably correspond to designer motivations, as we doubt that many businesses develop product design for the purpose of designating source but instead seek to protect certain design aspects as trade dress when they later come to serve that purpose for consumers (or, more cynically, when other legal options are unavailable).²³⁹

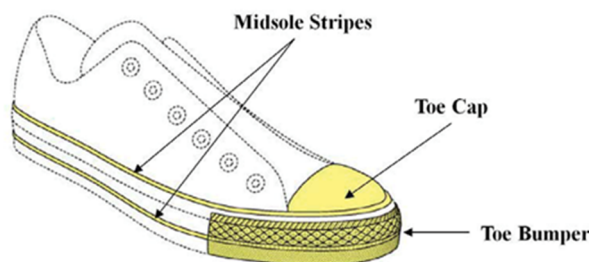
Converse's suit against Wal-Mart and New Balance is instructive. In that case, Converse alleged that the defendants infringed Converse's trademark rights in the design of its Chuck Taylor athletic shoes, which it claimed consisted of the features shown in Figure 20.²⁴⁰

²³⁷ Priority is also determined by use, subject to constructive-use provisions relating to intent-to-use applications. 15 U.S.C. §§ 1051(b), 1057(c) (2012). Because determining the nature and amount of use necessary to establish priority can be difficult, there is some incentive to apply to register on the basis of an intent to use a mark, which would set one's priority date in relation to the filing date. But product design is protectable only with evidence of secondary meaning. See *supra* text accompanying note 236. Therefore, parties cannot apply to register design on the basis of an intent to use it. Thus, priority for purposes of product design is entirely determined by use. There are obviously advantages to registration in terms of the geographic scope of rights. See, e.g., 15 U.S.C. § 1057(c) (specifying that filing an application to register a mark confers a "nationwide" right of priority).

²³⁸ *Supra* Section I.B.

²³⁹ Cf. David H. B. Bednall et al., *Color, Champagne, and Trademark Secondary Meaning Surveys: Devilish Detail*, 102 TRADEMARK REP. 967, 971 (2012) ("Once they have established a brand, companies seek to build and then protect their brand equity."); Steffen Herm & Jana Möller, *Brand Identification by Product Design: The Impact of Evaluation Mode and Familiarity*, PSYCHOL. & MARKETING 1084, 1084 (2014) ("Once companies have established strong associations between product designs and brands in consumers' minds, they seek protection against imitation as well as consistency in product lines."). Here there is likely some contrast with product packaging, which we suspect businesses tend to register earlier in relation to commercialization than they do product configuration because those businesses are more likely to be focusing on legal protection when they create that packaging. And that would make sense because product packaging is capable of being considered inherently distinctive and is therefore potentially protectable immediately upon use. *Supra* Section I.B.

²⁴⁰ Complaint at 4, *In re Certain Footwear Prods.*, Inv. No. 337-TA-936, (USITC June 23, 2016), available at <http://www.itcblog.com/images/conversecomplaintpart1.pdf> [<https://perma.cc/A9LA-BUBB>].

Figure 20: Converse Trade Dress Claim²⁴¹

As Wal-Mart and New Balance emphasized in their arguments to the Federal Circuit, Converse claimed the shoe design as trade dress only after many years of use, during which it had emphasized not the design elements, but the Converse brand and All Star logo.²⁴²

Such post-use claiming sets up a different dynamic than does earlier design patent claiming. Those who claim trade dress rights after a long period of use have the opportunity to gauge competitors' reactions and to see how consumers understand the design in the marketplace before asserting a claim. These pieces of information give trademark claimants the opportunity to define their claims so as to sweep both consumer understanding and competitor designs within the claim boundaries.

Parties that assert rights in unregistered trade dress can delay claiming even further because they do not have to identify the elements of their trade dress until they decide to enforce rights in their designs.²⁴³ Those parties can shape their claims to encompass the particular uses they allege infringe their rights.

Copyright is similar to trademark in the sense that registration is optional. Copyright vests as soon as an original work of authorship is fixed in a tangible medium. As in trademark, there are some advantages to registering a copyright; most obviously, one cannot sue to enforce a copyright unless and until it is registered.²⁴⁴ Even though the copyrighted work serves as the exemplar in a central claim to the work, copyright owners refine their claims only in the course of litigation.

There are two primary benefits of recognizing unregistered rights. The first, and most obvious, is the low cost of rights acquisition. Second, and related, is the ability to defer judgment about which rights to pursue until it

²⁴¹ Corrected Non-Confidential Principal Brief of Intervenor at 7, *Converse, Inc. v. Int'l Trade Comm'n*, No. 2016-2497, 2017 WL 2870241 (Fed. Cir. June 26, 2017).

²⁴² *Id.* at 9-14.

²⁴³ *Supra* Section I.B.

²⁴⁴ *Supra* Section I.C.

is clear which marks or works are commercially valuable. Trademarks and copyrighted works both may have limited commercial life, and so they may not be worth the time and expense of registration. In fact, we suspect that design will often have an especially limited commercial life, relative to paradigmatic trademark and copyright subject matter (word marks and logos, for trademark; books and songs, for copyright). Designers' ability to delay claiming therefore permits them to capture unscrupulous behavior as it is happening in the market without wasting resources registering designs that aren't worth the expenditures.

That said, there are real costs to late claiming. As the *Taco Cabana*, *Lisa Frank*, and *Varsity Brands* examples all demonstrate, allowing parties to delay claiming until litigation enables them to define their claims strategically so as to encompass alleged infringers' behavior, something that would be more difficult if they were forced to claim rights earlier and independently of a particular dispute. Delayed claiming also diminishes the adequacy of notice, as we discuss below.²⁴⁵

With this analysis of claim timing and the background information available to shape the claims at the moment of claiming, we turn now to the extent to which a regime's claim format is elastic or manifold, which can lead to inconsistent or patchwork claiming within a single regime.

B. *The Elasticity and Multiplicity of Claim Formats*

As our discussion above indicates, claim format is elastic—and often multiple—within any one design protection regime. Elasticity and multiplicity emerge out of a regime's claiming features: central claiming; allowance of multiple, different claims over time; and intermingling of visual and verbal claims. In this section, we analyze the possibility that inconsistent or patchwork claims might emerge for a single design within a single regime. Later, in sections C and D, respectively, we take up the related consequences for the adequacy of notice and claim scope.

1. Central Claiming, by Exemplar and Characteristic

As we have noted, the three intellectual property regimes that can protect designs—design patent, trademark, and copyright—are best characterized as utilizing forms of central claiming. They use central claiming because claimants in these legal regimes identify some—but not all—members of the set of designs protected by the right. Designs not specifically claimed might still be protected by these regimes by virtue of infringement rules that permit

²⁴⁵ *Infra* Section II.C.

non-identical designs to be considered within the scope of the claimant's rights. That stands in contrast to systems of peripheral claiming, which require identification of all members of a given set.²⁴⁶

Before any litigation, the central claims in all three areas are principally made by exemplar because the claims identify a particular member or members of the set of protected designs rather than describing characteristics shared by these members.²⁴⁷ In design patent, the exemplar is, unsurprisingly, the design depicted in the drawing; in trademark law, it is the trade dress being used in the marketplace (whether or not the trade dress is registered); and in copyright law, the exemplar is the work that has been fixed.²⁴⁸ Third parties are then left to adduce the scope of the claim from the claimed exemplar and to determine whether their designs have enough characteristics in common with the exemplar to be covered by the protected design right. If litigation occurs, these systems of claiming by exemplar are supplemented, to differing extents depending on the legal regime, by claiming by characteristic. That is, rightsholders and courts describe the prototypical—if not the essential—characteristics of the design in the course of litigation.

This particular combination of claiming regimes—central and by exemplar before litigation and then also by characteristic once litigated—has important implications. A system of central claiming by its nature creates the possibility of multiple claims that may be at different levels of generality or even inconsistent with each other. Central claiming enables this multiplicity of claims because no single claim is thought to capture the periphery of the creation, but rather identifies a prototype or central aspects of the creation.²⁴⁹ Other variations thus might be encompassed within the creation's scope whether or not they fall within the central claim's bounds.

For that reason, central claims at varying levels of generality or even inconsistent claims are not necessarily nonsensical.²⁵⁰ Multiple central claims might each focus attention on the salient aspects of a creation based on the context in which each claim is made. In that sense, it is much like the way we understand many concepts like a “game.” We might reasonably make a central

²⁴⁶ Burk & Lemley, *Fence Posts*, *supra* note 105, at 1745, 1749; Fromer, *Claiming*, *supra* note 26, at 724-30.

²⁴⁷ Fromer, *Claiming*, *supra* note 26, at 724-30.

²⁴⁸ The exception to prelitigation claiming by exemplar is the registered trademark, which comprises some claiming by characteristic in the registration's verbal description. *Supra* Section I.B.

²⁴⁹ Fromer, *Claiming*, *supra* note 26, at 726-27.

²⁵⁰ In one limited circumstance, inconsistent claims might be disallowed. Pursuant to the doctrine of prosecution history estoppel, design patent law disallows the reclaiming of material that was disclaimed or narrowed during prosecution of a claim. *Pac. Coast Marine Windshields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694, 700-02 (Fed. Cir. 2014); *see also* *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730-731 (2002) (holding that prosecution history estoppel promotes clarity and that “[t]his clarity is essential to promote progress, because it enables efficient investment in innovation”).

claim for a “game” that focuses on rules, competitive play according to those rules, and a winner of the competition. But we can also have central claims for a “game” that, instead or additionally, focuses on cooperative play—thinking of games like *Pandemic*²⁵¹—or on the absence of victory conditions—thinking of games like *The Ungame*.²⁵² Or we can have a central claim that demands that a “game” depends on skill—as in chess²⁵³—and another that says, seemingly in opposition, that a “game” depends on luck—as in *Candy Land*.²⁵⁴ All of these can reasonably be central claims, made alone or together, for a “game.” On this view, the potential multiplicity of central claims is essentially benign, or perhaps helpful in focusing attention on relevant features, even if some of the claims seem incompatible.

On another understanding, multiplicity is worrisome in that a claimant can strategically multiply claims that are inconsistent or that vary in generality and thereby undermine clarity. As just one example, consider again the very detailed claim Varsity Brands submitted to the Copyright Office when it sought registration of its cheerleading uniform design.²⁵⁵ As discussed above, Varsity Brands likely crafted that claim to convince a skeptical Copyright Office that it deserved at least narrow protection on a possibly unoriginal useful article.²⁵⁶ Yet when Varsity Brands sued Star Athletica for infringing its uniform designs, it claimed copyright in those designs at a much more abstract and encompassing level, describing the designs as consisting of “the lines, stripes, coloring, angles, V’s, and shapes and the arrangement and placement of those elements.”²⁵⁷ Each of those claims, read in isolation, gives a very different sense of the scope of Varsity Brands’ copyrights. Anyone who read both claims together would surely be befuddled as to what those copyrights cover.

2. Claim Timing

Not only does claim timing vary across the different design protection regimes, as we discussed in the previous section,²⁵⁸ but each separate regime

²⁵¹ *Pandemic*, BOARDGAMEGEEK, <https://boardgamegeek.com/boardgame/30549/pandemic> [<https://perma.cc/LY95-GY8W>] (last visited Sept. 30, 2018).

²⁵² *The Ungame*, BOARDGAMEGEEK, <https://boardgamegeek.com/boardgame/6283/ungame> [<https://perma.cc/J4H4-7FN3>] (last visited Sept. 30, 2018).

²⁵³ *Chess*, BOARDGAMEGEEK, <https://boardgamegeek.com/boardgame/171/chess> [<https://perma.cc/CKzR-HYUY>] (last visited Sept. 30, 2018).

²⁵⁴ *Candy Land*, BOARDGAMEGEEK, <https://boardgamegeek.com/boardgame/5048/candy-land> [<https://perma.cc/6N4S-JAZH>] (last visited Feb. Sept. 30, 2018).

²⁵⁵ *Supra* text accompanying note 201.

²⁵⁶ *Supra* text accompanying notes 202–03.

²⁵⁷ *Star Athletica* Joint Appendix, *supra* note 197, at 242.

²⁵⁸ *Supra* Section II.A.

often permits parties to claim at multiple times. Design patent claims are formalized in the patent application, but they often are supplemented to some extent by verbal descriptions of the design in litigation.²⁵⁹ Parties formulate their trademark claims in applications to register their marks or in litigation.²⁶⁰ And copyright claims can be made in applications to register and in litigation.²⁶¹

When a single regime allows parties to claim at multiple points in time, chances are good that the claim content will vary based on the background information that is available and salient at the time of the claim. Claim multiplicity, then, results not just from central claiming, but also from the fact that all of the design protection regimes permit claiming at multiple points in time.

3. Visual and Verbal Claiming

Claims can also multiply within any one regime because parties combine visual and verbal claims. Before describing the contribution of differing modes of claiming to multiplicity, we first compare the three design protection regimes in terms of the dominance of visual or verbal claiming. We then analyze how visual claiming and verbal claiming of what otherwise might seem like the same information might lead to different understandings of that information.

Design patent, trademark, and copyright law vary in terms of the dominant medium in which parties are expected to make their claims. In design patent law, claiming is entirely visual, but in litigation the visual claims are commonly supplemented to some extent by verbal description.²⁶² Claiming is hybrid in the trademark registration context, in that a claim will typically consist of a drawing, a verbal description of the mark depicted in the drawing, and a classification of the goods or services for which the design will be used.²⁶³ The verbal descriptions, however, are highly inconsistent, even though they are required for designs. By contrast, unregistered trade dress claimed for the first time in litigation must be verbally claimed, and that verbal description supplements the visual trade dress actually being used in the marketplace.²⁶⁴ Copyright claiming is most like claiming of unregistered trade dress, in that parties claim principally in verbal form in the context of infringement litigation, supplementing the exemplar claims that are the works themselves.²⁶⁵

²⁵⁹ *Supra* Section I.A.

²⁶⁰ *Supra* Section I.B.

²⁶¹ *Supra* Section I.C.

²⁶² *See supra* Section I.A.

²⁶³ *See supra* Section I.B. The form of the registration, however, tends not to control in infringement litigation.

²⁶⁴ *See supra* Section I.B.

²⁶⁵ *See supra* Section I.C.

These differences in claiming medium, even when claims appear to be conveying the same information, can also yield distinctions in the understanding of that information. As courts have emphasized with regard to design patent claims, visual claims typically are thought to be perceived more holistically than verbal claims, which are thought to be more readily picked apart into their constituent pieces.²⁶⁶ To the extent these legal characterizations accurately reflect human psychology—and evidence indicates they generally do²⁶⁷—visual and verbal claims will effectively convey the “same” information differently. For example, decisionmakers asked to evaluate whether a particular accused product infringes a visually claimed design are likely to compare the designs holistically, whereas those asked to compare the accused product to a verbally claimed design might compare the designs in a more piecemeal fashion to match corresponding parts. A visual claim can thereby lead a decisionmaker to overlook differences between designs that the same decisionmaker would regard as pertinent were the claim verbal instead.

Amy Adler and Rebecca Tushnet have both written about courts’ interpretations of images, and particularly the differential legal treatment that images receive, as compared to text, for the First Amendment and copyright purposes.²⁶⁸ As Tushnet observes:

Copyright oscillates between two positions on nontextual creative works such as images: they are either transparent, or they are opaque. When courts treat images as transparent, they deny that interpretation is necessary, claiming that images merely replicate reality, so that the meaning of an image is so obvious that it admits of no serious debate.²⁶⁹

By contrast, Tushnet notes, “[w]hen [courts] treat images as opaque, they deny that interpretation is possible because images are so far from being susceptible to discussion and analysis using words that there is no point in trying.”²⁷⁰

Design patent jurisprudence reflects the simplified view of images, as courts caution against describing claims verbally, suggesting that the images

²⁶⁶ See *supra* Section I.A.

²⁶⁷ Tushnet, *Worth a Thousand Words*, *supra* note 93, at 690-92 (“Images are more vivid and engaging than mere words, decreasing our capacity to assess images critically because we are more involved in reacting to them.”); accord NEAL FEIGENSON & CHRISTINA SPIESEL, LAW ON DISPLAY: THE DIGITAL TRANSFORMATION OF LEGAL PERSUASION AND JUDGMENT 7 (2009) (“With words, we can’t get the idea without getting to the end of the spoken or written thought. With pictures . . . we can stop ‘reading’ when we think we recognize the subject matter . . .”).

²⁶⁸ See Amy Adler, *The First Amendment and the Second Commandment*, 57 N.Y.L. SCH. L. REV. 41, 42 (2013) [hereinafter Adler, *First Amendment*]; Tushnet, *Worth a Thousand Words*, *supra* note 93, at 687.

²⁶⁹ Tushnet, *Worth a Thousand Words*, *supra* note 93, at 686-87.

²⁷⁰ *Id.* at 687.

speak for themselves or cannot be reduced to words.²⁷¹ Yet, as Adler and Tushnet each lay bare in their work, “[w]e are vulnerable to the treachery of images” because they “appear to us to resemble unmediated reality more than words do.”²⁷² Because of our tendency to treat pictures as reality, we might be prone to overlook the ways pictures can be cropped, expanded, or manipulated to emphasize certain features over others.²⁷³ This is especially worrisome because we process pictures holistically and quickly.²⁷⁴

At the same time, as the design patent cases reflect, courts and other legal actors cannot help but resort to words, at the very least because they must explain their reasoning.²⁷⁵ As Neal Feigenson and Christina Speisel observe:

Law, like most disciplines or practices that aspire to rationality, has tended to identify that rationality (and hence its virtue) with texts rather than pictures, with reading words rather than “reading” pictures, to the point that it is often thought that thinking in words is the only kind of thinking there is.²⁷⁶

But verbal description isn’t always neutral; indeed, forcing verbal articulation can actually alter perception of objects or images, a phenomenon referred to as “verbal overshadowing.”²⁷⁷

²⁷¹ See *supra* Section I.A.

²⁷² Tushnet, *Worth a Thousand Words*, *supra* note 93, at 689 (internal quotation marks omitted); accord Adler, *First Amendment*, *supra* note 268, at 43; see FEIGENSON & SPIESEL, *supra* note 267, at 8-9; WILLIAM J. MITCHELL, *THE RECONFIGURED EYE: VISUAL TRUTH IN THE POST-PHOTOGRAPHIC ERA* 24 (1992).

²⁷³ Tushnet, *Worth a Thousand Words*, *supra* note 93, at 694, 726; see also FEIGENSON & SPIESEL, *supra* note 267, at 9-10. As William Mitchell explains in analyzing photography, “[s]electing a station point, framing the scene, and choosing the moment to expose are all intentional acts [by a photographer].” MITCHELL, *supra* note 272, at 29; accord *id.* at 202 (“Traditionally, photographers have tendentiously effaced and elided, when they wished to do so, through carefully selective framing and cropping and through use of camera angles in which foreground objects occlude unwanted background objects.”).

²⁷⁴ See FEIGENSON & SPIESEL, *supra* note 267, at 7; Tushnet, *Worth a Thousand Words*, *supra* note 93, at 690-92.

²⁷⁵ Tushnet, *Worth a Thousand Words*, *supra* note 93, at 734; cf. Roland Barthes, *The Photographic Message*, in *IMAGE, MUSIC, TEXT* 15, 18-19 (Stephen Heath ed. & trans., 1977) (“[T]o describe [a photograph] is thus not simply to be imprecise or incomplete, it is to change structures, to signify something different to what is shown.”). This can be so extreme that, as Jennifer Mnookin notes that before the era of photography, “[i]n reports of patent cases, the reporters sometimes apologized for the inclusion of drawings in their report.” Jennifer L. Mnookin, *The Image of Truth: Photographic Evidence and the Power of Analogy*, 10 *YALE J.L. & HUMAN.* 1, 61 (1998).

²⁷⁶ FEIGENSON & SPIESEL, *supra* note 267, at 4.

²⁷⁷ Tushnet, *Worth a Thousand Words*, *supra* note 93, at 734-35. Verbal overshadowing is something that experts can resist but nonexperts cannot. *Id.* at 735-36.

Perhaps, for example, Taco Cabana's color-neutral verbal description of its trade dress led the courts and jurors involved in that case to de-emphasize the restaurants' actual colors in adjudging similarity and consumer confusion.²⁷⁸

All of this amounts to a lot of confusion in our design protection regimes. Visual exemplar claims—whether in design patents, trademark registrations, or designs in the marketplace—are always supplemented in litigation by some degree of verbal claiming. This verbal claiming can helpfully focus attention on certain features, or it can distract from other pertinent features. Legal actors need to be expressly conditioned to recognize the biases of images and texts, which evidence shows can dislodge many of those biases.²⁷⁹

As we explore in the next section, the mixture of visual and verbal claims can drive a wedge between the notice the public receives from an exemplar claim pre-litigation and the verbal characterizations that flow later in litigation. Variation in claim form is also connected to claim scope, given the different ways in which images depicting a design and words describing the “same” design communicate to an audience.²⁸⁰

* * *

This Section demonstrates that each of the three design protection regimes comprises a system of central claiming that allows claiming at multiple points in time and mixes visual and verbal claiming, though to varying degrees. As a result, claimants can assert different, perhaps conflicting, claims for the same design even within a particular protection regime. This has further important consequences for adequacy of notice and claim scope, to which we turn respectively in the next two Sections.

C. Adequacy of Notice

The primary purpose of intellectual property claims is, as one of us has written, “to give notice to the public of the extent of the set of protected embodiments so as to encourage efficient investment in innovation, thereby fostering [the] law’s overarching goal of stimulating” creation.²⁸¹ Yet the adequacy of the notice provided by the design claims in any one legal regime is affected by several claiming features.

As we discussed above, four features in particular create the potential for a multiplicity of claims²⁸²: central claiming, often by exemplar rather than by

²⁷⁸ See *id.* at 737 (“[I]n [a copyright] infringement case, the ways in which the witnesses and lawyers talk about the works at issue and direct factfinders’ attention to specific features will quite literally change how the factfinders see the works.”).

²⁷⁹ *Id.* at 738 n.249.

²⁸⁰ See *infra* Section II.D.

²⁸¹ Fromer, *Claiming*, *supra* note 26, at 721; accord Fromer, *Patent Disclosure*, *supra* note 226, at 544–54.

²⁸² See *supra* Section II.B.

characteristic; the timing of claiming; the level of generality at which claims can be made; and the extent to which there is a choice between verbal and visual claiming. These features also affect notice, and we analyze each in turn. We then discuss how clearer distinctions between claimed, unclaimed, and disclaimed design features would help improve notice.

The potential multiplicity of claims within any of the design protection regimes can, at least as currently implemented, undermine the adequacy of notice as to the scope of protection. If reconfigured, however, the multiplicity of claims could instead improve the adequacy of notice.

Poor notice is primarily a result of parties' inability to assess which claims take priority over other possibly conflicting claims. When more than one claim is made to a protected design, one of those claims might seem to cover a particular design while others might not. For example, claims might be made at multiple points in time. The earlier claim might specify a color for a restaurant exterior, and the later claim might not. Alternatively, multiple central claims might be made, irrespective of time: perhaps one to the design of a game requiring just skill and another to designs of games that require only luck. Or a central claim by exemplar, rendered visually, might be supplemented by a central claim by characteristic, made verbally: an image of a mostly pink restaurant exterior supplemented by a verbal description of a restaurant that doesn't mention color at all, or that refers to "festive colors" but does not specify pink. Or one can imagine multiple claims presented at varying levels of generality—one with the excruciating detail of Varsity Brands' description to the Copyright Office and another with a more general description referring only to lines, zigzags, and colorblocking.

These multiple claims are problematic in that a third party's design could seem to fall within the scope of one claim but not the others. Does the corresponding design right cover anything that falls within the scope of any of the multiple claims made to it, as in utility patent law?²⁸³ Does a later/earlier/broader/narrower/verbal/visual claim instead take precedence?²⁸⁴ Or is the relation between multiple claims yet more complicated than that? Without a framework to address these questions, the fundamental notice function of intellectual property claims²⁸⁵ is severely undermined.

Some of the design protection regimes provide partial answers regarding priority among multiple claims. Design patent doctrine makes clear that the

²⁸³ *E.g.*, Fromer, *Claiming*, *supra* note 26, at 731-41.

²⁸⁴ *Cf.* *FDA v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 143 (2000) ("The classic judicial task of reconciling many laws enacted over time, and getting them to make sense in combination, necessarily assumes that the implications of a statute may be altered by the implications of a later statute. . . . [A] specific policy embodied in a later federal statute should control our construction of the [earlier] statute" (internal quotation marks omitted)).

²⁸⁵ Fromer, *Claiming*, *supra* note 26, at 761-67.

visual design patent claim takes precedence over any later verbal claims made in litigation. But as we discussed above, despite the formal emphasis on the visual, courts dealing with virtually every validity or infringement question inevitably engage in verbal description.²⁸⁶ Trademark doctrine prioritizes the context in which the trade dress is used in the marketplace, even over the form of any (optional) registration.²⁸⁷ Copyright law provides no guidance whatsoever. None of the regimes gives anything close to a comprehensive sense of how to resolve these conflicts. In fact, none of the regimes seems even to recognize that the potential multiple claims can raise conflicts that undermine the adequacy of notice. And courts' inconsistencies in choosing among claims, say with regard to level of generality, do not help matters. The lack of methodology also undermines notice by making it difficult for courts to be consistent in their interpretations.

The lack of methodology is a shame because, in our view, multiple claims could, if implemented well, improve rather than impede notice. As one of us has analyzed, multiple central claims to the same work can help third parties understand the work's scope by providing multiple vantage points from which to construct that understanding.²⁸⁸ Relatedly, informational redundancies can help communicate the salient features of a particular design through "repetition of information [across multiple claims] so that it can be reconstructed even [if single claims] cannot be retrieved or comprehended."²⁸⁹ In fact, in spite of its apparent inefficiency, redundancy pervades human communication, thereby aiding in comprehension.²⁹⁰

That design claims are central also affects the adequacy of notice. Despite the widespread belief that peripheral claiming provides better notice of the scope of rights, in some cases central claiming might instead provide better, or at least equivalent, notice. Peripheral claims can be written with greater ambiguity to make them broader. The Lisa Frank claim we discussed previously,²⁹¹ for example, might be seen as an attempted peripheral claim,

²⁸⁶ See *supra* Section I.A.

²⁸⁷ See *supra* Section I.B.

²⁸⁸ Fromer, *Claiming*, *supra* note 26, at 761-67.

²⁸⁹ Fromer, *Patent Disclosure*, *supra* note 226, at 573-79; accord John M. Golden, *Redundancy: When Law Repeats Itself*, 94 TEX. L. REV. 629, 677-78 (2016) [hereinafter Golden, *Redundancy*] ("[C]laim drafters are commonly engaged in an engineering exercise that deliberately introduces redundancy . . . to try to protect against any of a number of 'stresses' or 'failures'—invalidity challenges, relatively narrow claim constructions, etc.—that can later afflict the language that they use."); cf. Henry E. Smith, *The Language of Property: Form, Context, and Audience*, 55 STAN. L. REV. 1105, 1157-61 (2003) (making comparable observations with regard to property claims).

²⁹⁰ See Fromer, *Information Theory*, *supra* note 49, at 85-91 (positing how copyright law can be explained from the perspective of information theory and redundancy in communication); Golden, *Redundancy*, *supra* note 289, at 658, 660-61.

²⁹¹ *Supra* Section I.B.

yet it was both long and abstract, perhaps undermining any notice value of the claim. Additionally, because designing consists essentially of visual drafting, a comprehensive set of visual peripheral claims is impracticable.²⁹² Central claiming is therefore likely preferable to peripheral claiming for design claims, not only because of peripheral claiming's defects, but also because central claiming has some distinct advantages. Pertinently, cognitive science research suggests that central claims correspond better to categorical learning.²⁹³ And sometimes a central claim made at a particular moment in time can helpfully focus attention on features that are relevant to the circumstances, or even the dispute, at hand.²⁹⁴

Still, notice can often be undermined by the fact of multiple central claims, possibly made at different points in time, that appear to suggest differing scopes.²⁹⁵ One thing that might ameliorate this concern to some extent would be a requirement that a note accompany each formal design claim specifying that the claim is not exhaustive—essentially putting third parties on notice of potential multiplicity.

With regard to claiming by exemplar or by characteristic, in general “when intellectual property law is protecting a small, poorly differentiated category, claiming by exemplar would be appropriate. But claiming by characteristic would be more suitable for larger, better differentiated categories, though claiming by exemplar might also play a role in teaching categorical boundaries.”²⁹⁶

That said, context matters. Design is inherently visual, more so than many other types of matter protected by intellectual property rights. It would therefore be difficult to imagine a design claiming system that did not at least include visuals. In any system that does not limit infringement to identical reproduction of a design in every detail, it is difficult to conceive of visual claims as claims by characteristic. Thus, it seems unlikely that notice would be effective in the design context without exemplar claiming, even if claiming by characteristic can be more helpful for notice generally. For this reason, claiming by exemplar should be seen as a given in design protection regimes. What can be optimized with regard to notice is the precise form of visual exemplar claiming, and any supplementation of claiming by characteristic.

Identification of characteristics—even if within a system of central claiming under which the listed characteristics are prototypical rather than necessary or sufficient—helpfully supplements visual claiming by directing

²⁹² See Fromer, *Claiming*, *supra* note 26, at 728 tbl.1.

²⁹³ *Id.* at 761-65.

²⁹⁴ The Second Circuit's interpretation of Louboutin's claim, particularly its emphasis on the *contrasting* red sole, comes to mind here. See *supra* notes 140-47 and accompanying text.

²⁹⁵ *Supra* subsection II.B.1.

²⁹⁶ Fromer, *Claiming*, *supra* note 26, at 766.

parties to the more relevant characteristics in an exemplar. It might otherwise be difficult to adduce which design characteristics are most important.

The mix of visual and verbal claiming affects notice in another way. As discussed above, visual claims tend to be interpreted holistically, whereas verbal claims instead focus attention—or distract attention away from—particular features.²⁹⁷ Both claim formats can distort, standing alone. Courts have often recognized that fact, which is why they sometimes emphasize the visual—reflecting concern that parties will omit or unduly emphasize certain design features—and sometimes prioritize the verbal—out of concern parties will abstract away from the protectable features. But alternating emphasis misses the opportunity to develop a more holistic claiming methodology that would in all cases combine elements of visual and verbal claiming, perhaps at least by requiring verbal disclaiming, to draw attention to features that are not part of the claim.

Adequacy of notice is also a function of when third parties learn of a design's existence and when they learn that the designer claims rights in the design. A third party might see a design in the marketplace but have little reason to know that anyone claims rights in it, let alone which features are claimed. Obviously, by the time any litigation starts, third parties will know of both the design and the claim of rights. And when the design is registered—as it must be for design patents and as it can be for trademarks and copyright—the public is constructively on notice that the owner claims some rights in the design. But for unregistered trademarks or copyrights, third parties might have knowledge of the design but not of any particular assertion of rights to it. Linking knowledge of the existence of a design to the observation that the designer might assert rights in aspects of the design is not always trivial, especially when the design is a composite, as is typical.²⁹⁸

At the time a design patent issues,²⁹⁹ the public is on notice of both the design and a claim of rights. By that time, depending on the industry, there is a reasonable chance the claimant's design has been commercialized.³⁰⁰ In

²⁹⁷ *Supra* subsection II.B.3.

²⁹⁸ *Supra* text accompanying notes 135–37.

²⁹⁹ On average, design patents issue twenty months after filing. *Supra* text accompanying note 61.

³⁰⁰ This might be more likely to be true of, say, fashion designs as compared with computer hardware designs, given differences in business cycles, although much depends on when design patent applications are filed in that business cycle. See ELAINE CHEN, BRINGING A HARDWARE PRODUCT TO MARKET: NAVIGATING THE WILD RIDE FROM CONCEPT TO MASS PRODUCTION 1-4 (2015) (explaining that the business cycle of hardware products is “long and costly” as it can take years to create commercialized products after the core technology is developed); *Fast Fashion*, FASHION LAW (Oct. 3, 2016), <http://www.thefashionlaw.com/learn/fast-fashions-green-initiatives-dont-believe-the-hype> [<https://perma.cc/HXY3-64GX>] (noting that fast-fashion retailers consistently deliver new designs to their stores every four to six weeks).

general, then, both claiming and public notice of a claim of rights in a design happen relatively early for design patents.

But that is less true for trademark or copyright rights in design. When the rights are unregistered, there is little or no public notice of the claims. Notice is not significantly improved even when those rights are registered because courts do not understand the claims within these registrations to bind rightsholders in their assertion of rights.³⁰¹

If notice were the only concern, the obvious solution here would be to require early, binding claiming. But there are some good reasons to de-emphasize registration in the trademark and copyright contexts. In particular, mandatory registration raises the cost of protection for designers and can work as a trap for the unwary, preventing designers from acquiring rights when they inadvertently fail to register in a timely fashion.³⁰² Moreover, because American trademark law connects rights in a design to its use in the marketplace, early notice might not always be possible because the rights depend on consumers' association of the design features with a particular source, and consumer understanding can change as marketplace conditions evolve.³⁰³

One way to improve the quality of notice would be to make it easier for third parties to distinguish between a design's claimed, unclaimed, and disclaimed aspects. For example, consider the broken lines that might be found in a design patent claim. Matter depicted in broken lines is technically unclaimed.³⁰⁴ Yet to the uninitiated, this matter might appear to be claimed matter that narrows the scope of protection in the design.³⁰⁵ Or it might seem to be disclaimed. We think it would be useful to have a third mode of depiction for *disclaimed* matter, or at least a verbal supplement to disclaim matter within a visual depiction. Verbal supplementation might be especially effective here because verbal claiming by its nature tends to focus attention on specific features—exactly as one would want disclaimers to do.

D. Claim Scope and Litigation Framing³⁰⁶

In addition to providing notice, claims are critical to framing virtually every aspect of intellectual property litigation. Every infringement action involves an allegation that the defendant has violated the plaintiff's rights in the claimed design. As a result, the first thing a court must do is figure out

³⁰¹ See *supra* Sections I.B–C.

³⁰² Sprigman, *supra* note 184, at 491–93 (describing the high costs of compliance in early American copyright law).

³⁰³ See *supra* Section I.B.

³⁰⁴ See *supra* Section I.A.

³⁰⁵ When assessing design patent scope, even someone familiar with design patent claiming conventions might subconsciously, or mistakenly, include matter in broken lines.

³⁰⁶ Portions of this section are adapted from Lemley & McKenna, *Scope*, *supra* note 28.

what the claimed design is. Only then can the court determine whether the claimed property is subject to valid rights because all of the relevant validity doctrines in design patent, trademark, and copyright assess the validity of the design *as claimed*.

One significant part of the validity determination in every design protection regime is a comparison of the claimed design with what came before it. Almost all intellectual property regimes premise protection on some form of novelty—the invention or creation of a new thing the world has not seen before.³⁰⁷ But truly new creations are rare things. Almost all creators add their contributions onto a base of prior knowledge. And, for various policy reasons, intellectual property regimes refuse to protect some features, no matter how different they might be from what preceded them. For example, although they each understand functionality differently, none of the three design protection regimes will protect functional features.

At the same time, all intellectual property regimes recognize that a party can own some valid rights in a work even when many features of the work are not protectable. One can, for example, get a utility patent on an invention that incorporates many elements of prior inventions, as long as the newly claimed invention adds some novel and nonobvious element.³⁰⁸ Utility patent law refers to the features that make an invention patentable collectively as the “point of novelty.”³⁰⁹ Design patent law also used to incorporate the concept of the “point of novelty,” and although the Federal Circuit has since rejected the terminology, it still evaluates a claimed design in light of prior art. Copyright and trademark lack a similar term, but they have the same concept: those features that are new and are not excluded from protection for policy reasons can be the basis of protection for a work as a whole, but that which was taken from the prior art or otherwise excluded from protection cannot be protected separately. Thus, one important purpose of defining the relevant

³⁰⁷ Even trademark law, which does not require novelty per se, typically awards rights to the party that first uses a mark in connection with particular goods or services. *See supra* Section I.B. Copyright, of course, does not require novelty in the sense that the work must be different from what came before it. Indeed, as a matter of blackletter doctrine, copyright attaches to any work independently created (not copied from others) with a modicum of creativity. *Supra* Section I.C. But that rule is more theoretical than true: some courts treat “striking similarity” between works as strong evidence of copying. *E.g.*, *Ty, Inc. v. GMA Accessories*, 132 F.3d 1167, 1170 (7th Cir. 1997) (“If, therefore, two works are so similar as to make it highly probable that the later one is a copy of the earlier one . . .”). More importantly, the scope of copyright protection in a work that is identical to other preexisting works would be vanishingly small. The plaintiff would have to prove that the defendant’s work was copied *from the plaintiff* rather than from the preexisting work.

³⁰⁸ *Cf. KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–19 (2007) (“[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.”).

³⁰⁹ *See Lemley, Point of Novelty*, *supra* note 87, at 1254–55 (discussing the role of the “point of novelty” in patent law).

design is to determine which features of the claimed design are protectable, and whether valid rights attach in relation to a unit of the claimed scope.³¹⁰

Once we know what the rightsholder has in fact contributed to the world, we can ask what acts violate rights in that property. Every intellectual property system determines infringement by reference to both the acts that cannot be undertaken in relation to the subject of intellectual property rights and the level of similarity between the defendant's invention, work, or mark and that of the plaintiff.³¹¹ Together, the prohibited acts and the requisite similarity determine the legal scope of a party's rights. That legal scope is inextricably intertwined with the delineation of the entitlement, which is inescapably anchored by the claims. When we, for example, say that the defendant must publicly display "the copyrighted work," we take for granted that we have already been able to define "the copyrighted work" so that we can connect our analysis of similarity to that work. Further, we generally mean that the defendant must have taken the thing that gives the intellectual property right its validity—the point of novelty, in patent terms. The marks "Shake Shack" and "Joe's Crab Shack" might share the word "shack," but that fact alone should not cause the newcomer to be guilty of trademark infringement, for the simple reason that the word "shack" alone is not what justifies protecting the trademark.

Determination of the scope of a party's rights therefore necessarily depends on a definition of the relevant intellectual property. More particularly, evaluating whether the defendant's use comes within the legal scope of the plaintiff's rights requires identification of the protectable elements of those rights. This is because all intellectual property regimes require, at least in theory, not just similarity between the defendant's and plaintiff's works but similarity between the allegedly infringing work and the protectable elements of the plaintiff's work.³¹² Infringement inquiries in every area therefore depend in the first instance on the ability to determine what a party has claimed. A court simply cannot run any of the relevant doctrines except in relation to the *claimed* design. To the extent claiming methodology interferes with clarity or enables parties to emphasize different features at different times, the effects are pervasive and fundamental.

³¹⁰ See Michael J. Madison, *IP Things as Boundary Objects: The Case of Copyright Work*, 6 LAWS 13, 13–14 (2017) (examining the ways that boundaries on protectable works may be "less distinct than they appear"); Michael J. Madison, *Law as Design: Objects, Concepts, and Digital Things*, 56 CASE W. RES. L. REV. 381, 397–98 (2005) (discussing the "broadening array" of potentially protectable things).

³¹¹ Fromer & Lemley, *Audience*, *supra* note 190, at 1251.

³¹² In addition, different information might be available in each design protection regime to assess protectability, scope, and infringement. Pertinently, design patents list prior art references. 37 C.F.R. § 1.98 (2017). There is no comparable information for copyrights and trademarks, even registered ones.

E. Internalizing Validity and Scope

Intellectual property doctrines fall into three basic categories: validity, infringement, and defenses.³¹³ Each intellectual property regime tends to separate doctrines into these three legal categories, often applying different burdens of proof and asking different actors to decide issues in each category.³¹⁴ As a result of that separation, parties treat intellectual property rights “like a nose of wax, which may be turned and twisted in any direction.”³¹⁵ When infringement is at issue, intellectual property owners tout the breadth of their rights, while accused infringers seek to cabin them within narrow bounds.³¹⁶ When it comes to validity, however, the parties reverse their positions: intellectual property owners emphasize the narrowness of their rights to avoid having those rights held invalid, and accused infringers argue the reverse.³¹⁷ Courts often have difficulty managing that strategic behavior and holding the scope of rights constant for validity and infringement purposes.

Take, for example, *Reynolds Consumer Products v. Handi-Foil Corp.*³¹⁸ In that case, Reynolds objected to the packaging of a new line of Handi-Foil aluminum-foil products.³¹⁹ Reynolds claimed to own rights in the “overall look, feel and commercial impression of its Reynolds Wrap packaging design.”³²⁰ Specifically, Reynolds identified at least twelve elements that make up this unregistered trade dress:

- (a) the color scheme; (b) the use of the color scheme; (c) the use of prominent lettering within the blue section; (d) the use of silver bands to separate the blue and pink sections; (e) the placement of the quantity information; (f) the inclusion of the “made in the U.S.A.” lettering; (g) the repetition of the color scheme and type on the ends of the boxes; (h) the “press here to lock” feature at the ends of the boxes; (i) the use of graphics with how-to information; (j) the “Lift” graphic; (k) the positioning of the

³¹³ See Lemley & McKenna, *Scope*, *supra* note 28, at 2219 (discussing the “separation between validity, infringement, and defenses” in intellectual property cases).

³¹⁴ *Id.* at 2220-23.

³¹⁵ *White v. Dunbar*, 119 U.S. 47, 51 (1886).

³¹⁶ See Lemley & McKenna, *Scope*, *supra* note 28, at 2225-66 (“IP owners will argue in the infringement proceedings that their right is quite broad . . . only to turn around and argue in validity proceedings that their right is quite narrow Accused infringers will do the reverse.”).

³¹⁷ *Id.* In the German patent context, this phenomenon is referred as the “Angora cat” because in infringement proceedings the patent resembles a blow-dried fluffy cat, and in invalidity proceedings, the same cat looks like a little wet rolled-up bundle. Colleen Chien & Christian Helmers, *Inter Partes Review and the Design of Post-Grant Patent Reviews*, STAN. TECH. L. REV. (forthcoming) (manuscript at 16) (available at <https://ssrn.com/abstract=2601562>).

³¹⁸ No. 13-0214, 2014 WL 3615853 (E.D. Va. July 18, 2014).

³¹⁹ See *id.* at *1.

³²⁰ *Id.* at *7.

brand name on the top flap of the box; and (l) the color yellow, placement, and text used to caution the consumer.³²¹

In evaluating Reynolds' claim, the court never addressed validity, let alone identified the features that made the Reynolds trade dress protectable.³²² It simply engaged in a side-by-side comparison of Handi-Foil's and Reynolds's packages, shown in Figure 21, which was enough for the court to conclude that "the similarity between the overall impressions" was "striking."³²³ What were the damning similarities?

Figure 21: Reynolds and Handi-Foil Packages³²⁴



[T]he two boxes both say "non-stick" and "heavy duty." The Reynolds box says "foods lift right off!" and the Handi-Foil box says "Food Easily Lifts Off!" Both boxes place the (identical) square footage on the right end of the box, with the metric conversions typed neatly below. Additionally, the two-dimensional images above cannot capture the similarity of the boxes' side and end panels, all of which bear striking semblance. Add to these characteristics the "Made in USA" language on the right portion of the boxes³²⁵

These elements of similarity, and the court's belief that Handi-Foil attempted to mimic the Reynolds Wrap box to enter the aluminum-foil market, convinced the court that the jury's finding of trade dress infringement was reasonable.³²⁶ In fact, according to the court, "any other finding may well have been unreasonable."³²⁷

³²¹ *Id.*

³²² *Id.* at *8.

³²³ *Id.* at *9.

³²⁴ Second Amended Complaint at 6, 9, *Reynolds*, No. 13-0214, 2014 WL 3615853.

³²⁵ *Reynolds*, 2014 WL 3615853, at *9.

³²⁶ See *id.* at *9-10 ("[T]he reasonableness of the jury's trade dress verdict [has] become[] obvious.").

³²⁷ *Id.* at *9.

The problem with this conclusion is that the elements of similarity noted by the court were not even elements of the trade dress articulated by Reynolds, very likely because those elements almost certainly were not things Reynolds was entitled to own. Phrases like “Food Easily Lifts Off” and “Made in the USA” are descriptive, so any rights Reynolds owned in relation to the phrases must have been related to the particular stylization, which Handi-Foil did not copy. When one limits the trade dress in the Reynolds Wrap packaging to the sorts of things Reynolds is legally entitled to own, the similarities disappear. Because, however, the court never definitively determined the features of the claimed design, it could not hold the scope of Reynolds’ rights constant across both validity and infringement analyses.

One of us previously attributed the “nose of wax” problem to the lack of an integrated procedure for deciding the proper scope of a party’s rights.³²⁸ Yet the flexibility and multiplicity of claims, a particularly serious problem in the context of design, enables inconsistency and makes it much more difficult for courts to constrain the parties. That is how, for example, Varsity Brands could claim its cheerleading uniform designs sufficiently narrowly to the Copyright Office—to establish validity—and then later in litigation claim its designs more broadly to capture Star Athletica’s designs.³²⁹ Yet a design ought to be one and the same, whether validity or infringement is at issue.³³⁰

* * *

This Part shows that the choices each design protection system makes regarding claiming methodology have significant consequences. Those choices influence claim timing and the amount and content of information available to shape the claim, the elasticity and multiplicity of claims, the adequacy of notice provided by the claims, claim scope and litigation framing, and the extent to which parties can strategically manage validity and scope. The claiming methodologies adopted by each design protection regime give reason for concern about the adequacy of notice because they all allow rightsholders to claim strategically at different moments in time. These methodologies also enable parties to avoid internalizing their claiming choices across validity and scope inquiries, as intellectual property laws ought to do. To address these concerns, design protection regimes should encourage earlier claiming where plausible, construct a set of rules to decide how to prioritize between conflicting claims, communicate clearly that central claims need not be exhaustive so as not to mislead third parties, devise a standard to distinguish

³²⁸ Lemley & McKenna, *Scope*, *supra* note 28, at 2200-02.

³²⁹ *Supra* section I.C.

³³⁰ See Lemley & McKenna, *Scope*, *supra* note 28, at 2267 (“Our aim should be to find the proper scope for an IP right. And that can’t be done if we consider validity, infringement, and defenses in isolation.”).

between claimed, unclaimed, and disclaimed matter, and emphasize the constancy of claim scope across both validity and infringement analyses.

III. OVERLAPPING PROTECTION AND CLAIMING DESIGN

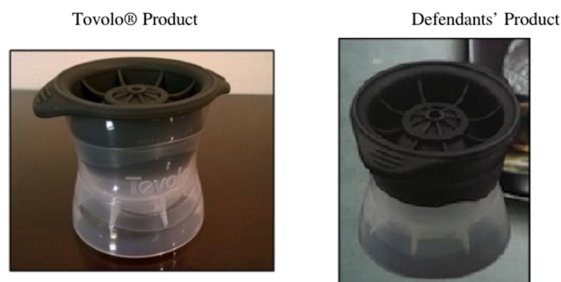
In this Part, we address the relationship between the varied claiming systems in design patent, trademark, and copyright, along with the issue of overlapping protection. After describing the way parties use these various forms of protection cumulatively or as substitutes, we argue that overlapping protection aggravates many of the concerns we described above about the multiplicity of claiming methodologies, particularly by further weakening notice. We then argue that the differences in claiming methodologies may in some cases exacerbate the overlap problem, by enabling parties to game limiting doctrines and by disguising the extent to which claims are really directed to the same design.

A. *Overlapping Protection for Design*

What is worth emphasizing about Puma's dispute with Forever 21 over the bow slides is that Puma asserted design patent, trademark, and copyright rights in the exact same design.³³¹ That sort of claiming is far from unique—parties often can, and frequently do, claim multiple forms of protection for the exact same designs, or at least designs that consist in substantial part of the same features. They use these different forms of protection cumulatively or as substitutes for each other even though each regime has a somewhat different purpose.

For a recent example of cumulative claiming, consider Spectrum Diversified Design's complaint against Target for infringing Spectrum's rights in its Tovolo Sphere Ice Molds, shown in Figure 22.

³³¹ See *supra* text accompanying notes 4–5.

Figure 22: Tovolo and Target Ice Molds³³²

According to Spectrum, Target's Ice Mold infringes its design patent, shown in Figure 23, and its trade dress in the design of the Sphere Ice Molds.³³³ Spectrum described its trade dress as having a unique design that corresponds to the shape depicted in its design patent, but also including "a clear plastic mold base with two swirled-looking lines with the Tovolo® trademark in the middle and a gray plastic mold top with grooves, lines, ridges, and a wagon wheel design."³³⁴

Figure 23: Claim in Spectrum's Design Patent³³⁵

One important reason parties are often motivated to assert both design patent and trademark claims has to do with potential remedies. Specifically, parties cumulate claims in search of comprehensive remedies that neither system readily provides on its own. A finding of design patent infringement almost inevitably leads to an award of damages, which can be substantial, but

³³² Complaint at 5, Spectrum Diversified Design, LLC v. Target Corp., No. 18-00133 (W.D. Wash. Jan. 29, 2018).

³³³ *Id.* at 5-6.

³³⁴ *Id.* at 4.

³³⁵ U.S. Patent No. D731,264 fig.1.

it does not always result in an injunction.³³⁶ A finding of trademark infringement, by contrast, usually leads to injunctive relief, but not always damages.³³⁷ Parties therefore sometimes assert both design patent and trademark claims so they can get the best of both worlds: damages on their design patent claim and injunctive relief on their trademark claim.

For an example of substitutive claiming, consider Govino's complaint against GoVerre.³³⁸ In that case, Govino alleged that it owns several design patents covering the design of a wine glass, but notably, Govino didn't assert design patent infringement, presumably because GoVerre's glasses were not similar enough to infringe the design patents.³³⁹ Instead, Govino alleged trade dress infringement, arguing that its design patents prove the designs are ornamental.³⁴⁰

Govino's claim against GoVerre also shows how parties' cumulative or substitutive use of these different regimes enables them to game the different substantive rules in trademark, design patent, and copyright laws. In Govino's case, it attempted to avoid the relatively stricter design patent infringement standard while benefitting from design patent's relatively weaker functionality doctrine, pointing to the design patents to establish trademark nonfunctionality.³⁴¹ To the extent claiming methodologies allow parties to use these regimes cumulatively or as effective substitutes, the policy goals underlying strong boundary-policing doctrines may be frustrated.

³³⁶ See *eBay Inc. v. MercExchange L.L.C.*, 547 U.S. 388, 392-93 (2006) (emphasizing that injunctive relief for patent infringement should not be automatically granted); Mark A. Lemley, *A Rational System of Design Patent Remedies*, 17 STAN. TECH. L. REV. 219, 221-24 (2013) (setting out and analyzing the generous damages provision for design patent infringement).

³³⁷ See Mark A. Lemley, *Did eBay Irreparably Injure Trademark Law?*, 92 NOTRE DAME L. REV. 1795, 1796 (2017) ("Trademark cases should take account of the true equities of trademark cases Doing so will not mean that trademark owners always win injunctions, but it should make it more common, at least in the core cases in which confusion is a real risk."); Mark A. Thurmon, *Confusion Codified: Why Trademark Remedies Make No Sense*, 17 J. INTELL. PROP. L. 245, 247-51 (2010) (indicating that damages are not awarded as a matter of course following a finding of trademark infringement); Rebecca Tushnet, *What's the Harm of Trademark Infringement*, 49 AKRON L. REV. 627, 628 (2016) (arguing that courts should not always issue injunctions).

³³⁸ Complaint, *Govino, LLC v. Goverre, Inc.*, No. 8:17-cv-01237 (C.D. Cal. July 19, 2017).

³³⁹ *Id.* at 3.

³⁴⁰ *Id.* at 3, 12.

³⁴¹ Trademark law polices functionality aggressively, denying trademark protection to features whenever they are not arbitrary or fanciful vis-à-vis the article's function (that is, when they contribute to function in any meaningful degree). See *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29-30 (2001); *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 990-92 (Fed. Cir. 2015), *rev'd on other grounds*, 137 S. Ct. 429 (2016); *Groeneveld Transp. Efficiency, Inc. v. Lubecore Int'l, Inc.*, 730 F.3d 494, 503-09 (6th Cir. 2013). Design patent, by contrast, rarely disqualifies features from protection on functionality grounds, doing so only when those features represent the only way of achieving a functional result. *Apple*, 786 F.3d at 992.

B. Exacerbating Notice Problems

Even if we only think about each of these areas of law protecting design in isolation, the claiming issues we have described create significant notice and scope problems. But it would be a mistake to consider them only in isolation because it is so common for parties to assert multiple forms of rights for the same design. As a result, would-be users, licensees, and courts have to evaluate the scope of rights across multiple systems. That can be quite difficult. Even when a party appears to claim rights in the same design and asserts its various rights against the same allegedly infringing products, the design patent, trademark, and copyright claims—not to mention the underlying substantive laws—are not obviously identical.

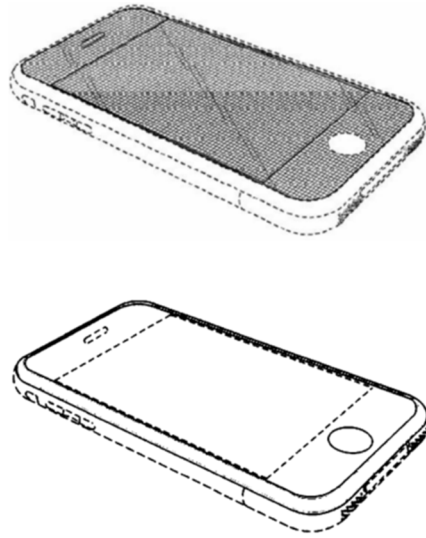
In the well-known dispute between Apple and Samsung over the iPhone, for example, Apple asserted both design patent and trade dress rights.³⁴² There was considerable overlap in terms of the Samsung devices that Apple contended infringed its various rights. Apple's claimed trade dress seemed to be for the same Apple devices that Apple contended embodied its patented designs. And the parties and the courts that considered Apple's claims treated them as if the overlap was essentially complete. But compare Apple's visual design patent claim with its different verbal description of its unregistered trade dress.

Table 1: Apple Visual Design Patent Claim and Verbal Description of Unregistered Trade Dress³⁴³

Design Patent	Unregistered Trade Dress

³⁴² See *Apple*, 786 F.3d at 989-91.

³⁴³ *Id.* at 992, 997.



a rectangular product with four evenly rounded corners;

a flat, clear surface covering the front of the product;

a display screen under the clear surface;

substantial black borders above and below the display screen and narrower black borders on either side of the screen; and

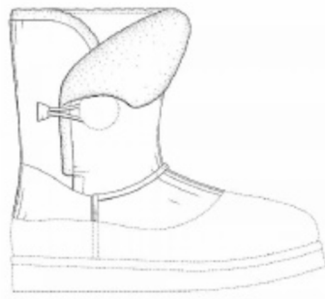
when the device is on, a row of small dots on the display screen, a matrix of colorful square icons with evenly rounded corners within the display screen, and an unchanging bottom dock of colorful square icons with evenly rounded corners set off from the display's other icons.

Deckers' recent suit against H&M demonstrates even more clearly the uncertainty created by different legal claims to a design.³⁴⁴ In that case, Deckers alleged that H&M infringed a design patent covering various aspects of the design of Deckers' UGG boots, as shown in Figure 24.

Figure 24: Deckers' Design Patents and Allegedly Infringing H&M Boots³⁴⁵

³⁴⁴ Complaint at 1-2, *Deckers Outdoor Corp. v. H&M Hennes & Mauritz, L.P.*, No. 17-00103 (C.D. Cal. Jan. 5, 2017).

³⁴⁵ *Id.* at 4, 8.

**Design Patent D599,999***Defendant's Accused Product*

Deckers also claimed that H&M infringed its trade dress rights in the Bailey Boot, which it described as follows:

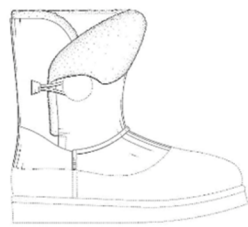
- Classic suede boot styling made famous by the UGG® Brand;
- Overlapping of front and rear panels on the lateral side of the boot shaft;
- Curved top edges on the overlapping panels;
- Exposed fleece-type lining edging the overlapping panels and top of the boot shaft; and
- One or more buttons (depending on the height of the boot) prominently featured on the lateral side of the boot shaft adjacent the overlapping panels.³⁴⁶

Deckers contended that the same H&M boots infringed both the design patent and the UGG trade dress.³⁴⁷ Indeed, it lined up its design patent drawing, its Bailey Button boot, and H&M's accused boot side by side in its complaint, as shown in Figure 25.

³⁴⁶ *Id.* at 5.

³⁴⁷ *Id.* at 5, 8.

Figure 25: Deckers' Design Patent, Deckers' Boot, and Allegedly Infringing H&M Boot³⁴⁸



Design Patent D599,999



UGG® Bailey Button Boot



Defendant's Accused Boot

There are, however, some interesting and notable differences between the design patent and trade dress claims. In some ways, the trade dress claim is broader than the design patent, referring, for example, to “one or more buttons” and leaving undefined the height of the boot.³⁴⁹ That is, the trade dress claim is to a line of boots—boots with different numbers of buttons and of different heights—and not to a particular boot design. The design patent by definition claims a particular boot design. At the same time, the trade dress claim is also conceivably narrower than the design patent in the sense that the trade dress claim refers to a fleece-type lining, whereas the design patent clearly shows some kind of lining but doesn’t identify a material.³⁵⁰ Because Deckers asserted both design patent and trade dress rights against the same commercial products, H&M had to layer the claims to determine the scope of Deckers’ rights. That effect is common. Indeed, Target will have to do the same thing with regard to Spectrum’s claims, which overlap substantially but not perfectly.³⁵¹

C. Obscuring Overlap

Perhaps more subtly, the fact that a party’s claims to a particular design might take different forms even when they are meant to cover the same ground can obscure the extent of overlapping protection and perhaps lull courts into a sense of complacency about the problems of overlap. The visual claims in a design patent, for example, might focus courts on an overall impression of the design, and that might happen even if the drawing uses broken lines that technically limit the claim to particular features of the design. Verbal descriptions of trade dress, by contrast, might direct courts to specific features at the expense of overall impression.

³⁴⁸ *Id.* at 8.

³⁴⁹ *Id.* at 5.

³⁵⁰ *Id.* at 8.

³⁵¹ See *supra* notes 332–34 and accompanying text.

These effects are likely most significant when the plaintiff has in fact asserted multiple forms of rights. However, it's also possible that the persistence of different claim forms generally reduces courts' sense that the various rights overlap. That sort of effect may be a partial explanation for the Seventh Circuit's controversial decision in *Kohler Co. v. Moen Inc.*³⁵² In that case, Moen claimed only trade dress rights in the design of its faucets, and Kohler defended in part by arguing that the court should not recognize trade dress rights in product design because it is the subject matter of design patent law.³⁵³ The Seventh Circuit rejected that argument,³⁵⁴ despite the Supreme Court's repeated expressions of concern about overlapping trademark and patent rights, even in cases involving design patents.³⁵⁵

According to the Seventh Circuit, there was nothing to worry about. Trademark rights are simply different from design patents because unlike design patents, "trademark protection for a product's configuration does not create a monopoly in the use of the product's shape."³⁵⁶ Instead, the court insisted that "Kohler [was] free to copy Moen's design so long as it insure[d] that the public [was] not thereby deceived or confused into believing that its copy [was] a Moen faucet."³⁵⁷

That distinction, as one of us has noted, was disingenuous, for the effect of trade dress protection was to deny Kohler the ability to copy Moen's design for the purpose of competing with Moen in the market for faucets—in other words, in the context most likely to have economic significance.³⁵⁸ That Kohler was free to copy the design of Moen's faucet as a sculpture hardly establishes that trade dress rights work no competitive harm.

And precisely because Moen sought protection for the design of the faucet itself—rather than the name attached to the faucet or its packaging—the promise that Kohler was free to copy Moen's design "so long as it insure[d] that the public [was] not thereby deceived" was an empty one.³⁵⁹ The whole point of seeking trade dress protection for product design features is to enforce those rights against others who copy the product features specifically, even when they do not copy word marks or packaging. Moen was not asking the court simply to require Kohler to label its faucets effectively (Kohler had already done that); it was asking the court to prevent Kohler from copying

³⁵² 12 F.3d 632 (7th Cir. 1993).

³⁵³ *Id.* at 636-37.

³⁵⁴ *Id.* at 644.

³⁵⁵ *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 238-39 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232-33 (1964).

³⁵⁶ *Kohler*, 12 F.3d at 640 n.10 (internal quotation marks and emphasis omitted).

³⁵⁷ *Id.*

³⁵⁸ McKenna, (*Dys*)*Functionality*, *supra* note 6, at 843-45.

³⁵⁹ *Kohler*, 12 F.3d at 640 n.10.

the faucet's design features because it contended that Kohler's use of the same design features for its faucets was what was likely to create the confusion.³⁶⁰ If Moen was right about that—if the confusion was caused by use of the design features themselves—then it was *impossible* for Kohler to use the design in a way that would ensure the public was not deceived.

We don't suggest that differences in the form of design patent and trademark claims completely explain *Kohler Co. v. Moen Inc.* or the other cases that follow its reasoning. But it's entirely possible that a design patent claim's inclusion of a faucet (even if some aspects were rendered in broken lines) encouraged the court to think of design patent claims as in-gross claims that differ from trade dress claims even when those claims are functionally equivalent. Moreover, we suspect that it is generally harder for courts to see the functional equivalence between these forms of protection because claiming methodology differs across areas of intellectual property.

IV. FIXING CLAIMING VARIANCE

Having described the substantial problems that can result from the use of such different—not to mention internally muddled³⁶¹—claiming rules across the various areas of design protection, we now consider possible ways of addressing the relationship between claiming and overlapping protection. Two potential approaches stand out. For those who are convinced that overlapping rights are problematic—or that the claiming issues we describe make that overlap intolerable—the solution is to eliminate the overlap, either using doctrines of election or channeling doctrines. For those who are comfortable with overlap among the design protection regimes, we suggest a more targeted fix for claiming, namely the adoption of a transsubstantive claiming regime for design. There are different costs and benefits to each approach, which we consider in turn.

A. *Eliminating Overlap*

The most straightforward way to deal with the problems caused by the diverse claiming regimes for design would be to eliminate overlapping protection. If design claimants could avail themselves of only a single form of

³⁶⁰ *Id.* at 633 (recounting the evidence that Moen introduced, which demonstrated the likelihood of source confusion).

³⁶¹ Earlier in this Article, we address a number of improvements to each claiming regime to restore internal order, including encouraging earlier claiming where plausible, constructing a set of rules to decide how to prioritize between conflicting claims, communicating clearly that central claims need not be exhaustive so as not to mislead third parties, devising a standard to distinguish between claimed, unclaimed, and disclaimed matter, and holding the scope of a design right constant across both validity and infringement analyses. *Supra* Part II.

protection, claiming methodology could not differ across protection regimes for the simple reason that only one claiming regime would govern. Although one would surely want to optimize the governing claiming regime, the mischief that derives from multiple design claiming systems would be avoided.

Concerns about overlapping forms of protection typically are premised on the notion that a party's ability to claim multiple forms of protection undermines the inherent, but different, bargains on which each form of protection is based.³⁶² Whereas design patent law exists to encourage industrial design, trademark law fosters competition by preventing deceptive use of source indicators and copyright law aims to stimulate the creation and dissemination of works of authorship. Yet all three forms of protection are increasingly available for design.³⁶³ Despite significant doctrine reflecting concern about overlapping protection for functional features, modern courts and some commentators are more sanguine about overlapping forms of design protection. They reason that, so long as each area of law provides for protection on its own terms, creators should not have to choose among those rights.³⁶⁴

We do not wade further here into the debate on the propriety of overlapping regimes. Instead, we describe two principal tools courts have used to manage overlap, to the extent it is a problem: doctrines of election and channeling doctrines. We discuss the benefits of each approach in turn.

1. Doctrine of Election

In the early twentieth century, courts routinely held that creators of works could elect just one form of intellectual property protection, even if they would seem to qualify for multiple forms.³⁶⁵ For example, in 1910, a circuit court ruled that even when a work—there, a watercolor painting of sprigs of holly, mistletoe, and spruce intended for use as wrapping paper—was potentially protectable under design patent or copyright, “the author or owner [must] decide[] under which statute he would protect his property.”³⁶⁶ The court reasoned that “[t]he method of procedure, the term of protection, and the penalties for infringement, are so different that the author . . . of a painting that is eligible for both classes must decide to which region of intellectual effort the work is to be assigned, and he must abide by the decision.”³⁶⁷

³⁶² See *supra* note 7.

³⁶³ E.g., Heymann, *Overlapping*, *supra* note 7, at 242-46 (discussing how the boundaries between the different doctrines have developed over the years).

³⁶⁴ See *id.* at 252-56 (“[A]lthough it was not the focus of the opinion, the Supreme Court lent its voice in 2000 to the chorus of courts finding no doctrinal issue with simultaneous intellectual property rights.” (citing *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 205-08 (2000))).

³⁶⁵ *Id.*

³⁶⁶ *Louis De Jonge & Co. v. Breuker & Kessler Co.*, 182 F. 150, 151 (C.C.E.D. Pa. 1910).

³⁶⁷ *Id.* at 152.

During this period, courts similarly ruled that a designer had to elect between design patent and trademark protection, reasoning that allowing both forms of protection for the design “would result for all practical purposes in an extension of the design monopoly.”³⁶⁸ More recently, however, courts have rejected election, allowing qualifying creators to hold and enforce multiple forms of intellectual property with regard to the same creation.³⁶⁹

One solution to the issues raised by design claiming would be to revitalize the doctrine of election for designs. Requiring a designer to choose only one of design patent, trademark, and copyright would ensure that the designer is thereby also choosing just one claiming regime, which would eliminate the notice problems attributable to varied claiming methodologies, and it would reduce the opportunity for strategic behavior.³⁷⁰

A number of considerations affect the viability and value of a doctrine of election, particularly the timing and form of election, creator choice, and the subject of election. Consider first the timing and form of election. For election to simplify the claiming rules, parties must not initially be able to claim multiple forms of protection and only later be forced to decide which of the three forms of protection to enforce. That would allow most of the claiming problems we have described to persist until the moment of enforcement. A doctrine of election would therefore be most effective if it required an early election.

Early election would improve the quality of notice and reduce strategic behavior. At the same time, designers might reasonably want to see how their designs fare in the marketplace before deciding whether, say, trademark protection is plausible, let alone optimal. Timing is further complicated by the fact that design patent applications typically must be filed relatively early, whereas copyright registration need only be sought at the point of enforcement and trademark registrations are not necessary at all.³⁷¹

³⁶⁸ *In re Blood*, 23 F.2d 772, 772 (D.C. Cir. 1927).

³⁶⁹ *E.g.*, *In re Yardley*, 493 F.2d 1389, 1395 (C.C.P.A. 1974) (“But the mere fact that the *copyright* will persist beyond the term of any design patent which may be granted does not provide a sound basis for *rejecting* appellant’s design patent application.”); *see* Beckerman-Rodau, *Problem*, *supra* note 7, at 73 (“Most recent case law has allowed such simultaneous protection.”); Heymann, *Overlapping*, *supra* note 7, at 252-56; McKenna, *(Dys)Functionality*, *supra* note 7, at 847 (“[N]o one seems seriously to suggest that overlap between trademark and copyright law generally disqualifies copyrightable works from trademark protection.”); Samuelson, *Strategies*, *supra* note 7, at 1529. Some attribute the move to allowing multiple forms of overlapping protection to a general shift in attitude toward favoring the interests of intellectual property creators. Beckerman-Rodau, *Problem*, *supra* note 7, at 88; Moffat, *Mutant Copyrights*, *supra* note 7, at 1496-97. One of us has advocated a return to the doctrine of election at the product level. Mark P. McKenna, *An Alternate Approach to Channeling?*, 51 WM. & MARY L. REV. 873, 890-94 (2009) [hereinafter McKenna, *Alternate Approach*].

³⁷⁰ Again, this assumes that each internal claiming regime is fixed to improve notice and remove possibilities for undesirable strategic behavior.

³⁷¹ *Supra* Part I.

Moreover, trademark rights will not even attach to designs until there has been use in the marketplace and distinctiveness established.³⁷² Given these timing rules, designers would have to elect design patent protection relatively early or effectively elect against design patent. Given the uncertainty about whether, and when, secondary meaning might attach and the relatively more robust functionality exclusion in trademark law, that might create incentives for parties to choose copyright or design patent protection more often. As between those, copyright has the cost advantage (attaching at the moment of fixation and allowing registration to be deferred),³⁷³ but even after *Star Athletica* (and perhaps especially after *Star Athletica*), copyright protection for useful articles is uncertain. A doctrine of election could therefore have the effect of pushing more design to design patent, at least on the margin.

If we assume that the incentives are not so strong as to effectively eliminate real choice, then there are both costs and benefits to allowing a designer to choose the form of protection for his or her design. As one of us has written, giving designers this choice has the benefit of recognizing that the designer “is in the best position to know where competitors are likely to find value.”³⁷⁴ That is, the designer is in a better position than anyone else—perhaps including lawmakers—to decide whether, say, design patent’s shorter term but perhaps broader protections are desirable over copyright’s longer term but perhaps narrower protections, given the designer’s business strategy. That said, although the designer might be well-placed to optimize private benefits from protection, the designer’s choice might be a suboptimal form of protection from society’s point of view. If designers frequently choose forms of protection that are subpar for society, channeling doctrines might be a better solution than a doctrine of election.³⁷⁵

There is one final complication to using a doctrine of election, and that has to do with its workability. To make a doctrine of election useful, courts (or, potentially, Congress) would need to determine which designs are subject to election. In our view, election should apply only to designs that fall within the subject matter of more than one of the three design protection regimes. Those are the designs for which overlapping protection is at issue.

³⁷² *Supra* Section I.B.

³⁷³ A law requiring copyright registration—whether on the early side or otherwise—would run afoul of the Berne Convention’s prohibition on formalities as prerequisite to copyright protection. Berne Convention for the Protection of Literary and Artistic Works art. 5(2), Sept. 9, 1886, 828 U.N.T.S. 221. Legal provision of incentives to engage in formalities, however, are permissible. Sprigman, *Reform(aliz)ing*, *supra* note 184, at 494-99.

³⁷⁴ McKenna, *Alternate Approach*, *supra* note 369, at 892.

³⁷⁵ *Infra* subsection IV.A.2.

One challenge to identifying the relevant designs will be the imperfect mapping of claims in different formats, as in the *Apple v. Samsung* case discussed above.³⁷⁶ Courts in cases involving multiple claims will have to determine whether those claims really are to the same design. That determination is likely to be more difficult in a world of election because parties will have a greater incentive to vary the claims slightly in order to mask the extent of overlap. Even if that challenge is manageable within an individual case, the dynamic considerations are exponentially harder. Specifically, how will a court determine which designs are subject to election when the issue is not simply whether a party must elect a form of protection within a particular case, but whether that party asserting rights today regarding an ostensibly new design is really claiming a design for which different rights were previously elected in another context?

Relatedly, a doctrine of election must specify how much of a design must be elected. That is, must a designer choose only one form of protection for the entire design? Or might the designer elect for, say, design patent protection for certain design elements but trade dress for others? We think that the doctrine of election should operate at the level of the design, or product, rather than piecemeal on design elements.³⁷⁷ Allowing a party to use different forms of protection for different elements of the same design would enable designers to game the doctrine of election and undermine its ameliorating effects. At the same time, a doctrine of election operating at the design level could sometimes raise difficult questions as to what constitutes the “design”—precisely the issue courts are now struggling with in the context of design patent remedies.³⁷⁸

2. Channeling

The intellectual property system could rely on channeling doctrines rather than a doctrine of election to eliminate overlapping protection for design, thereby reducing concerns about different claiming methodologies. Channeling doctrines are rules that “channel” particular subject matter to the particular intellectual property system intended for it, and intellectual property laws contain many such doctrines already.³⁷⁹ For example, copyright

³⁷⁶ *Supra* Section III.B.

³⁷⁷ See McKenna, *Alternate Approach*, *supra* note 369, at 891 (proposing a doctrine of election between utility patent and trademark laws that “would force a firm to elect between forms of protection at the product level”).

³⁷⁸ For a discussion of how to identify the relevant article of manufacture, and thereby to determine the proper unit of a design, see Burstein, *Article of Manufacture Today*, *supra* note 32, 812–31.

³⁷⁹ For more on how existing doctrines channel works between utility patent and copyright, utility patent and trademark, utility patent and design patent, and copyright and trademark, see generally Buccafusco & Lemley, *Functionality*, *supra* note 2; see also Laura A. Heymann, *The Trademark/Copyright*

law's useful articles doctrine channels out of copyright law and to utility or design patent law, if anywhere, certain aspects of a useful article. Pursuant to this doctrine, copyright law excludes from protection the "utilitarian aspects of [a useful] article" and "pictorial, graphic, or sculptural features that can[not] be identified separately from [or are not] capable of existing independently of" those utilitarian aspects.³⁸⁰ Trademark law's functionality doctrine channels to utility patent law protection of features that are "essential to the use or purpose" or "affect[] the cost or quality" of an article.³⁸¹ In the design context, channeling doctrines would direct certain designs solely to design patent, others solely to copyright, and still others solely to trademark.

A channeling doctrine for designs would be an alternative to a doctrine of election, with the similar effect of forbidding overlapping protection for designs. The biggest difference is that designers would not choose which form of protection they'd prefer; instead, courts or lawmakers would set the rules that would determine which designs would be considered the subject matter of design patent, trademark, or copyright. That means we would not be leveraging designers' experience and knowledge to identify, at the retail level, the best form of protection. On the other hand, channeling doctrines would also prevent designers from choosing a form of protection that provides private benefits but social costs. Instead, these channeling doctrines would consider at the wholesale level which design protection regimes are socially optimal for particular types of design—which is not to say that those regimes would always afford protection in individual cases.

Channeling doctrines also have the benefit of operating on designs from the moment they become protectable, meaning that there would always be at most one form of protection for a design. Unlike a doctrine of election, it would therefore be irrelevant that a designer need not claim rights in a design until enforcement. Third parties could consult the laws' channeling doctrines to determine which regime the design lies within, whether or not the designer has yet asserted rights under that regime. This choice has benefits for designers too because their decisions about whether to pursue design patent protection at the outset are simplified: the designers need not weigh the uncertain costs and benefits of electing design patent because the channeling rules will dictate which regime is available.

Divide, 60 SMU L. REV. 55 (2007); McKenna & Strandburg, *Progress*, *supra* note 6; Mark P. McKenna & Lucas Osborn, *Trademarks and Digital Goods*, 92 NOTRE DAME L. REV. 1425 (2017).

³⁸⁰ 17 U.S.C. § 101 (2012). *See generally* Buccafusco & Fromer, *Fashion's Function*, *supra* note 31; Buccafusco & Lemley, *Functionality*, *supra* note 2; *supra* Section I.C.

³⁸¹ *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)). *See generally* McKenna, *(Dys)Functionality*, *supra* note 6.

Just as with a doctrine of election, channeling should happen at the level of the design rather than for particular design elements.³⁸² Although this decision would also raise difficult questions about what features constitute a “design,” we think it is preferable to piecemeal protection under different regimes for different design elements.

In all, instituting either a doctrine of election or channeling doctrines for design would, in addition to addressing the concerns of those disturbed by the extent of overlapping protection for design,³⁸³ resolve the concerns about overlapping and different claiming methodologies. That said, for those who are comfortable with overlapping protections for design, introducing a doctrine of election or channeling doctrine for design might seem to be too drastic a measure to cure the claiming problems afflicting design protection. For that group, we propose implementing a transsubstantive claiming regime, to which we now turn.

B. Transsubstantive Claiming

Transsubstantive law—a layer of law that applies across different areas of substantive law—tends to be most familiar in the contexts of remedies³⁸⁴ and civil and criminal procedure.³⁸⁵ It has, in the main, not been a feature of intellectual property law.³⁸⁶ For claiming specifically, there might be good reasons for the differences in methodology across regimes, reasons that relate to the purposes of those regimes. As the extent of overlapping protection increases, however, the variations in claiming methodology become costlier because multiple rights, each with different claiming

³⁸² *Supra* text accompanying note 377.

³⁸³ See, e.g., Clark D. Asay, *Intellectual Property Law Hybridization*, 87 U. COLO. L. REV. 65, 70 (2016) (suggesting that patent law should factor in effects on creative activities and copyright should consider technological innovation, including by using obviousness or novelty tests to decide what counts as fair use); McKenna, *Alternate Approach*, *supra* note 369, at 875, 894-96 (calling for policymakers to factor in the interplay between different intellectual property protections when shaping the scope and duration of the protection offered by each).

³⁸⁴ Perhaps not surprisingly, some have focused on remedies as a solution to the overlap problem. See, e.g., Heymann, *Overlapping*, *supra* note 7, at 241-42 (suggesting that courts allow multiple forms of protection but limit the remedies to those necessary to address the specific harms of the specific use at issue). We are skeptical that transsubstantive remedies would resolve the claiming concerns discussed here because they would not fix claiming upfront, although they could help limit the collateral damage by minimizing strategic behavior of rightsholders seeking to maximize remedies across design protection regimes.

³⁸⁵ Federal Rule of Civil Procedure 23, for example, offers the ability to bring a class action for any violation of federal law so long as certain prerequisites are met. FED. R. CIV. P. 23. *But see* J. Maria Glover, *The Supreme Court’s “Non-Transsubstantive” Class Action*, 165 U. PA. L. REV. 1625, 1627 (2017) (positing that the only way to understand the Supreme Court’s recent Rule 23 jurisprudence is to “look past the procedural veneer and consider the underlying substantive rules and remedial regimes at stake”).

³⁸⁶ *But cf.* Beckerman-Rodau, *Problem*, *supra* note 7, at 89 (arguing for increased collaboration between, or even the unification of, the agencies that administer each branch of intellectual property law).

methodologies, are more frequently asserted for the same design. A transsubstantive claiming regime would alleviate the problems with these multiple claiming methodologies, and it would do so in a more targeted fashion than a doctrine of election or channeling doctrine.³⁸⁷

A complete description of a transsubstantive claiming regime is beyond the scope of this Article. But one goal of such a system should be to improve claim stability over time, both within a case and across cases. It is true that one area of design protection—trademark law—emphasizes consumer understanding, and for that reason, it recognizes that rights might change over time. But whatever the merits of that approach generally, we have seen the mischief it can cause in the context of design. Thus, at the very least, a claimant should bear the burden of establishing that there is a good reason, such as an overwhelmingly changed consumer understanding, to accept an evolving claim.

One way to operationalize that burden shifting would be to deny a presumption of validity with regard to rights that are inconsistent with those previously claimed—perhaps in the context of registration—and to extend the presumption only to design as originally claimed. A slightly stronger version would be to apply estoppel principles across time, so that a party that claimed one way in one case would be barred from claiming the design differently in other cases.

In terms of format, we tentatively propose a system with both visual and verbal claims. Courts in all areas of design protection have concerns about verbal claiming because it can result in losing sight of the overall design. At the same time, visual claims often cannot be interpreted without verbal description of particular features, especially in the common circumstance in which some (perhaps many) of the features are not protectable standing alone. The optimal claiming methodology would draw the best from both modes of claiming to account for the concerns about those modes. More specifically, we think in many cases claims will be most intelligible when they visually depict the claimed features and then verbally describe which aspects are *not* claimed. Focusing on the features not claimed will help avoid verbal overshadowing while addressing the central concern about visual claiming, namely that unprotectable features will be weighted inappropriately in assessing validity, infringement, or both.

³⁸⁷ In this regard, a consideration of the virtues and vices of transsubstantive claiming for design replicates debates that occur about transsubstantive law in other areas, like civil procedure: the practicality and ease of a “one size fits all” law versus a multiplicity of laws that are finely and appropriately attuned to their respective contexts. *See generally* Geoffrey C. Hazard, Jr., *Discovery Vices and Trans-Substantive Virtues in the Federal Rules of Civil Procedure*, 137 U. PA. L. REV. 2237 (1989); William J. Stuntz, *O.J. Simpson, Bill Clinton, and the Transsubstantive Fourth Amendment*, 114 HARV. L. REV. 842 (2001); Stephen N. Subrin, *The Limitations of Transsubstantive Procedure: An Essay on Adjusting the “One Size Fits All” Assumption*, 87 DENV. U. L. REV. 377 (2010).

CONCLUSION

At the outset, we noted how striking good design can be. While we hope it continues to be so, we think design protection regimes should become *less* striking by undoing the mischief they cause through their widely varying claiming methodologies. This multiplicity of claiming regimes undermines the quality of notice that design claims provide third parties about claim scope. These notice problems are ironic because intellectual property claims exist almost entirely to provide notice. Claim ambiguity and a party's ability to switch back and forth between different design claims—both within and across legal regimes—make it difficult for courts or third parties to evaluate the validity and scope of rights. Cumulation also enables design rightsholders to assert rights in one or more regimes using the claiming rules that benefit them most at a particular moment, without any material consequences to claiming the design differently at a later time. We think that any of our proposed solutions—a doctrine of election, channeling doctrine, and a transsubstantive claiming methodology—would ameliorate these concerns, thereby enabling third parties to better assess their freedom to operate and create other designs. Design protection regimes ought to be improved to encourage the creation of good designs, without also causing confusion about claim scope.